United States

Circuit Court of Appeals

For the Ninth Circuit

DIAMOND PATENT COMPANY, (a Corporation),

Appellant,

US.

THE S. E. CARR COMPANY, (a Corporation),

Appellee.

Transcript of Record

Appeal from the United States District Court for the Eastern District of Washington. Northern Division.

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FEB 9 - 1914 F. D. MONCKTON, OLERIC FILED FEB 9 - 1914



Court of appeals



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Upon Appeal from the United States District Court for the Eastern District of Washington,

Northern Division.



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NAMES AND ADDRESSES OF SOLICITORS OF RECORD.

SCRIVNER & MONTGOMERY,

Mechanics Institute Building, San Francisco, Cal., and LUBY & PEARSON,

Hutton Building, Spokane, Washington, Solicitors for Appellant.

MORRILL, CHESTER & SKUSE, Peyton Building, Spokane, Washington, and S. H. CUTTING,

Paulsen Building, Spokane, Washington, Solicitors for Appellee.

DIAMOND PATENT COMPANY,

(a Corporation),

Complainant,

US.

THE S. E. CARR COMPANY, (a Corporation),

Respondent.

BILL OF COMPLAINT FOR INFRINGEMENT OF A PATENT, INJUNCTION AND ACCOUNTING.

To the Judges of the District Court of the United States for the Eastern District of Washington, Northern Division.

The Diamond Patent Company, your orator herein, is a corporation duly organized and existing under the laws of the State of California, and having its principal place of business at the City and County of San Francisco, and in the Northern District for State of California, brings this, its bill of complaint, against

The S. E. Carr Company, a corporation, duly organized and existing under the laws of the State of Washington, respondent herein; and thereupon your orator complains and says:

I.

That heretofore and before the 3d day of October, 1904, one Fred Weber, was the original and first inventor of a certain new and useful improvement and invention in show cases, a more particular description of which will be found in the letters patent hereinafter referred to and to which special reference is hereby made, and in which letters patent the said invention is entitled "Show Case."

That the same was a new and useful invention and was not known to or used by others in this country before the invention thereof by the said Fred Weber, and was not patented or described in any printed publication in this or any foreign country before the invention thereof by the said Fred Weber, nor for more than two years prior to his hereinafter alleged application for a patent therefor, and at the time of his said application for a patent therefor had not been in public use nor on sale in the United States for more than two years and had not been abandoned.

II.

That thereafter, to-wit: on the 3 day of October, 1904, the said Fred Weber duly and regularly filed in the Patent office of the United States, an application praying for the issuance to him of letters patent for the said invention, and after proceedings duly and regularly had and taken, to-wit: on the 17th day of Oc-

tober, 1905, letters patent of the United States, bearing date on that day, and numbered 801,944, were granted, issued and delivered to the said Fred Weber, whereby there was granted to him, his heirs and assigns for the full term of seventeen years from the said last named day the sole and exclusive right and liberty to make, use and vend the said invention throughout the United States of America, and the territories thereof, and the said letters patent were issued in due form of law under the seal of the Patent Office of the United States, and signed by the Commissioner of Patents of the United States, and that prior to the issuance thereof, all proceedings were had and taken which were required by law to be had and taken prior to the issuance of letters patent for new and useful inventions, which said letters patent are hereby specially referred to for further and fuller description of the invention therein patented, and are ready in court to be produced by your orator, or a duly authenticated copy thereof.

III.

And your orator further shows unto your Honors that on or about the 5th day of February, 1910, the said Fred Weber, by an instrument in writing, sold, assigned and transferred unto your orator the said letters patent and all rights, liberties and privileges secured thereby, and that your orator thereby became and now is the sole and exclusive owner and holder, for and throughout all of the United States, and the territories thereof, of the said letters patent and of the invention, inventions, and improvements described therein, and of all rights, and privileges granted and secured or intended to be granted and secured thereby,

and your orator ever since has been and now is the owner of said patent.

And your orator further alleges that its said assignor and your orator since said assignment have invested and expended large sums of money in the manufacture of show cases under and in accordance with the said letters patent for the purpose of selling the same and making the said invention profitable and useful to the public; and that since the date of said assignment of said letters patent, your orator made and sold large numbers of such show cases throughout the United States, and is now actively engaged in the manufacture and sale thereof. That the said invention is of very great benefit and advantage, and that your orator has, upon all of the show cases so made and sold by him under said letters patent, fixed or caused to be fixed or marked thereupon the words "Patented," together with the day and year the said patent was granted, and the number thereof, thereby giving notice to the public at large that the said show cases were patented by the said letters patent. That the public have generally acknowledged and acquiesced in the aforesaid rights of your orator, and that but for the invasion of its rights by the respondent herein complained of, your orator would continue to enjoy large gains and profits from the practice of the said invention.

IV.

Your orator further shows to your Honors that notwithstanding the premises, but well knowing the same and well knowing the rights secured to your orator as aforesaid, and contriving to injure your orator and deprive it of the profits, benefits and advantages which might and otherwise would accrue to it from the said invention, and without the license or consent of your orator, and against the will of your orator, and in violation of his rights and in infringement of the said letters patent, and within six years last past, and within the Eastern District of Washington, the said respondent has made or caused to be made show cases employing, embodying and containing the said invention described in and covered by all the claims of said patent, but how many your orator is not advised.

Your orator further shows to your Honors that said respondent is now so continuing and threatens to continue to use show cases so as aforesaid infringing the said letters patent, and does now threaten and intend to further use show cases so as aforesaid infringing the said letters patent, all in defiance of the rights acquired by and secured to your orator as aforesaid, and to its great and irreparable loss and injury.

Your orator further shows to you Honors that the violation of your orator's rights as aforesaid by the said respondent and its threats and intentions to continue the same in disregard and defiance of your orator's said rights, has the effect to, and does induce others to venture to infringe the said patent in disregard of your orator's rights.

Your orator further shows to your Honors that it has caused notice to be given to the said respondent of its said infringements of the said letters patent and of the rights of your orator in the premises, and had notified it to desist and refrain thereform, and that the respondent has disregarded the said notice and has

refused to desist from infringing the said letters patent, and as your orator is informed and believes is now continuing to use the same.

V.

Your orator further avers that it has always sought to maintain the sole and exclusive right to practice said invention and has never acquiesced in any infringement of its exclusive rights under said patent.

VI.

Your orator further shows to your Honors that by reason of the premises, your orator has suffered great and irreparable loss and injury and damage, and the said respondent has realized large profits and gains, the exact amount of which is unknown to your orator. That for the wrongs and injuries herein complained of your orator has no plain, speedy or adequate remedy at law; and for as much as it is without any remedy in the premises save in a court of equity where matters of this kind are properly cognizable and relievable, and to the end, therefore, that the said respondent may, if it can, show cause why your orator should not have the relief herein prayed for, and may (but not upon oath, and oath to the respondent's answer being hereby waived) according to the best and utmost of its knowledge, recollection, information and belief, full true, direct and perfect answer make to all and singular the matters and things hereinbefore charged; your orator prays that the said respondent may be decreed to account for and pay over to your orator the gains and profits realized by it from its unlawful use and practice of the invention patented in and by said letters patent, and, in addition to the profits to be accounted for,

as aforesaid, the damages sustained by your orator, together with the costs of suit.

May it please your Honors to grant unto your orator a writ of injunction out of and under the seal of this court, provisionally and until the final hearing, enjoining and restraining the said respondent, its officers, agents, employees, clerks and attorneys from making or using or selling any show case or device containing and embodying the invention patented in and by the said claims of letters patent, or either of the claims thereof; and your orator prays that upon the final hearing of the case, the said provisional injunction may be made perpetual; and your orator prays that it may have such other and further relief as the nature of the case may require, and to your Honors may seem meet and proper in accordance with equity and good conscience.

May it please your Honors to grant unto your orator a writ of subpoena directed to said respondent, the S. E. Carr Company, commanding it at a certain time and under a certain penalty therein to be limited, personally to be and appear before this honorable court, then and there to answer to this bill of complaint, and to stand to, perform and abide by such further orders, directions and decrees as to your Honors shall seem meet in the premises.

And your orators will ever pray, etc.

LUBY & PEARSON.
SCRIVNER & MONTGOMERY.

Solicitors for Complainant.

JOHN V. PEARSON J. J. SCRIVNER,

Of Counsel for Complainant.

United States of America, Eastern District of Washington, County of Spokane.—ss.

JAMES P. SHAFFER, being first duly sworn, deposes and says: That he is an officer, to-wit: President, of the Diamond Patent Company, a corporation, the complainant named in the foregoing bill of complaint; that he has read the bill of complaint and knows the contents thereof and that the same is true of his own knowledge except as to matters which are therein stated on his information and belief, and that as to those matters he believes it to be true.

JAMES P. SHAFFER,

President.

Subscribed and sworn to before me this 23d day of April, 1912.

(Seal)

M. J. LUBY,

Notary Public in and for the State of Washington, Residing at Spokane.

Endorsements: Bill of Complaint.

Filed in the U. S. District Court for the Eastern District of Washington, May 9, 1912.

W. H. HARE, Clerk.

By S. M. Russell, Deputy.

United States District Court, For the Eastern District of Washington, Northern Division.

NO 1365.

DIAMOND PATENT COMPANY (a Corporation), Complainant,

US.

THE S. E. CARR COMPANY (a Corporation),

Respondent.

Answer of The S. E. Carr Company, a Coporation, to the Bill of Complaint.

This defendant reserving all manner of exceptions that may be had to the uncertainty and imperfection of the bill, comes and answers thereto, or to so much thereof, as it is advised is material to be answered, and says:

1.

It admits that it is a corporation duly organized and existing under the laws of the State of Washington, but whether complainant is a corporation duly organized and existing under the laws of the State of California respondent does not know and has no information, except as contained in the complaint, which it neither admits or denies.

2.

Respondent admits that on the 17th day of October, 1905, letters patent of the United States, bearing said date, and numbered 801,944, were granted to one Fred Weber for alleged improvement in show cases, but whether said patent was duly applied for and issued according to law, respondent does not know, and whether the complainant has acquired title to said patent or any interest therein, respondent does not know, and upon all and each of these matters the complainant is required to make proof.

3.

Further answering on information and belief, respondent denies that Fred Weber was the original and first inventor of the apparatus covered by said patent No. 801,944, and it avers that said apparatus and said

patent described, was not an invention when produced by said Fred Weber, and that it was not novel at that time, and that in the state of the art then existing it required not invention, but only mechanical skill to produce said apparatus and that the same when produced by said Fred Weber was not a patentable combination, but a mere aggregation.

4.

Further answering respondent on information and belief denies that said alleged invention was new and that it was not known and that it was not used by others before the alleged invention thereof by the said Fred Weber, but on the contrary alleges that the said alleged invention was in public use and on sale in this country more than two years before the said Fred Weber made any application for letters patent thereon, and that the said Fred Weber actually abandoned the said invention before any application was made.

5.

Respondent does not know whether said alleged invention had or had not been patented or described in any printed publication in this or any foreign country before the alleged invention thereof by the said Fred Weber prior to his application for patent therefor, and as to such matter, if deemed material, complainant is required to produce proof.

6.

Further answering on information and belief, respondent denies that complainant or its assignor have invested and expended large sums of money in the manufacture of show cases under and in accordance

with said letters patent for the purpose of selling same and making said alleged invention profitable and useful to the public, and further denies that complainant has made and sold large numbers of such show cases throughout the United States and denies that complainant is now actively engaged in the manufacture and sale thereof, and denies that said alleged invention is of very great benefit and advantage and denies that the validity of said patent, the assignment thereof, or the alleged right of complainant thereunder, have been generally recognized and acquiesced in, by the public and denies any invasion or profits arising therefrom of complainant's alleged rights under said patent, and likewise denies that it has ever deprived complainant of any gains or profits from the practise of said alleged invention.

7.

Further answering respondent denies that it has ever made or used any apparatus covered by said patent in said bill of complaint mentioned, and denies all infringement of said patent, and likewise denies that it ever derived any profit from such making or using and likewise denies that the complainant ever incurred any damage from any such transactions committed or caused to be committed by the respondent, in defiance of any rights acquired by and secured to complainant.

8.

Answering the Fifth paragraph of the bill of complaint herein, on information and belief, respondent denies that complainant has always sought to maintain the sole and exclusive right to practise said 12 Diamond Patent Company, Appellant, vs.

alleged invention, and that it has not acquiesced in infringement of its alleged exclusive rights under said patent.

9.

Further answering, respondent says it is not true that complainant has not a plain and adequate remedy at law for the recovery of any damage or injury it may show it has sustained herein.

Having thus made full answer to all the matters and things contained in the bill, respondent prays to be dismissed hence with its costs in this incurred.

> S. E. CARR COMPANY, By MORRILL, CHESTER & SKUSE,

> > Its Attorneys,

745 Peyton Bldg., Spokane, Wn.

Endorsements: Service of the within answer is admitted this __ day of June, 1912, by acceptance of a copy thereof.

Answer.

Attorneys for Complainant.

Filed in the U. S. District Court for the Eastern District of Washington, July 1, 1912.

W. H. HARE, Clerk. By S. M. Russell, Deputy.

In the District Court of the United States, Eastern District of Washington, Northern Division.

NO. 1365.

DIAMOND PATENT COMPANY, a Corporation, Complainant,

US.

THE S. E. CARR COMPANY, a Corporation,

Defendant.

REPLICATION.

Complainant, saving and reserving unto itself all and all manner of advantage of exception to the manifold insufficiencies of the said answer, for replication thereunto says:

That it will aver and prove its said Bill of Complaint to be true, certain and sufficient in law to be answered unto, and that the said answer of the said defendant is uncertain, untrue and insufficient to be replied unto by this replicant, all of which matters and things this replicant is and will be ready to aver and prove as this Honorable Court shall direct, and humbly prays as in and by its said Bill of Complaint it has already prayed.

> (Signed) LUBY & PEARSON, Attorneys for Complainant, (Signed) JOHN V. PEARSON and SCRIVNER & MONTGOMERY,

> > Of Counsel.

Endorsements: Replication.

Due service and receipt of a true copy of within replication is hereby admitted this 12th day of September, 1912.

(Signed) MORRILL, CHESTER & SKUSE, Attorneys for Defendant.

Filed July 12, 1912.

W. H. HARE, Clerk. By S. M. Russell, Deputy. 14 Diamond Patent Company, Appellant, vs.

In the District Court of the United States, Eastern
District of Washington, Northern Division.

No. 1365.

DIAMOND PATENT COMPANY, a Corporation, Complainant,

US.

THE S. E. CARR COMPANY, a Corporation,

Defendant.

MOTION TO AMEND ANSWER.

Comes now the S. E. Carr Company, defendant in the above cause and moves the court for leave to file the following amendment to its answer filed in this cause, on the first day of July, 1912, to-wit; By adding after the first two words on the eighth line of the fourth paragraph of the second page of said answer, the following:

"That more than two years prior to the application of said Fred Weber for letters patent for the alleged invention, William J. Whitcomb, whose business address is southeast corner Eighteenth and Wyandott, Kansas City, Mo., and who resides at 506 Gladstone Boulevard, in said city, and George W. Whitcomb, whose residence is 3338 Peery Avenue, in Kansas City, Mo., manufactured and sold in the market in this country, the identical show case which is the subject of the alleged invention; that Warren J. Gurney, operating a jewelry store at 117 E. Eleventh Street, Kansas City, Mo., residing at 3211 Wayne Avenue, in said last named city; also William M. Federman, whose business address is 904 Main Street, in Kansas City, Mo., residing at 3119 Paseo Street, in said city; also

Soloman Kaufman, whose business address is 407 Gordon & Koppel Building, Kansas City, Mo., residing at 3204 Windsor Avenue, in said city; also H. J. Ernest, whose business address is 1720 E. Ninth Street, Kansas City, Mo., residing at 624 Highland Avenue, in said city and — — Ware, whose given name is to the defendant unknown, who resides in Kansas City, Mo., and whose exact address is likewise to defendant unknown, each and all, more than two years prior to said application by said Fred Weber for letters patent for said alleged invention, bought, owned and used, many of said show cases, in this country, which are identical with the show cases covered by said alleged invention and described in the application of said Fred Weber for letters patent and described in the patent mentioned and described in the bill of complaint in this case."

That said amendment is material and necessary to a proper defense of this case, and that the matter set up by way of amendment, was not known to defendant prior to filing the original answer.

WHEREFORE, defendant prays that said amendment be allowed upon such terms and conditions as the court may prescribe, which terms and conditions defendant now accepts, and be considered as a part of the answer on the hearing of this cause.

(Signed) MORRILL, CHESTER & SKUSE and S. H. CUTTING,

Attorneys for Defendant.

16 Diamond Patent Company, Appellant, vs.

STATE OF WASHINGTON, County of Spokane.

S. E. Carr, after being first duly sworn on oath, deposes and says: That he is the president of the S. E. Carr Company, defendant in the above styled cause; that the foregoing motion is not vexatiously made, nor for delay; that the amendment contained therein is material and could not with reasonable diligence have been sooner introduced into the answer; that the names and residences of the parties therein named, and the manufacturing and sale and the purchase and use of the show cases mentioned therein, were not known to the defendant, until long after the filing of its answer herein, nor until the 12th day of September, 1912.

(Signed) S. E. CARR.

Subscribed and sworn to before me this 12th day of September, 1912.

(Signed) FRED B. MORRILL,

Notary Public for Washington, Residing at Spokane, Washington.

(Seal)

Endorsements: Service of the within motion and amendment to answer is hereby admitted at Spokane, Wash., this — day of September, 1912.

Attorneys for Complainant.

Motion to Amend and Amendment to Answer. Filed in the U. S. District Court for the Eastern District of Washinton, September 13, 1912.

> W. H. HARE, Clerk. By Frank C. Nash, Deputy.

In the District Court of the United States, Eastern District of Washington, Northern Division.

NO. 1365.

DIAMOND PATENT COMPANY, a Corporation, Complainant,

US.

THE S. E. CARR, COMPANY, a Corporation,

Defendant.

ORDER GRANTING LEAVE TO AMEND ANSWER.

This cause coming on to be heard in chambers on motion of defendant to amend its answer and it appearing to the court that notice was served upon the plaintiff and it appeared not, and the court being fully advised of the amendment sought to be made to the answer of defendant heretofore filed in this cause on the 1st day of July, 1912, it is hereby,

ORDERED, ADJUDGED and DECREED, That the motion be granted and that the amendment as set forth in the motion be separately engrossed and the clerk of this court is hereby ordered to file the same as of the date of this order as an amendment to the original answer.

In Chambers September 16, 1912.

(Signed) FRANK H. RUDKIN,

Judge.

Endorsements: Order Granting Leave to Amend Answer.

Filed in the U. S. District Court for the Eastern District of Washington, September 16, 1912.

W. H. HARE, Clerk. By S. M. Russell, Deputy.

18 Diamond Patent Company, Appellant, vs.

In the District Court of the United States, Eastern District of Washington, Northern Division.

NO. 1365.

DIAMOND PATENT COMPANY, a Corporation, Complainant,

US.

THE S. E. CARR COMPANY, a Corporation.

Defendant.

STIPULATION.

It is hereby stipulated by and between the parties hereto that the defendant may amend its amended answer by inserting the words "to-wit: in Kansas City, Missouri," in the seventh line of the second page of Amendment to Defendant's Answer immediately following the words "many of said show cases, in this country" and that said amendment may be made by interlineation.

(Signed) LUBY & PEARSON.

(Signed) JOHN V. PEARSON, of Counsel.

Attorneys for Plaintiff.

(Signed) MORRILL, CHESTER & SKUSE, and S. H. CUTTING.

Attorneys for Defendant. (Signed) SCRIVNER & MONTGOMERY, Solicitors for Complainant.

Endorsements: Stipulation Amending Answer. Filed in the U. S. District Court for the Eastern District of Washington, October 7, 1912.

W. H. HARE, Clerk. By Frank C. Nash, Deputy.

United States District Court for the Eastern District of Washington, Northern Division.

NO. ——

DIAMOND PATENT COMPANY, a Corporation, Complainant,

US.

S. E. CARR COMPANY, a Corporation,

Defendant.

AMENDMENT TO DEFENDANT'S ANSWER.

By leave of the court heretofore granted, defendant amends its answer filed herein on the 1st day of July, 1912, by adding after the first two words on the eighth line of the fourth paragraph of the second page of said answer, the following:

"That more than two years prior to the application of said Fred Weber for letters patent for the alleged invention, William J. Whitcomb, whose business address is southeast corner of Eighteenth and Wyandott, Kansas City, Mo., and who resides at 506 Gladstone Boulevard, in said city, and George W. Whitcomb, whose residence is 3338 Peery Avenue, in Kansas City, Mo., manufactured and sold in the market in this country, the identical show case which is the subject of the alleged invention; that Warren J. Gurney, operating a jewelry store at 117 E. Eleventh Street, Kansas City, Mo., residing at 3211 Wayne Avenue, in said last named city; also William M. Federman, whose business address is 904 Main Street, in Kansas City, Mo., residing at 3119 Paseo Street, in said city; also Soloman Kaufman, whose business address is 407 Gordon & Koppel Building, Kansas City, Mo., resid20 Diamond Patent Company, Appellant, vs.

ing at 3204 Windsor Avenue, in said city; also H. J. Ernst, whose business address is 1720 E. Ninth Street, Kansas City, Mo., residing at 624 Highland Avenue, in said city, and — — Ware, whose given name is to defendant unknown, who resides in Kansas City, Mo., and whose exact address is likewise to defendant unknown, each and all, more than two years prior to said application by said Fred Weber for letters patent for said alleged invention bought, owned and used, many of said show cases, in this country, to-wit: in Kansas City, Missouri, which are identical with the show case covered by said alleged invention and described in the application of said Fred Weber for letters patent and described in the patent mentioned and described in the bill of complaint in this case."

(Signed) MORRILL, CHESTER & SKUSE, and S. H. CUTTING.

Attorneys for Defendant, Suite 745 Peyton Bldg., Spokane, Wash.

Endorsements: Amendment to Defendant's Answer. Filed in the U. S. District Court for the Eastern District of Washington, September 16, 1912.

W. H. HARE, Clerk. By S. M. Russell, Deputy.

In the District Court of the United States, Eastern District of Washington, Northern Division.

No. 1365.

DIAMOND PATENT COMPANY, a Corporation, Complainant,

US.

THE S. E. CARR COMPANY, a Corporation,

Defendant.

STIPULATION.

It is hereby stipulated that plaintiff's replication now on file may stand as the replication to the amended answer filed herein.

Dated this 20th day of September, 1912.

(Signed) LUBY & PEARSON, Attorneys for Plaintiff.

(Signed) MORRILL, CHESTER & SKUSE, Attorneys for Defendant.

(Signed) SCRIVNER & MONTGOMERY. By John V. Pearson, of Counsel for Complainant. Endorsements: Stipulation.

Filed in the U. S. District Court for the Eastern District of Washington, September 12, 1912.

W .H. HARE, Clerk. By S. M. Russell, Deputy.

In the District Court of the United States for the Eastern District of Washington, Northern Division.

NO. 1365.

DIAMOND PATENT COMPANY, a Corporation, Plaintiff,

US.

S. E. CARR COMPANY, a Corporation,

Defendant.

IN EQUITY.

CONDENSED STATEMENT OF THE TESTI-MONY TAKEN IN THE ABOVE ENTITLED ACTION.

For the purpose of establishing its case the Counsel for the respective parties met at the office of J. H. PELLETIN on the 6th day of August, 1912, at the

hour of ten o'clock A. M., whereupon the following proceedings were had for and on behalf of the plaintiff, as appears from the report of said J. H. PELLETIN, the Commissioner appointed to take the testimony in the cause, which is as follows:

The examination of witnesses in the above entitled suit in equity was held, beginning on the 6th day of August, 1912, at the hour of 10 o'clock a. m. on behalf of the complainant, before me, a special examiner. duly appointed and authorized to administer oaths and to take and certify said depositions, at my office, 615 The Rookery Building, Spokane, Washington, in a certain suit now pending and entitled In the United States District Court, for the Eastern District of Washington, Northern Division, holding terms at Spokane, in the District Court aforesaid, wherein the above named Diamond Patent Company, a corporation, is complainant and The S. E. Carr Company, a corporation, is defendant, the complainant appearing by Scrivner & Montgomery, and Luby & Pearson, their counsel, and the defendant appearing by Messrs. Morrill, Chester & Skuse, and S. H. Cutting, Esq., their counsel:

That the following evidence and proceedings were had and taken, to-wit:

The complainant produced before the examiner the articles of incorporation of the complainant and exhibited the same to counsel for defendant, whereupon it was admitted by the defendant that the plaintiff was a corporation duly organized and existing, as alleged in the bill of complaint.

The complainant thereupon presented the original letters patent referred to in the bill of complaint and by consent of counsel for defendant was permitted to file, in lieu of the original, a copy thereof, which copy was admitted in evidence marked PLAINTIFF'S EXHIBIT A. ADMITTED.

Complainant thereupon produced the original assignment of said patent sued upon, from Fred Weber to the complainant, and by consent of counsel was permitted to file a copy thereof in lieu of the original, which original complainant's counsel was allowed to retain. Assignment admitted in evidence marked PLAINTIFF'S EXHIBIT B. ADMITTED.

In order to prove the alleged infringement, by stipulation of the respective counsel the complainant produced and filed a stipulation admitting the infringement as alleged in the complaint, which stipulation was admitted in evidence and marked PLAINTIFF'S EXHIBIT C. ADMITTED.

Complainant's counsel thereupon, to prove the averments of the complaint, of the marking of the show cases made under the plaintiff's patent produced one of the labels containing the date of the patent, as required by law, and Mr. J. J. Scrivner, one of counsel for complainant, was permitted to state as an officer of the court that he was familiar with the matter and knew of his own knowledge that these stamps were required to be placed upon all show cases made by or under the authority of the complainant and all of its licensees and representatives, which label was admitted in evidence marked PLAINTIFF'S EXHIBIT D. ADMITTED.

EXAMINER'S CERTIFICATE.

I, DO HEREBY CERTIFY that the foregoing evidence, and the whole thereof, was duly taken before me on the dates and at the places named in connection with the taking of said evidence; that during all the taking of said evidence the complainant appeared and was represented by Messrs. Scrivner & Montgomery, and Luby & Pearson, their counsel, and the defendant appeared and was represented by Messrs. Morrill, Chester & Skuse and S. H. Cutting, Esq., their attorneys; and I do further certify that the several exhibits which accompany this evidence were offered in evidence as noted therein, and in the report of the taking thereof.

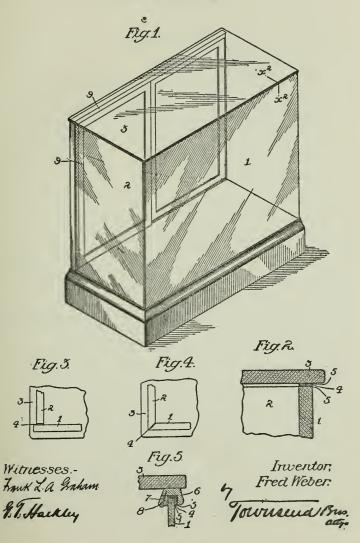
WITNESS MY HAND, at Spokane, Washington, this 6th day of August, A. D. 1912.

> (Signed) J. H. PELLETIN, Examiner.

No. 801,944.

PATENTED OCT. 17, 1905.

'F. WEBER.
SHOW CASE.
APPLICATION FILED 00T. 3, 1004.



UNITED STATES PATENT OFFICE.

FRED WEBER, OF LOS ANGELES, CALIFORNIA.

SHOW-CASE.

No. 801,944.

Specification of Letters Patent.

Patented Oct. 17, 1808.

Application filed October 3, 1994. Serial No. 228.882.

To all whom it may concern:

Be it known that I, FRED WEBER, a citizen of the United States, residing at Los Angeles, in the county of Los Angeles and State of California, have invented a new and useful Show-Case, of which the following is a specification.

This invention relates to improvements in glass show-cases; and the improvement resides particularly in the means for fastening one glass surface to another glass surface or to woodwork forming part of the case.

one glass surface to another glass surface or to woodwork forming part of the case.

The object of the invention is to do away with drilling holes through the glass and to dispense with metallic or other fastening deals vices which are commonly used at the corners for holding the plates forming the case together and to provide a fastening which will unite the parts so securely that they cannot be separated except by such stresses or blows on a would break the glass before accomplishing the dismemberment, although by the use of a proper tool the parts may easily be separated.

Another object is to provide for a certain cushion effect is produced. If the parts were rigidly united, severe shocks received by the show-case would tend to shatter the plates or displace the parts; but in the present invention the cushion-joint aids in maintaining the union of the parts, affording, as it does, an elastic or resilient joint, which eases the strain at the actual union or contact-faces of the plates, thereby also greatly softening the efforts of shocks received by the case.

The accompanying drawings illustrate the invention, and, referring thereto, Figure 1 is a perspective view of a show-case the plates of which are fastened together with my im
to proved means. Fig. 2 is an enlarged sectional view on line x^2x^2 , Fig. 1. Fig. 3 is a bottom plan of a corner, showing the manner of fastening the side plates to the top. Fig. 4 is a view similar to Fig. 3, illustrating a 45 miter-joint. Fig. 5 is a sectional view illustrating the method of fastening glass plates with an intervening strip of molding.

The invention comprises in combination with the parts to be united, such as glass or 50 other material having a vitreous surface, a strip of yielding material, such as felt, which is interposed between the adjacent faces to be united, each face of the yielding material having a coating of cement, which forms the

union between the yielding material and the 55

surface of the adjacent part.

Referring particularly to Fig. 2, 1 designates the front plate. 2 is the side plate, and a is the front place. 2 is the side plate, and 3 is the top plate, resting upon the front and side plates with a strip of felt 4, which lies 60 upon the top edge of the side plates 1 and 2, both top and bottom faces of the felt 4 having cement 5, which unites the plates to the felt. The cement is applied to the felt superficially, forming a skin, as it were, on both sides of 65 the felt, the body of the felt thus retaining its natural state. If the cement were applied to the felt so as to permeate the same, by uniting with the felt it would form a hard practically homogeneous substance, thus de- 70. stroying the resiliency of the felt. The ce-ment should be applied to the felt when quite thick, so that it will not soak into the felt. Thus a laminated structure is produced comprising the two layers of cement, with an 75 intervening layer of felt forming the yielding or resilient substance. Any desired form of cement may be used for this purpose, and yielding or resilient substances other than felt could be employed, which selections are ob- 80 viously embraced in the scope of my inven-

In Fig. 3 the front plate 1 extends slightly beyond the outside face of the side plate 2, as shown, the top plate 3 preferably overhang. So ing both the front and side plates, so as to give a neat finish to the case.

Fig. 4 shows the side plate 2 and front plate 1 united with a miter-joint with the intervening laminated felt and cement structure. 90 This method gives a greater area of union between the front and side plates and in some

cases may be preferred.

Fig. 5 shows a rabbeted molding 6, which rests upon the front plate 1, the top plate 3 presting upon the molding 6, the felt and cement structure being located between the molding and glass, as shown. A strip 7 extends along inside the plate 1, being fastened to the molding 6 by pins 8 or any other suitable means, the strip holding the plate 1 in place on the molding 6. This method of union permits easy assembling of the parts.'

The construction shown in Fig. 5-enables thin glass to be used affording sufficient ce-105 menting area, the narrow thin edge alone not

giving sufficient cementing area. At the back of the case, where the glass

2 801 944

plates fasten to the wooden structure 9, as shown in Fig. 1, the same fastening means, consisting of the laminated structure of felt and cement, is also employed with equally 5 good results.

The cement may be silvered, if desired, to give a neat appearance when seen through the glass, or it may be colored green, or any other color, green being preferred for both felt and

10 cement.

Parts which have been united in this manner cannot be separated without breaking the glass, except by running a sharp knife through the felt between the two layers of cement.

15 This feature is one of considerable value, inasmuch as it permits of easy removal of a plate when desired, as in altering the structure of the case or in making repairs when one or more of the glass plates become broken. They ieldson nature of the felt cushion absorbs the sharpness of shocks on the case and obviates breakage, which so frequently happens with all other forms of fastenings now known, particularly metallic corner-fastenings or structure.

25 tures in which a glass plate is grooved to receive the edge of another glass plate, which parts are united by cennent at the groove, or show-cases in which the vertical glass plates are tightly fitted in grooved frames of wood 39 or other material. In the latter structures severe shocks imparted directly to the front

severe shocks imparted directly to the front or side plates will fracture them, as a side plate has no interresiliency with the front plate or top frame; but the present invention avoids 35 this difficulty, as there is interresiliency with both to paral vertical plates which illegrees he

both top and vertical plates which allows each plate to move relatively to the other, whether one plate alone is jarred or whether all plates are jarred simultaneously, so that each plate to vibrates its own degree and direction. The effect of this is particularly noticeable at the

effect of this is particularly noticeable at the corners formed by the junction of three plates—the top plate, a side plate, and front plate—as at the corners referred to unless perfect cushioning of each plate is provided 45 a fracture is very likely to occur, resulting from the rigidity of the three-line joint and the unequal rate of vibration of the respective three plates and the conflicting directions or planes of vibration centering at one point, 50 and so far as I am aware I am the first inventor to provide a structure comprising glass plates arranged in three different planes, each plate meeting and joining the other two, with an intervening cushion between the joining 55 faces, to which cushion the glass plates are cemented.

What I claim is

1. A structure comprising a plurality of glass plates, the edges of which are spaced 60 from the adjacent plates, a felt cushion filling the space between the adjoining plates, the plates being elemented to the felt, each plate being adapted to freely vibrate in its natural plane of vibration, and prevented by the felt 65 cushion from imparting its vibration to the adjacent plates.

2. A structure comprising a plurality of glass plates, an unconfined edge of one plate nearly but not quite meeting another plate also 70 with unconfined adjacent edge, an elastic material filling the space thus existing between the nearest adjacent surfaces of the plates, said plates being attached to the elastic material, whereby the plates by reason of their 75 unconfined edges and the intervening elastic

material can each vibrate or move in any direction independently.

In testimony whereof I have hereunto set my hand, at Los Angeles, California, this 24th 80 day of September, 1904.

FRED WEBER.

In presence of— GEORGE T. HACKLEY, FREDERICK S. LYON. Whereas, I, Fred Weber, of Los Angeles, County of Los Angeles, State of California, did obtain letters patent of the United States for an improvement in show cases, which letters patent are numbered 801,944 and bear date the 17th day of October, in the year 1905; and whereas I am now the sole owner of said patent and of all rights under the same; and whereas the Diamond Patent Company, a corporation, duly organized under the laws of the State of California and having its principal place of business in the city and county of San Francisco, of said state, is desirous of acquiring the entire interest in the same;

Now, therefore, to all whom it may concern, be it known that, for and in consideration of the sum of One (1) Dollar to me in hand paid, the receipt of which is hereby acknowledged, I, the said Fred Weber, have sold, assigned, and transferred, and by these presents do sell, assign, and transfer unto the said corporation, the whole right, title, and interest in and to the said improvement in show cases and in and to the latters patent therefor aforesaid and to all rights of recovery for past infringements, the same to be held and enjoyed by the said corporation for its own use and behoof, and for the use and behoof of its legal representatives, to the full end of the term for which said letters patent are or may be granted, as fully and entirely as the same would have been held and enjoyed by me had this assignment and sale not been made.

In testimony whereof I have hereunto set my hand and affixed my seal at Los Angeles, in the county of Los Angeles, and State of California, this 5th day of February, 1910.

(DULY ACKNOWLEDGED)

(SEAL) (Signed) FRED WEBER.

The stipulation referred to is as follows:

In order to expedite the trial of this cause, and inasmuch as there is no genuine dispute as to the facts of the alleged infringement, the defendant, the S. E. Carr Company, hereby admits that prior to the filing of the complaint in this cause, the Pacific Scale and Show Case Company made for defendant's use and it is now using and intends to continue to use, in the Eastern District of Washington, Northern Division, and within the jurisdiction of this court, unless restrained by an injunction of this court, one or more show cases, made in substantial accordance with the claims, specifications and drawings of the letters patent sued on, to-wit: Letters Patent No. 801,944, dated October 17th, 1905, and which show cases are so being used by defendant for substantially the same purpose, object and result described in and covered by said patent.

(Signed) LUBY & PEARSON and

(Signed) SCRIVNER & MONTGOMERY,

Attorneys for Plaintiff.

(Signed) MORRILL, CHESTER & SKUSE, Attorneys for Defendant.

Thereupon the plaintiff rested.

Thereafter, on the 24th day of October, pursuant to the notice set up in the answer and supplemental answer of the defendant, counsel for plaintiff and de30

Testimony of William G. Whitcomb.

fendant appeared before Genevieve Parlin, a Notary Public, in and for the County of Jackson, State of Missouri, who was selected and agreed upon by stipulation to take and report the testimony offered by the defendant (plaintiff being represented by Mr. J. J. Scrivner and the defendant by its counsel, Mr. A. L. Cooper); whereupon the following witnesses were examined and their testimony taken and reported, to-wit:

WILLIAM G. WHITCOMB, being duly sworn, testified; That he had resided in Kansas City, Missouri, for about thirty years, and that he was fifty years of age; that he was a cabinet maker by trade; that his firm name was: "Whitcomb Cabinet Company," which was a corporation, and that he was president thereof; that the corporation had been in existence about ten years, and that prior to that time his business had been carried on under the same name, as a partnership; that the business of the partnership and corporation had been the manufacture of store fixtures, bank fixtures, show cases, general cabinet work, and anything of that kind; that he had been in the shop almost continually, and had had practical experience as a mechanic in the making of show cases for about thirty years. "We made a regular line of show cases with mouldings, and then we made what we called 'all glass cases,' that is, without any moulding or wood across the front or ends, fastened with metal clips, and we made others with felt joints cemented, some with felt and some with rubber, and some with paste preparation—sort of a putty that we put in the joints.

"In 1899 and 1900 we put in a bunch of these cases

Testimony of William G. Whitcomb.

in Joplin, Missouri, for the Cooper Drug Company; there were ten of these Joplin cases. These Joplin cases had screws or bolts in the back corners and some of them one also in the middle. We also made some about the same time for Federmann, which were made substantially the same as the Joplin cases. The glass plates in these Joplin and Federmann cases were fastened together with a preparation that I made myself; it was not ordinary cement. I would go into a drug store and get the druggist to give me some drug and fix up some stuff and call it cement; I might have called it something else, but did not; I might have called it 'dog,' but didn't. These cases are all in existence yet. The glass plates in these Joplin cases were fastened together with a preparation I got up myself, and I called it 'cement.' I have not got any of it; it has to be used right away. The ones I put in recently have only been small jobs-individual cases. I have not fitted up any store with any great amount; didn't like to make them; didn't want to make them; talked a fellow out of them. If a fellow came in and wanted one case I would talk him out of it. My custom has been to advise people not to take them. When I made these Joplin cases I made up my mind that I didn't like the cases very well. I am willing for both sides to assume that the Federmann cases and the Joplin cases would be a fair representation of my idea of how I manufactured cases in 1898 and 1905, and along there. I don't think these all-glass show cases are a good, practical proposition—those that I have seen. I think a case in a frame is far better; I do not consider any

Testimony of William N. Federmann.

of them a success. The drug company cases at Joplin had felt joints; the other material used by me in making them was cement; I made it myself; it was a special material—something I worked out myself; natuarally didn't publish it; it was a special preparation which I called 'cement.' It was a soft materialsomething like paint; we could pour it from one vessel to another. I suppose it would have a tendency to harden, naturally most anything would evaporate or harden. It permeated the felt at first, and then I got a felt that we had treated, waterproof. I can't think what we called it. You can take any piece of cloth and have the piece sort of water-proofed so as to cause your cement from soaking through."

Thereupon MR. WILLIAM N. FEDERMANN was sworn, examined and testified on behalf of defendant as follows:

"I have resided in Kansas City for twenty-five years; I have been engaged in the drug business for thirty years. I know Mr. Whitcomb. About April, 1900, I put four or five show cases up from the Whitcomb Cabinet Company, which are installed at No. 904 Main Street, Kansas City. It is here agreed, that the four or five Federmann cases were made substantially like the Cooper Drug Store cases, commonly known in this record as: 'The Joplin cases.' I think—so far as my impression and observation goes—the joints were solid tight joints; that the glue or cement, or whatever material was put in between the glass plates, made a solid joint, as I understand it, and that-according to my knowledge, information and observation

Testimony of Gustolf A. Hohm, and H. W. Jackson.—during all these years there is no elasticity in the joints at all; none that I know of. All the cases furnished me by Mr. Whitcomb (as heretofore testified) came with the bolts in the corners, as shown by the exhibit of the Joplin Drug Store Company's case on file in this cause, with the exception of some of them had bolts in the middle of the case along the back rail."

GUSTAV A. HOLM, being duly sworn, testified on behalf of the plaintiff, and stated as follows:

"I have repaired a number of the Whitcomb all-glass show cases; they were put together with some kind of a composition; I couldn't tell you what it is, but it seemed to be a very hard substance after it dried. It made a hard, solid joint. I do not know what kind of a paste or cement or glue or what it was; couldn't tell anything about it. I saw some rubber in some of the joints and some other substance there that must have been soft when it was put on; some kind of a paste."

H. W. JACKSON, being duly sworn, testified for the plaintiff, and stated as follows:

"I am a licensee of the plaintiff in this suit; I know the Whitcomb Company (an extensive manufacturer of show cases and all kinds of fixtures). I had a conversation with Mr. Whitcomb some four or five months ago about all-glass cemented show cases; he said they were no good; he denounced the cases as being no good on account of breakage that might occur in them, and the inaccessibility of the joints to be repaired; it was a hard matter to fix them when they got broken; he had found that his trade preferred to have the cases 34

Testimony of H. W. Jackson.

with clamps or with holes bored through the plates on account of the ease with which this kind of case could be repaired; also, that they could be shipped knocked down, which would be an impossibility in shipping a cement case, on account of its having to be shipped set up. I have been manufacturing the plaintiff's patented show case quite extensively; they have generally been very satisfactory to customers. All-glass cases can be shipped set up without any difficulty. The Weber patented show case has a frame work at the back over which the top glass rests; the back frame work is cemented to the glass like the front; the wood is cemented to the glass. We use a felt strip in there between the wood and the glass. I know of some of the all-glass cases made by the Whitcomb Company back in 1902 and 1903 and along there, and know how they are made. The glass cases: there were joints made to look like glue had been used, or some other substance; seemd to be very hard and chipped the under side of the top plate of glass and made them unsightly. We repaired two of them. The joints in the cases repaired by us were solid and rigid."

Thereafter, on or about the 20th day of January, 1913, before D. B. Richards, a Notary Public in and for the City and County of San Francisco, State of California, and by and pursuant to stipulation entered into by and between the parties in this suit, the following witnesses were duly sworn, and testified on behalf of plaintiff, as hereinafter stated, to-wit: Fred Weber, James P. Shaffer, William E. Price, and A. C. LaRue Shaffer.

Testimony of Fred Weber.

FRED WEBER was thereupon sworn and testified as follows:

"I am forty-one years of age and reside in Los Angeles, California. I am the Fred Weber mentioned in the Letters Patent No. 801,944, dated October 17th, 1905, which is the basis of this suit. I am familiar with the plaintiff's patent. I went into the show case business about 1901 or 1902, in Los Angeles. I started to experiment along somewhere about 1904 on an allglass cemented show case, and after experimenting a few months found we could make a success with the case. We made quite a few cases; we took orders for cases, and in fact, shipped some of them, and found that they were a great success. Of course, as soon as I found that the cases would be a success, I applied for a patent and went into it deeper all the time and made a great number of cases. About 1909 we made a canvass on account of the high insurance rates; we found out the extent of the use of the cases. We went through our books and hunted up our customers to find out how many cases they had, how long they had them, and the extent of their breakage, and we had in all, approximately, fifteen thousand lineal feet, that was in 1909. And on the showing we made, that is the little breakage, we have shown the insurance companies that they could lower the insurance rate and still insure at a profit. The business grew to such an extent that I could not personally handle it any more in connection with my own business, and we sold the patent to the Diamond Patent Company of San Francisco, the plaintiff herein; this was in 1909. So far as Testimony of James P. Schaffer.

I know, I was the first and original inventor of this device described in the patent. I have absolutely no trouble in repairing any cases. I have no trouble in setting them up. You can employ an inexperienced helper in that class of work. Never have had any trouble in breakage in shipping the cases. We formed an elastic cushion joint; that was one of the principal features of the case, because it could be repaired easy. I had seen show cases where the top plates were bolted onto the woodwork, making a solid joint; that was what I was endeavoring to get away from; I wanted an elastic joint, and I got it."

MR. JAMES P. SHAFFER was thereupon duly sworn, and testified as follows:

"My name is James P Shaffer; I am thirty-one years of age, residing at San Francisco, California. I was one of the incorporators of the Diamond Patent Company, and am president of the company now. The company was incorporated in 1909. I am actively employed in the business of the corporation. The principal business of the corporation is licensing manufacturers to manufacture the article described as a 'show case' throughout the United States. The company owns the patent and licenses manufacturers, collecting the royalties. I am also connected with the Diamond Patent Show Case Company, which is also a corporation engaged in the manufacture of the patented show case under a license from the plaintiff. I know Mr. W. G. Whitcomb of Kansas City. About 1906, when myself and my brother determined to take over this show case business, I-in company with Mr. WilsonTestimony of William E. Price.

went east on the business. Among other places, we went to Kansas City and called on Mr. Whitcomb. Our object was to find a manufacturer in Kansas City to whom we could give a license to manufacture this case. We put the proposition up to them, that we had a cement all-glass show case on which we were licensing manufacturers under a royalty basis; we had a sample with us to show persons what the proposition was. Mr. Whitcomb, after examining the model, stated to us that he did not think we would find it a good proposition on account of the elasticity which we had in the joints, and he told me then and there, that he had tried cemented show cases, but had found them unsatisfactory; in fact, he said they were so unsatisfactory he was going to discontinue the manufacture of them, and then he went to his desk and brought forth a metal clamp, which is very commonly known in the show case business. We issued licenses to manufacturers in Salt Lake, Denver, Kansas City, Omaha, Des Moines, Indianapolis, Cincinnati, Columbus, Ohio; Pittsburg, Cleveland, Toledo, Detroit, Buffalo, Albany, Boston, Columbus, Georgia; New Orleans, and possibly some others. All of these licenses are still in existence. We have shipped cases as far as Manila, Philippine Islands, and Sydney, Australia, without any trouble."

WILLIAM E. PRICE was thereupon sworn and testified as follows:

"I am forty-seven years of age; in the drug business in Joplin, Missouri. I know Mr. W. G. Whitcomb, of Kansas City. I bought show cases of him; they are in the store there now. I remember the occasion of Testimony of A. C. LaRue Shaffer.

getting them from Mr. Whitcomb; it was in the years 1899 or 1900; I got ten; they were shipped knocked down. Mr. Whitcomb came down from Kansas City and set them up. I helped him set up eight of the cases; the other two I put up myself after he left." Being asked how the cases were constructed, the witness said: "There was the base and back frame. We put the back frame in the base and the end glass in, then the front glass, then the top glass, and on the top of each glass, or edge of each glass, we put on felt and glue, and that is the way they were held together, and the back part of the case had bolts or screws fastened down tight; the back had felt along the back rail with no glue or cement; the glass plate on the back edge was bolted down to the wood without glue. The insurance companies refused to insure them while they had the bolts along the back rail. The material used in the bolts looked to me just like ordinary liquid glue; it was some material that Mr. Whitcomb brought with him "

A. C. LARUE SHAFFER, being first duly sworn, testified as follows:

"I am secretary of the Diamond Patent Company, also of the Diamond Patent Show Case Company; I am twenty-eight years of age, residing in San Francisco. I know the Weber patent. I know how the case described therein is made. Our cases have given satisfaction to the purchasers and users; never have had any complaint since we have commenced business. We have made about five hundred (500) lineal feet of show case per month since 1909; some months run

Testimony of A. C. LaRue Shaffer.

pretty high and other months different. I know Mr. W. G. Whitcomb, of Kansas City, Missouri. I examined the Federmann cases in Kansas City. I went to Federmann's store and examined the cases there; I think there was four cases there at the time, four or five. One of them, I think, was a wood frame and two of them the glass was held together with clamps, and two of them were held together with a substance such as glue, or similar substance; that is: the end plates were set and the front plate was held to the end plate with this substance, and the top plate was put on the top of the ends and front plate and back rail, and the back was held by a bolt running through the top plate into the back frame. There was no cement or glue or felt on the back rail. The top plate was held to the back frame by means of bolts, by boring a hole into the glass and running the bolt through the glass into the back frame. These cases were not constructed according to the description of the Weber patent.

"I know the Cooper Drug Company in Joplin. I went to examine some cases in the Cooper Drug Company. Mr. Whitcomb stated that he made some cases back there in 1900 or 1899, and I went down to investigate and see how they were made. He testified they were held together with glue and cement, nothing else being used to hold the case. Two of the cases which appeared to be in their original shape were held together with glue and felt with bolts through the top plate into the back frame to hold the top plate to the back frame. On these two cases there was a piece of felt, but no glue used, just bolts. In the cases—said to

Testimony of A. E. Edwards.

have been repaired—the bolts had been left out and they had strung a little glue here and there along the back frame to hold the top plate to the back frame instead of using bolts. I think it vital to use something in the joints that does not permeate the felt. If you permeate the felt it draws up and makes a hard joint, and that is what we avoid in the patent. Out patent covers and elastic joint; that is, when we make a case, we make it with an elastic joint. The Federmann cases are what I call solid joints all through, because the material used (I would call it 'glue') would permeate the felt and make a hard joint. Whatever material he used permeated the felt and bolts were used as before described. Three distinct differences between the Federmann case and the Weber patent case are: the solid joints; the use of the bolts, as above described, and the material used in the construction of the Federman cases which (whatever it is) permeates the felt, making a solid jointed case, which was not the case in the patent. It was simply the process of putting these plates together with an elastic joint; that is the substance of the patent, as I understand it. The Joplin cases are the same composition as the Federmann, and my testimony with reference to the Federmann cases applies to the Joplin cases."

Thereafter, on the 2nd day of June, 1913, in Spokane County, State of Washington, A. E. EDWARDS was duly sworn and examined as a witness on behalf of the defendant, and stated and testified as follows:

"I am forty years old, by occupation a manufacturer, and residing in Spokane, Washington. I am a Testimony of A. E. Edwards.

manufacturer in the firm of Pacific Scale & Show Case Company, a corporation engaged in the manufacturer of show cases, manufacturing and selling show cases generally in the City of Spokane. My company manufactures the show cases used by the defendant in this suit. My experience in the manufacture of this kind of show case covers a period of about four years. and I have personally worked in the business. I am familiar with the ingredients that is used in cementing the cases together; it is a combination of drugs, oils, etc., making a cement so that it will work easily and is used in connection with felt. The first method in cementing glass to glass with a cushion between, is to glue the felt to the one light of glass, then spread the cement upon the felt, joining the next light of glass to it, and pressing or weighting down to form the union, spreading the cement through pressure to give it adhesive power, later cleaning surplus cement off the glass. I think when the proper kind of cement and felt are used—under the proper conditions—that it makes an ideal joint."

The plaintiff hereby proposes the foregoing as its abstract of the testimony taken in the above entitled cause, prays that the same be allowed as settled by the court, pursuant to the provisions of Equity Rule No. 75.

(Signed) SCRIVNER & MONTGOMERY, and LUBY & PEARSON.

Attorneys for Plaintiff.

Endorsements: Condensed Statement of Testimony Proposed by Complainant.

42 Diamond Patent Company, Appellant, vs.

Testimony of William G. Whitcomb.

Received at the Clerk's Office December 19, 1913, and filed, after being settled by order of court, in the District Court of the United States for the Eastern District of Washington, January 12, 1914.

W. H. HARE, Clerk. By Frank C. Nash, Deputy.

In the District Court of the United States for the Eastern District of Washington Northern Division.

NO. 1365.

DIAMOND PATENT COMPANY, a Corporation, Plaintiff,

US.

S. E. CARR COMPANY, a Corporation,

Defendant.

IN EQUITY.

DEFENDANT'S PROPOSED AMENDMENTS TO THE CONDENSED STATEMENT OF THE TESTIMONY TAKEN IN THE ABOVE ENTITLED ACTION.

WILLIAM G. WHITCOMB, being duly sworn as a witness on behalf of the defendant testified:

That the glass show cases where the plates were connected with felt and cement which he made were constructed by putting the cement along the edge of the glass and then lay the felt on and then put cement on top of the felt and then put the glass on; the purpose of the cement was to hold the case together; that he made a good many of these cases from 1898 to 1905 and still makes a few of them; that the first one

Testimony of William G. Whitcomb.

of these cases that he sold was to H. J. Ernest, in 1899; that the case sold to Ernest was made with the felt stuck to the edge of the end glass and then put cement on the felt and simply put up the front glass and the same thing with the top, the back of the case was frame; there was cement and felt on the top but not at the back corner; the back edge of the glass laid in a rabbet in the wood frame; the front, top and end joints were put together with felt and cement clear along the edges; that Mr. Ernest paid for the case and used it several years; that he made five of these cases for Mr. Federmann, constructed with felt and cement the same as the Ernest case; these cases were delivered to Mr. Federmann in April, 1900, and he has them yet, two or three broken tops have been replaced and some of them have never been repaired; that in some of these elastic cases made with the felt and cement construction he bored holes through the top glass at the back top corners and put a screw through the holes and into the back wood frame, some of them were made without these screws, the two end joints and front joints and the front corners where the glass is put together did not have any holes and were held together by the cement; that he began experimenting with these felt joint cases in 1896 or 1897; that he made several of these cases before selling any, and first tried using glue for the adhesive substance to adhere the felt to the glass and found out glue would not do as it broke and chipped the glass, then he tried shellac and found that would not work and finally he used a substance made up of ingredients that he would get at Testimony of William G. Whitcomb.

a drug store; that a Mr. Shaffer called on him a few years ago to sell him a license to make cemented allglass cases; that he told him he was the first to make all-glass cemented show cases; that the right to make all-glass cemented cases belonged to him if it belonged to anybody.

That the Federmann cases were made by sticking the felt to the glass and then put cement on the other side of the felt and lay the glass on; that he had no more trouble from this class of cases coming apart than from others. That during November, 1899, he constructed and installed ten of these cases for the Cooper Drug Company at Joplin, Missouri; that these Joplin cases were constructed with felt in the joints between the glass with an adhesive substance on either side of the felt adherring it to the glass; that the cement used in those cases was a preparation he got up himself; that he used felt in the joints of these all-glass cemented cases, for the vibration of the case, that he made some without the felt, simply stuck one plate of glass on the other plate and found it was so solid any little jar would break it, then he thought of the felt to give the elastic movement and make an elastic joint; that the joints in the Federmann cases and all those are not hard and fixed. they appear to be solid, but there must be some give to them or they would break; that his trouble with the first ones he made was that the joints were solid and he could not handle them, they would break without anyone touching them; but later I got so I shipped them all set up; that the Ft. Scott cases were set up in his factory and shipped down there Testimony of William N. Federmann.

all complete; that his idea was to get an elastic joint, something that would give a little and he succeeded; that as compared with a wood frame case he does not think any all-glass show case is a good, practical success; that the cases are good or bad by comparison with a wood frame case and he does not consider them as good, some give satisfaction, but some people are not satisfied with them; that he tells people that the wood frame case is the best. That sometimes people accustomed to wood frame cases would complain that these cases looked frail and would ask to have screws put through the back edge of the top plate of glass down into the wood frame; that he built some of them that way and some of them without such screws, that probably most of them were made without screws. That one of the objects of using felt in the joints between the glass was to give flexibility and elasticity to the joints and obtain sort of a rubber or cushion effect between the plates of glass. That he remembers the construction of the ten cases delivered to the Cooper Drug Company at Joplin, Missouri, very well as he went down and set them up and worked on them at night; that the joints were made with felt and cement, cement on the edge of the glass and then felt and then cement and the glass laid on; that he made the cement himself.

WILLIAM N. FEDERMANN, being duly sworn as a witness on behalf of the defendant, testified:

That in April, 1900, he received five show cases made by Whitcomb and that they were installed in his store at 904 Main Street, Kansas City, Missouri, and

Testimony of Gustav A. Holm.

that said cases have been used by him ever since and are now being used by him at the same location; that said cases were made with felt between the glass and fastened together with some adhesive substance; that three of the cases are still in their original condition and have not been broken or repaired; that the strips of green felt are still there on the edges of the glass and can be seen readily; that the top plate has been broken on a couple of the cases and the fragments removed and new tops put on and in the repairs clamps were put on the corners; that said cases have been in continuous use ever since they were installed in 1900 and are in fair condition and have been satisfactory; that whatever elasticity followed from the use of felt in the joints between the glass existed in his cases; that said cases were made by putting a strip of felt having an adhesive substance on either side of it in the ioints between the glass and the different plates of glass thus held together and that any elasticity resulting from that method of construction existed in said cases; that in saying that the joints were solid he meant that they were not loose and open, but were firm with the felt intervening with no opening to allow dust to enter or anything of that kind; that these cases have a bolt or screw through the glass into the wood frame at the rear top corners.

GUSTAV A. HOLM, being duly sworn as a witness in rebuttal on behalf of the plaintiff, testified:

That he repaired four or five show cases made by the Whitcomb Cabinet Company for Sol Kaufman; that they were all-glass cases, that is, they had no Testimony of Henry W. Jackson.

wood around the glass; that the glass was adhered together at the joints by material; that he repaired these Kaufman cases within the last two years; that the glass joints of these cases were fastened together by some adhesive substance serving the purpose of cement with a strip of gray rubber running the whole length of the joints between the glass; that he did not examine the rubber to see whether it was soft and elastic or not; that in repairing these cases he did not need to disturb the end plates of glass; that he simply put cement on the edge of the end plates and then put on a strip of felt and then put on some more cement and then put on the front plate of glass and then do the same way with the top plate of glass; that the difference in the way he repaired them from what they were before was that he used felt instead of the rubber that had been used in the first instance and any difference there was in the cement; that the cement he used was obtained from the Diamond Patent Company; that he is employed by the licensee of the Diamond Patent Company in Kansas City, Missouri, one of the competitors of the Whitcomb Cabinet Company in said city.

HENRY W. JACKSON, being duly sworn as a witness in rebuttal on behalf of the plaintiff, testified:

That he is secretary of the Kansas City Show Case Works Company, licensee of the plaintiff herein and competitor of the Whitcomb Cabinet Company; that he has been making the plaintiff's patented show case under said license; that he knew without being told that Mr. Whitcomb had been making these all-glass

Testimony of Fred Weber.

show cases, as he had seen such cases made by Whitcomb running back a dozen or thirteen years ago and knew two or three places where Whitcomb had put in the cement felt, all-glass show cases; that all these allglass cases have a wooden back frame and base; that the conversation he had with Mr. Whitcomb, as testified to, took place when they were competitive bidders on a job of work; that he repaired some all-glass cases made by Whitcomb along 1901, 1902 or 1903 and besides the paste or glue there was some material in the joints that looked like rubber; that the cases had been used four, five or six years when he repaired them; that Federmann's was the next place where he knew of Whitcomb putting in all-glass show cases; that the cement he uses in making these cases he obtains from the plaintiff and he does not know the composition of it; that his license requires him to buy the cement of plaintiff; that he never used cement in the show case business until he began making plaintiff's patented show case; that the cement he gets from plaintiff is the first flexible cement he knew of; that this cement he uses gets a little hard and is flexible and has some adhesive property in it.

FRED WEBER, a witness in rebuttal on behalf of the plaintiff, being duly sworn, testified:

That before testifying he had read the testimony of Mr. Whitcomb; that he constructs the patented show case by setting the end plates in putty in the grooves in the wood frame at the back and bottom and then apply a coat of cement on the front edge of the end plates and then apply a strip of felt on the edge of

Testimony of Fred Weber.

the end plates and then a layer of cement over the felt and then put up the front plate and then go through the same process on the top edge of the end plates and front plate and then put on the top plate; that the claims of the patent are a correct statement of the device as he made it; that he went into the show case business along in March, 1902, and began experimenting with the patented show case along in 1904; that when he testified that in 1909 he had sold 15,000 lineal feet of these show cases he meant that many feet reduced to one year's usage; that some of the cases had then been used several years and the number of actual feet was multiplied by the number of years usage; that damp weather has something to do with how long it takes the cement to harden, sometimes the cement will dry in four or five hours and then again will not hardly dry in a day and a half; that the cement gets a pretty good hold of the felt, but is not supposed to permeate the felt; that to the extent the cement does permeate the felt he escapes the elastic joint; that he never used rubber instead of the felt, but presumes that if a strip of rubber about the thickness of the felt was used, the same result would be obtained; that in the patented cases they set the back and bottom of the end plates and the bottom of the front in putty in a rabbet in the wooden frame work and the putty hardens in time and they get a pretty firm, rigid joint as rigid as putty will make it; that the elastic joint feature applies simply to the all-glass construction; that in the patented cases they have an elastic joint on one side and one end of the

Testimony of James P. Schaffer.

end plates and a rigid joint on one side and one end of the end plates; that it is the result they seek and he presumes any composition of ingredients that was an even color and consistency, which would set at a certain time and not too quick would be as satisfactory as their cement; that he is now making these patented cases as licensee from the present owner and his assignment of the patent was under terms whereby the more of these cases there are made the greater his compensation for the patent.

JAMES P. SHAFFER, at witness in rebuttal on behalf of the plaintiff, being duly sworn, testified:

That during his interview with Mr. Whitcomb in November, 1906, he showed Mr. Whitcomb a sample of the patented show case construction and Mr. Whitcomb told him "he had tried the cemented show cases" and intended using the metal clip instead and also stated "that from the fact that he had tried them out and found them unsatisfactory, that he would not be bothered with them any more"; that he stated nothing more than "that he had made the case" and that our case "had too much elasticity in the joint"; that he had read the testimony of Mr. Whitcomb; that he gets a salary from the plaintiff company and from one of its licensees; that at his interview with Mr. Whitcomb in 1906 the latter examined the sample of the patented construction pretty thoroughly and said there was too much elasticity in the joints; that there was too much give and take and I think his objection to taking it up was "principally on the fact he had tried them himself and found them unsatisfactory, and he didn't want

Testimony of William E. Price.

to try twice," he seemed to concede that you wanted some elasticity, but that we had too much, he thought we were overdoing the elasticity feature; we explained to him in considerable detail the construction of our patented case and there was not any question about his knowing how it was constructed, he did not indicate when he had made the cases, but "just simply stated that he had made them"; that the only cemented show case he talked about was the corner of the one we had there and he stated" he had made some himself."

WILLIAM E. PRICE, a witness in rebuttal on behalf of the plaintiff, being duly sworn, testified:

That he was one of the partners in the co-partnership known as Cooper Drug Company at Joplin, Missouri; that the ten cases which said company purchased of the Whitcomb Cabinet Company in 1899 or 1900 were constructed at the back top joint by putting a strip of felt on the wood which the top plate of glass laid upon and then two screws were put through holes in the glass, one at each back top corner down into the wood frame; the ten-foot cases had three screws through the rear edge of the top plate of glass, one at each end and one in the center, these screws or bolts were put in with a screw driver and they had big washers around the head; that he was not sure about the underside of the washers being lined with felt; that said cases were shipped to Joplin knocked down and were set up in the store by Mr. Whitcomb and himself; the back frame was separate from the base; that they screwed the back frame onto the base and then set the end plates of glass in grooves in the base and back frame then

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Testimony of William E. Price.

they put glue on the edge of these end plates of glass and then put on a strip of felt over the glue and then put glue on the felt and then put on the front plate of glass and then did the same with the top plate of glass; that the adhesive substance which they used and which he calls glue was brought along by Mr. Whitcomb; that he set up two of the cases alone after Mr. Whitcomb returned to Kansas City; that all these cases are still in use in the store where they were installed and have been in continuous use ever since installation; that the top plates of glass have been broken on eight of these cases and new tops put on; that two of the cases are still just as they were first set up and have not been changed or repaired; that he has personally used these cases all the time until just before testifying; that this glue, felt and glue construction in these cases ran along the top end joints, down the front end joints and the top front joint; that he has broken the top plates of these cases a good many times without breaking the other plates of glass, just the top plates would break and the other plates not break at all; that these are the only show cases he has had in his store since they were put in; that when the top plates of glass would get broken he would take a thin knife blade right under the glass, sometimes add a little hot water and sometimes without it-run the blade right along there through the felt and pull it off, it is not a very difficult process and some plates would skin right off.

Testimony of Wm. C. H. Wilson and A. C. LaRue Shaffer.

WILLIAM C. H. WILSON, a witness in rebuttal on behalf of the plaintiff, being duly sworn, testified:

That he was with Mr. Shaffer when the latter called on Mr. Whitcomb at Kansas City with a view of selling him a license to make the patented show cases; that said call was made November 22, 1906; that Mr. Whitcomb told them he had made cemented show cases. and did not care to handle their proposition; that in June, 1909, he again called on Mr. Whitcomb when he was hunting up infringers for the holders of this patent; that he learned of the Federman cases and went down and examined them; that on both trips when he called on Mr. Whitcomb he was in the employ of the owners of this patent; that Mr. Whitcomb examined the sample of their construction which they had; that he does not recall Mr. Whitcomb telling them that he had been making those show cases before they did; that these Federman cases were constructed with "some adhesive substance on either side of the felt "

A. C. LARUE SHAFFER, a witness in rebuttal on behalf of the plaintiff, being duly sworn, testified:

That the plaintiff company has about twenty-five licensees throughout the United States making show cases in accordance with the patented construction; that they all pay license and royalty fees to plaintiff; that he is also interested in the Diamond Patent Show Case Company of San Francisco, which is a licensee of plaintiff; that he was present and heard Mr. Whitcomb testify in this case; that he examined the Federman cases in Kansas City; there was felt on the back rail

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Testimony of C. LaRue Shaffer.

of these Federman cases, whether felt was used in all the joints he does not know; that after Mr. Whitcomb's testimony he examined the Cooper Drug Company cases at Joplin, Missouri, and interviewed the witness, Mr. Price, who was manager of the drug company; that he found the Cooper cases were made at the joints with glue and felt, except at the back rail where there was felt but no glue; that two of the cases appeared to be in their original condition; that he has a stock interest in both companies and gets a salary from each and has an agreement whereby he gets something in addition to both; that his inspection of the Federman cases was in October, 1912; that some of these Federman cases had bolts through the top plate of glass at the back corners, one bolt in each corner, they had inserted a sort of bolt with a rubber washer on it down into the back frame; that the balance of the case from the bottom to the front of the top corners and across the front on top and across the top of the ends, he thinks, was constructed with felt and glue; that he calls it glue from the way it seems to act on the glass; that the Federman cases are identical with the patent except that the Federman cases have bolts throught the rear corners of the top plate of glass, and that they are made with what I call glue, rather than what I call cement, and that I claim that the adhesive substance used in the Federman cases permeated the felt; that aside from those three things, the bolt is one thing, he did not use what I call cement, but did use what I call glue and as I claim the glue has permeated the felt, the cases are like the patented cases; Testimony of C. LaRue Shaffer.

that he does not claim the patent covers the plates, the back and so forth, but simply the process of putting these plates together with an elastic joint; that the Joplin cases are the same as the Federman cases; that the cement which they used in constructing the patented show cases and which the licensees are required to purchase from plaintiff is simply a composition of ingredients that they know about and which they have made up for them; that he does not claim any patent on the cement; that the patent covers uniting two plates of glass, with some adhesive substance and a cushion between; that some of the Federman cases had clamps on them that had been put on in repairs.

That plaintiff's Exhibit 1, being an alleged model submitted by plaintiff of the show cases in controversy, and plaintiff's Exhibit 2, being an alleged model submitted by plaintiff of the anticipating show cases manufactured by William G. Whitcomb and referred to in the testimony as the Federman and Cooper show cases, be made a part of the record in this cause, and transmitted as such record to the Clerk of the United States Circuit Court of Appeals for consideration by said Court in the consideration of this case.

The defendant hereby proposes the foregoing as its abstract of the testimony taken in the above entitled cause and asks that the same be allowed by the Court in accordance with the governing rules.

(Signed) MORRILL, CHESTER & SKUSE, and S. H. CUTTING.

Attorneys for Defendant.

Endorsements: Defendant's proposed amendments to the condensed statement of the testimony proposed by complainant.

Received at the Clerk's Office December 31, 1913, and filed, after being settled and allowed by the Court, in the U.S. District Court for the Eastern District of Washington, January 12, 1914.

> W. H. HARE, Clerk. By Frank C. Nash, Deputy.

In the District Court of the United Stales for the Eastern District of Washington, Northern Division. NO. 1365.—IN EQUITY.

DIAMOND PATENT COMPANY, a Corporation, Plaintiff.

US.

S. E. CARR COMPANY, a Corporation,

Defendant.

STIPULATION.

It is hereby stipulated and agreed by and between the parties to this action that the proposed condensed statement of the evidence lodged by the plaintiff with the clerk shall be amended as follows:

On page 5, the clause: "I am willing for both sides to assume that the Federmann cases and the Joplin cases would be a fair representation of my idea of how I manufactured cases in 1898 to 1905, and along there"; be substituted for the clause of similar wording, referring to the years 1899 to 1900;

And that the defendant's proposed amendments to said condensed statement of the evidence lodged with the clerk be amended as follows:

That all of page 1, except the title, be stricken out, because covered and included in plaintiff's statement.

And that upon being so amended said proposed statements shall be treated and considered as true, complete and properly prepared, and may be approved by the court, and filed as a part of the record for the purposes of appeal.

(Signed) SCRIVNER & MONTGOMERY, and LUBY & PEARSON

Attorneys for Plaintiff.

(Signed) MORRILL, CHESTER & SKUSE, and S. H. CUTTING,

Attorneys for Defendant.

Endorsements: Stipulation.

Filed in the U. S. District Court for the Eastern District of Washington, January 12, 1914.

W. H. HARE, Clerk. By Frank C. Nash, Deputy.

In the District Court of the United States for the Eastern District of Washington, Northern Division.

NO. 1365.—IN EQUITY.

DIAMOND PATENT COMPANY, a Corporation, *Plaintiff*,

US.

S. E. CARR COMPANY, a Corporation,

Defendant.

ORDER APPROVING CONDENSED STATE-MENT OF EVIDENCE.

Upon motion of Messrs. Luby & Pearson and Messrs. Scrivner & Montgomery, counsel for plaintiff, and on

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filing the stipulation of the parties, it appearing to the court that the statement of evidence as proposed and amended, pursuant to such stipulation, is true, complete and properly prepared.

IT IS ORDERED, That said statement be and the same hereby is approved, and it is directed that the same be filed in the Clerk's office of this court and become part of the record for the purpose of appeal.

(Signed) FRANK H. RUDKIN,

Judge.

Endorsements: Order Approving Condensed Statement of Facts.

Filed in the U. S. District Court for the Eastern District of Washington, January 12, 1914.

W. H. HARE, Clerk. By Frank C. Nash, Deputy.

In the District Court of the United States, Eastern District of Washington, Northern Division.

NO. 1365.

DIAMOND PATENT COMPANY, a Corporation, Plaintiff,

US.

S. E. CARR COMPANY, a Corporation,

Defendant.

OPINION.

Luby & Pearson and Scrivner & Montgomery, for plaintiff.

Morrill, Chester & Skuse and S. H. Cutting, for defendant.

RUDKIN, District Judge. This is a suit in equity

to enjoin the infringement of Letters Patent No. 801,944 for a show case, issued under date of October 17, 1905, to Fred Weber of California, and later assigned to the plaintiff. The infringement is admitted, and while the testimony and briefs in the case cover a wide range, the facts so far as deemed material were agreed upon at the final hearing and are as follows:

Show cases manufactured by William J. Whitcomb of Kansas City, Missouri, were in public use and on sale for more than two years prior to the application for the Weber patent. The base and back frame work of the Whitcomb cases were made of wood, while the ends, front and top were of plate glass. The two end plates were imbedded in the wooden base and in the wooden frame work at the rear. The front plate was likewise imbedded in the wooden base and cemented to the end plates with a strip of felt between the plates and the joint. The top plate was cemented to the front end and plates in the same manner and fastened to the wooden frame work at the rear by means of metal screws inserted through holes drilled in the glass at each rear corner of the eight-foot cases with an additional screw in the center of the ten-foot cases. A strip of felt was placed between the plate glass and the wood at the rear of the case.

The cases manufactured under the Weber patent are in all respects similar to the Whitcomb cases with the single exception that cement is substituted for metal screws for the purpose of fastening down the rear of the top plate. In other words, in the Weber case the top plate is cemented to the wooden frame

work at the rear just as glass is cemented in other parts of the case while metal screws are used to hold the rear of the top plate of the Whitcomb case in place.

Under the foregoing facts the defense of prior use or anticipation is the only question I deem it necessary to discuss or consider. In my opinion the Weber patent must fair for two reasons. First, because the mode of fastening or joining glass to wood is not covered by the claim in the Weber application; and, second, if it were, I do not think that the mere substitution of cement for metal screws rises to the dignity of invention, especially in view of the fact that the mode of joining glass to glass is merely extended to the joining of glass to wood under the Weber patent.

1. Under section 4888 of the Revised Statutes the application for a patent must particularly point out and distinctly claim the part, improvement or combination which the applicant claims as his invention or discovery, and while the claim may be illustrated it cannot be enlarged by language used in other parts of the specification.

Keystone Bridge Co. v. Phoenix Iron Co., 95 U. S. 274.

Railroad Co. v. Mellon, 104 U. S. 112.

Western Electric Co. v. Ansonia Co., 114 U. S. 453.

Yale Lock Co. v. Greenleaf, 117 U. S. 554.

White v. Dunbar, 119 U. S. 47.

Home Machine Co. v. National Needle Co., 134 U. S. 388.

McClain v. Ortmayer, 141 U. S. 149.

Deering v. Winona Harvester Works, 155 U. S. 286.

Coupe v. Royer, 155 U. S. 565.

United States Repair etc. Co. v. Assyrian Asphalt Co., 183 U. S. 591.

Cimiotti Unhairing Co. v. Fur Ref. Co., 198 U. S. 399.

But this rule is elementary. The claim set forth in the application for the Weber patent is as follows:

"What I claim is-

- 1. A structure comprising a plurality of glass plates, the edges of which are spaced from the adjacent plates, a felt cushion filling the space between the adjoining plates, the plates being cemented to the felt, each plate being adapted to fully vibrate in its natural plane of vibration, and prevented by the felt cushion from imparting its vibration to the adjacent plates.
- 2. A structure comprising a plurality of glass plates an unconfined edge of one plate nearly if not quite meeting another plate also with unconfined adjacent edge, and elastic material filling the space thus existing between the nearest adjacent surfaces of the plates, said plates being attached to the elastic material, whereby the plates, by reason of their unconfined edges and the intervening elastic material can each vibrate or move in any direction independently."

It will thus be seen that the claim is limited to the mode of uniting glass to glass and is entirely silent as to the mode of joining or uniting glass to wood. True, it is claimed that where screws are used each

plate cannot vibrate in its natural plane of vibration without imparting its vibration to adjacent plates, but this would seem to be a mere result which is not patentable.

Knapp v. Morris, 150 U. S., 221, 227.

Wollensak v. Sargent, 151 U. S. 227.

Cash Register Co. v. Cash Indicator Co., 156 U. S. 502, 515.

Columbus Watch Co. v. Robbins, 64 Fed. 384.

National Hollow B. B. Co. v. Interchangeable B. B. Co., 106 Fed. 693.

2. But if it be conceded that the mode of joining the glass to the wood is covered by the claim, yet it occurs to me that the mere substitution of cement for screws would occur to the rudest and most unskilled mechanic. Such a change does not call for the exercise of inventive genius or creative faculty and ought not to be dignified by letters patent.

Yale Lock Co. v. Greenleaf, 117 U. S. 554, 559.

As a general rule, "that which infringes, if later, anticipates, if earlier," and it seems to me that if the manufacture and sale of the Whitcomb cases followed the patent a clear case of infringement would be presented.

Miller v. Eagle Manufacturing Co., 151 U. S. 186 and cases cited.

The testimony of Whitcomb tends to show that he manufactured and sold cases identical with the Weber case long prior to the date of the application for a patent, but the witnesses appeared to be in error as to the kind of cases sold to different parties at different times and the manufacture and sale of the identical case is not established with that degree of certainty required by the patent law. On the entire record I am of opinion that the bill is without equity and should be dismissed. Let a decree be entered accordingly.

Endorsements: Opinion.

Filed in the U. S. District Court for the Eastern District of Washington, September 18, 1913.

W. H. HARE, Clerk. By Frank C. Nash, Deputy.

In the District Court of the United States, Eastern District of Washington, Northern Division.

NO. 1365.

DIAMOND PATENT COMPANY, a Corporation, Complainant,

US.

S. E. CARR COMPANY, a Corporation,

Defendant.

DECREE.

This cause came on to be heard at this term, and was argued by counsel; and thereupon, upon consideration thereof, it was ORDERED, ADJUDGED and DECREED as follows:

That Letters Patent No. 801,944 for an improvement in show cases issued to Fred Weber on October 17, 1905, are invalid by reason of anticipation through prior use; that the bill of complaint herein is without equity and this case is hereby dismissed with costs to the defendant.

64 Diamond Patent Company, Appellant, vs.

Done in open Court this 26th day of September, 1913.

(Signed) FRANK H. RUDKIN, Judge.

Endorsements: Due service and receipt of a copy of the within decree on September 22, 1913, is hereby admitted.

(Signed) LUBY & PEARSON, Solicitors for Complaint.

Decree.

Filed in the U. S. District Court for the Eastern District of Washington, September 26, 1913.

W. H. HARE, Clerk. By Frank C. Nash, Deputy.

In the District Court of the United States for the Eastern District of Washington, Northern Division.

NO. 1365—IN EQUITY.

DIAMOND PATENT COMPANY, a Corporation, Plaintiff,

US.

S. E. CARR COMPANY, a Corporation,

Defendant.

ORDER FOR WITHDRAWAL OF EXHIBITS.

Good cause appearing therefor, IT IS HEREBY ORDERED that all exhibits filed by the plaintiff and by the defendant to the foregoing action, and contained within the file thereof, and all models in the possession of the Clerk of this Court, may be withdrawn for the purpose of being transmitted to the United States Circuit Court of Appeals for the Ninth Circuit—the same

to be returned to the Clerk of this Court on the final determination of said cause.

(Signed) FRANK H. RUDKIN,

Judge.

Endorsements: Order for Withdrawal of Exhibits. Filed in the U. S. District Court for the Eastern District of Washington, January 12, 1914.

W. H. HARE, Clerk. By Frank C. Nash, Deputy.

In the District Court of the United States for the Eastern District of Washington, Northern Division.

NO. 1365—IN EQUITY.

DIAMOND PATENT COMPANY, a Corporation,

Plaintiff,

US.

S. E. CARR COMPANY, a Corporation,

Defendant.

ASSIGNMENT OF ERRORS.

NOW COMES the Diamond Patent Company, the plaintiff in the above entitled action, and files the following assignment of errors upon which it will rely in the United States Circuit Court of Appeals for the Ninth Circuit, and which it will also rely upon in its appeal in the above entitled cause, viz:

FIRST: Error of the Court in holding that United States Letters Patent No. 801,944 for an improvement in show cases, issued to Fred Weber, on October 17th, 1905, being the patent in suit, are invalid by reason of anticipation through prior use;

SECOND: Error of the Court in holding that the Bill of Complaint in said cause is without equity, and

adjudging and decreeing that said cause be dismissed;

THIRD: Error of the Court in no holding that the said Patent was and is valid, and in not granting the relief prayed for in said Bill of Complaint.

(Signed) SCRIVNER & MONTGOMERY, and LUBY & PEARSON,

Attorneys for Plaintiff and Appellant.

Endorsements: Due service and receipt of a true copy of the within Assignment of Errors is hereby admitted this 12th day of January, 1914.

(Signed) MORRILL, CHESTER & SKUSE and S. H. CUTTING,

Attorneys for Defendant.

Assignment of Errors.

Filed in the U.S. District Court for the Eastern District of Washington, January 12, 1914.

> W. H. HARE, Clerk. By Frank C. Nash, Deputy.

In the District Court of the United States for the Eastern District of Washington, Northern Division.

NO. 1365—IN EQUITY.

DIAMOND PATENT COMPANY, a Corporation, Plaintiff.

US.

S. E. CARR COMPANY, a Corporation,

Defendant.

TO THE HONORABLE. THE DISTRICT COURT OF THE UNITED STATES FOR THE EAST-ERN DISTRICT OF WASHINGTON, NORTH-ERN DIVISION.

The plaintiff herein, DIAMOND PATENT COM-PANY, a Corporation, feeling themselves aggrieved by the decretal order made by said Court on the 26th day of September, 1913, and the decree of dismissal made and entered on said day in pursuance of said order, whereby it adjudged and decreed that the defendant herein had not infringed upon the rights of the said plaintiff in and under certain Letters Patent of the United States, viz: "Letters Patent No. 801,944, dated October 17th, 1905, issued to Fred Weber of California," and owned by said plaintiff (being the Letters Patent sued on herein), and that said Letters Patent were anticipated and void for want of invention; and decreed that plaintiff's bill filed in said cause be dismissed with costs to the defendant, now come by their counsel, Messrs. Luby & Pearson and Scrivner & Montgomery, and petition the said court for an order allowing said plaintiff to prosecute an appeal from said decree to the Honorable United States Circuit Court of Appeals for the Ninth Circuit, under and according to the laws of Congress, and the Statutes of the United States, in such cases made and provided, and also that an order be made fixing the amount of security which plaintiff shall give and furnish upon such appeal, and that upon the giving of such security all further proceedings in this court be suspended and stayed until the determination of said appeal by said United States Circuit Court of Appeals, for the Ninth Circuit.

And your petitioner will ever pray, etc.
(Signed) SCRIVNER & MONTGOMERY, and
LUBY & PEARSON,

Attorneys for Plaintiff.

Endorsements: Due service and receipt of a copy of the within petition is hereby admitted this 12th day of January, 1914.

(Signed) MORRILL, CHESTER & SKUSE, and S. H. CUTTING,

Attorneys for Defendant.

Petition for Appeal.

Filed in the U. S. District Court for the Eastern District of Washington, January 12, 1914.

W. H. HARE, Clerk. By Frank C. Nash, Deputy.

In the District Court of the United States for the Eastern District of Washington, Northern Division.

NO. 1365—IN EQUITY.

DIAMOND PATENT COMPANY, a Corporation,

Plaintiff,

US.

S. E. CARR COMPANY, a Corporation,

Defendant.

ORDER ALLOWING APPEAL.

Upon motion of Messrs. Luby & Pearson and Messrs. Scrivner & Montgomery, counsel for plaintiff, and on filing the petition of the Diamond Patent Company, plaintiff, together with an assignment of errors, IT IS ORDERED: That an appeal be and is hereby allowed to the United States Circuit Court of Appeals for the Ninth Circuit from the final decree of this court, entered on the 26th day of September, 1913, dismissing said action and holding that the patent sued upon was void, on the ground of anticipation;

AND IT IS FURTHER ORDERED; That the amount of the bond upon said appeal be, and the same is hereby, fixed at the sum of Five Hundred and no-100 Dollars;

AND IT IS FURTHER ORDERED: That, upon the giving of such bond, the said judgment and decree be suspended and stayed until the determination of the appeal by the said Circuit Court of Appeals for the Ninth Circuit, and that a certified transcript of the record and proceedings herein be forthwith transmitted to the said United States Circuit Court of Appeals.

(Signed) FRANK H. RUDKIN,

Judge.

Endorsements: Order Allowing Appeal and Fixing Amount of Bond on Appeal.

Filed in the U. S. District Court for the Eastern District of Washington, January 12, 1914.

W. H. HARE, Clerk.

By Frank C. Nash, Deputy.

In the District Court of the United States for the Eastern District of Washington, Northern Division.

NO. 1365—IN EQUITY.

DIAMOND PATENT COMPANY, a Corporation,

Plaintiff.

US.

S. E. CARR COMPANY, a Corporation,

Defendant.

BOND FOR APPEAL.

KNOW ALL MEN BY THESE PRESENTS: That we, the DIAMOND PATENT COMPANY, a

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corporation, as principal, and the Fidelity & Deposit Company of Maryland, as surety, ARE HELD AND FIRMLY BOUND unto S. E. CARR COMPANY, a Corporation, the defendant, in the full and just sum of Five Hundred and no-100 Dollars, to be paid to the said defendant, its successors or assigns, for the payment of which, well and truly to be made, we bind ourselves and our successors, jointly and severally, firmly by these presents. Sealed with our seals and dated this 14th day of January, A. D., 1914.

WHEREAS, in above entitled suit pending in the District Court of the United States for the Eastern District of Washington, Northern Division, wherein said Diamond Patent Company, a Corporation, was plaintiff, and the said S. E. Carr Company, a Corporation, was defendant, a decree was rendered on the 26th day of September, 1913, against the said Diamond Patent Company and in favor of the said S. E. Carr Company, and said Diamond Patent Company has been granted an appeal in said cause and filed a copy thereof in the Clerk's office of said court to obtain a reversal of the decree in said suit, and a citation has been issued to said S. E. Carr Company citing it to appear at a session of the United States Court of Appeals for the Ninth Circuit to be holden at the City and County of San Francisco, in the State of California, on the 11th day of February, 1914:

Now the condition of this obligation is such, that if the said Diamond Patent Company shall prosecute said appeal to effect, and if it fails to make its plead good, shall answer all damages and costs, then the above obligation to be void, otherwise to remain in full force and virtue.

(Signed) DIAMOND PATENT COMPANY.

By Scrivner & Montgomery and Luby & Pearson, Its Attorneys.

SEALED and Delivered in presence of (Seal) (Signed) S. M. SMITH.

(Signed) ALBERT GOEDEN.

FIDELITY & DEPOSIT CO. OF MARYLAND. By W. L. Berry, Attorney in Fact.

Attest: W. T. McCrea, General Agent.

(Seal)

Approved by

(Signed) FRANK H. RUDKIN, District Judge.

Endorsements: Bond on Appeal.

Filed in the U. S. District Court for the Eastern District of Washington, January 14, 1914.

W. H. HARE, Clerk. By Frank C. Nash, Deputy.

In the District Court of the United States for the Eastern District of Washington, Northern Division.

NO. 1365—IN EQUITY.

DIAMOND PATENT COMPANY, a Corporation,

Plaintiff,

US.

S. E. CARR COMPANY, a Corporation,

Defendant.

CITATION. (Lodged Copy).

UNITED STATES OF AMERICA.—ss.

THE PRESIDENT OF THE UNITED STATES TO S. E. CARR COMPANY, GREETING:

YOU ARE HEREBY CITED AND ADMON-ISHED to be and appear at a United States Circuit Court of Appeals, for the Ninth Circuit, to be holden at the City and County of San Francisco, in the State of California, on the 11th day of February, 1914, pursuant to an order allowing an appeal entered in the Clerk's office of the District Court of the United States, for the Eastern District of Washington, Northern Division, in that certain action, numbered 1365, in which the Diamond Patent Company, a Corporation, is complainant and appellant, and you are respondent and appellee, to show cause, if any there be, why the decree rendered against the said complainant and appellant, as in the said order allowing an appeal mentioned, should not be corrected, and why speedy justice should not be done to the parties in that behalf

WITNESS the Honorable FRANK H. RUDKIN, Judge of the District Court of the United States for the Eastern District of Washington, Northern Division, this 12th day of January, 1914.

(Signed) FRANK H. RUDKIN, Judge. Attest:

(Signed) W. H. HARE, Clerk. By Frank C. Nash, Deputy. (Seal)

Endorsements: Due service and receipt of the within Citation is hereby admitted this 12th day of January, 1914.

(Signed) S. H. CUTTING, Attorney for Defendant.

Citation (Lodged Copy).

Filed in the U. S. District Court for the Eastern District of Washington, January 12, 1914.

W. H. HARE, Clerk. By Frank C. Nash, Deputy.

In the District Court of the United States for the Eastern District of Washington, Northern Division.

NO. 1365—IN EQUITY.

DIAMOND PATENT COMPANY, a Corporation, Plaintiff,

US.

S. E. CARR COMPANY, a Corporation,

Defendant.

PRAECIPE FOR TRANSCRIPT OF RECORD. TO W. H. HARE, CLERK OF SAID COURT:

YOU WILL PLEASE prepare and insert in the transcript on appeal, in the above entitled cause, the following papers, to-wit:

- (a) Bill of complaint;
- (b) Answer;
- (c) Amended or supplemental answer;
- (d) Condensed statement of evidence as finally allowed and approved by the Court;
- (e) Decree dismissing the suit and entering judgment for defendant;

- 74 Diamond Patent Company, Appellant, vs.
 - (f) Petition for appeal;
 - (g) Assignment of errors;
 - (h) Order allowing appeal;
 - (i) Undertaking on appeal;
 - (j) Order for withdrawal of exhibits;
 - (k) Citation on appeal,

and such subsequent orders as the Court may make and file herein.

(Signed) SCRIVNER & MONTGOMERY, and LUBY & PEARSON,

Attorneys for Plaintiff.

Endorsements: Duse service and receipt of a true copy of the within Praecipe is hereby admitted this 12th day of January, 1914.

(Signed) MORRILL, CHESTER & SKUSE, and S. H. CUTTING,

Attorneys for Defendant.

Praecipe for Transcript of Record.

Filed in the U. S. District Court for the Eastern District of Washington, January 12, 1914.

W. H. HARE, Clerk. By Frank C. Nash, Deputy.

In the District Court of the United States for the Eastern District of Washington, Northern Division.

NO. 1365—IN EQUITY.

DIAMOND PATENT COMPANY, a Corporation, Plaintiff,

US.

S. E. CARR COMPANY, a Corporation,

Defendant.

The S. E. Carr Company, Appellee.

PRAECIPE.

TO W. H. HARE, CLERK OF SAID COURT:

YOU WILL PLEASE prepare and insert in the transcript on appeal, in the above entitled cause, the following papers, to-wit:

- 1. Motion to amend the answer.
- 2. Order granting leave to amend answer.
- 3. Stipulation amending the amended answer by interlineation.
- Opinion of Judge Rudkin deciding the case. MORRILL, CHESTER & SKUSE, and S. H. CUTTING,

Attorneys for Defendant and Appellee.

Endorsements: Due service of a true copy of the within Praecipe on January 16, 1914, is hereby admitted.

(Signed) LUBY & PEARSON, Attorneys for Complainant.

Praecipe of Defendant for Transcript of Record.

Filed in the U. S. District Court for the Eastern

District of Washington, January 16, 1914.

W. H. HARE, Clerk. By Frank C. Nash, Deputy.

76 Diamond Patent Company, Appellant, vs.

In the District Court of the United States, Eastern
District of Washington, Northern Division.

No. 1365.

DIAMOND PATENT COMPANY, a Corporation, Complainant,

US.

THE S. E. CARR COMPANY, a Corporation,

Defendant,

CLERK'S CERTIFICATE TO TRANSCRIPT OF RECORD.

United States of America, Eastern District of Washington—ss.

I, W. H. Hare, Clerk of the District Court of the United States for the Eastern District of Washington, do hereby certify the foregoing pages, from 1 to 75 inclusive, to be a full, true, correct and complete copy of the record, pleadings, testimony and all proceedings had in said action as called for by the plaintiff and appellant and the defendant and appellee in their praecipes for a transcript of the record herein, as the same remain of record and on file in the office of the Clerk of said District Court, and that the same constitute the record on appeal from the order, judgment and decree of the District Court of the United States for the Eastern District of Washington, to the Circuit Court of Appeals for the Ninth Judicial Circuit, San Francisco, California.

I further certify that I hereto attach and herewith transmit the original citation issued in this cause.

I further certify that the cost of preparing, certifying and printing the foregoing transcript is the sum of \$93.20, and that the same has been paid to me by

Scrivner & Montgomery and Luby & Pearson, solicitors for complainant and appellant.

IN WITNESS WHEREOF, I have hereunto set my hand and affixed the seal of said District Court at the City of Spokane, in said Eastern District of Washington, Northern Division, in the Ninth Judicial Circuit, this 29th day of January, A. D. 1914, and the Independence of the United States of America the One Hundred and Thirty-eighth.

[SEAL] (Signed) W. H. HARE, Clerk U. S. District Court for the Eastern District of Washington.



United States Circuit Court of Appeals

For the Ninth Circuit

MAY TERM, 1914.

DIAMOND PATENT COMPANY (a Corporation),

Plaintiff and Appellant,

V.

S. E. CARR COMPANY (a Corporation),

Defendant and Appellee.

APPELLANT'S OPENING BRIEF

This is an action for an injunction restraining defendant from infringing United States Letters Patent No. 801,944, dated October 17th, 1905, issued to one Fred Weber, of Los Angeles, California, and for an accounting. The appellant is the assignee of the patent in suit, and as such assignee has been the owner of the patent ever since the 5th day of

February, 1910 (the date of the assignment). For convenience, we will hereafter call the appellant the plaintiff and the appellee the defendant.

The defendant assails the patent on the sole ground of anticipation by prior knowledge and use by one W. G. Whitcomb, in Kansas City, Missouri. Proper notice having been given, the defendant took testimony in Kansas City to establish the fact of prior use by said Whitcomb. Consequently, the only question now before this Court for its judgment and decision is simply one of anticipation by prior use by said Whitcomb. Prior use is made a defense under Subdivision V of Section 4920 of the Revised Statutes of the United States. This defense is an extremely technical one and requires positive and exact evidence which will satisfy the mind of the Court, beyond a reasonable doubt and to a moral certainty of the actual potential existence of the specific thing claimed to have been in such public use prior to the date of the patented invention; not only that, but it must appear that there existed an intelligent comprehension of its merits, uses and purposes, and that the making and use of it was not merely accidental or experimental. The law requires that such a defense shall be established beyond reasonable doubt in order to overcome the prima facie case made by the patent itself. for a patent issued by the government is presumed to be valid.

I.

STATE OF THE ART AT THE DATE OF THE APPLICATION FOR THE WEBER PATENT.

Show-cases, for the purpose of exhibiting small commercial articles for sale, have been in existence for many years. The earliest construction was simply a wooden frame with glass plates fixed in groves in the wooden frame, which made a heavy, cumbersome and unsightly piece of furniture for show pur-The first step in advance from these old heavy wooden frames, with the glass plates inserted, as above stated, was an all-glass case so arranged that the plates could be held together by what was termed in the trade as "metal clips," the clips being attached at the several corners of the glass plates to hold them together. As a step forward in these metal clip cases (they not having proved satisfactory) the manufacturers also inserted glue or paste along the edges of the glass plates, which becoming hard assisted in holding them together. These not having proved satisfactory to the trade, the manufacturer undertook to make an all-glass case, whereby the edges of the glass plates were glued, or pasted together and bolts or serews inserted through the glass plates at the edges or corners for the same purpose as the clips. These having many objectionable features, the next step consisted of an effort to make an all-glass case by simply pasting or gluing the edges of the glass

plates together without any clips, bolts or screws, or other metallic means of holding the plates together—it being supposed that the paste or glue would dry and become hard and rigid and hold the plates together. Still the trade was not satisfied and there was a want yet to be supplied in this art. All of these methods above described, it was conceded, were in public use prior to the date of the plaintiff's patent; they had been used for years and were not satisfactory, and some other means was being sought by which the glass plates could be held together in a satisfactory manner without these metallic clips, or other metallic methods of holding them together, and at the same time make an elastic or vibrating joint. Experience in these matters suggested to Weber that an elastic or vibrating joint between these glass plates was essential in order to prevent breakage in moving, or from expansion and contraction caused by heat and cold. Where the plates were merely cemented together, either with cement or paste or other analogous substance, it had been shown that such a system of work was highly objectionable and practically useless. One serious, and perhaps the controlling objection, was that as soon as the paste or glue dried the joints became hard and rigid, and there was and could be no vibration or give in the joints and the glass plates would easily break. Those cases where the glass plates were fastened together by means of metallic clips, screws or bolts (whether with or without glue or paste) were likewise found

to be objectionable. In all of these glass cases with or without the bolts the joints became rigid and the plates, were held together in a rigid, non-elastic position.

At this stage of the art, in the manufacture of all glass show-cases, Weber (the patentee) conceived the idea of making a show-case in the manner described in the patent in suit. In the specifications of his patent he says that

"The improvement resides particularly in the means of fastening one glass surface to another glass surface or to woodwork forming

part of the case.

"The object of the invention (says the patentee) is to do away with drilling holes through the glass and to dispense with metallic or other fastening devices which are commonly used at the corners for holding the plates forming the case together, and to provide a fastening which will unite the parts so securely that they cannot be separated, except by such stresses or blows as would break the glass before accomplishing the dismemberment, although by the use of a proper tool the parts may easily be separated.

"Another object (says the patentee) is to provide for a certain amount of elasticity at the joint, whereby a cushion effect is produced. If the parts were rigidly united, severe shocks received by the show-case would tend to shatter the plates or displace the parts; but in the present invention the cushion joint aids in maintaining the union of the parts, affording, as it does, an elastic or resilient joint, which eases the strain at the actual union or contact faces of the plates, thereby also greatly softening the

effects of shock received by the case."

It will be seen by this quotation from the specification of the patent, that the patentee had in view something different from anything in the prior art, and something that would accomplish results also different and superior to anything theretofore known.

The several objects to be accomplished were the following:

- (a) To do away with drilling holes through the glass and to dispense with metallic or other fastening devices;
- (b) To unite the parts so securely that they could not be separated, except by the use of a proper tool for that purpose;
- (c) To provide a certain amount of elasticity at the joint, whereby a cushion effect is produced;
- (d) The formation of an elastic or resilient joint;
- (e) To provide a structure comprising glass plates arranged in three different planes, each plate meeting and joining the other two, with an intervening cushion between the joining faces, to which cushion the glass plates are cemented.

That he accomplished these results is not disputed. He covered his invention by two claims, which read as follows:

- (1) "A structure comprising a plurality of glass plates, the edges of which are spaced from the adjacent plates, a felt cushion filling the space between the adjoining plates, the plates being cemented to the felt, each plate being adapted to freely vibrate in its natural plane of vibration, and prevented by the felt cushion from imparting its vibration to the adjacent plates;
- (2) "A structure comprising a plurality of glass plates, an unconfined edge of one plate nearly but not quite meeting another plate also with unconfined adjacent edge, an elastic material filling the space thus existing between the nearest adjacent surfaces of the plates, said plates being attached to the elastic material, whereby the plates by reason of their unconfined edges and the intervening elastic material can each vibrate or move in any direction independently."

We may here remark that the burden of the anticipatory defense is concentrated upon the use of alleged cemented felt joints. To the extent, however, of whatever differences there may be, as a matter of law or fact, between the two claims, there is no evidence directly applicable to the second claim, and that difference remains unassailed, and we contend that there is not sufficient evidence to justify a judgment that either of said claims are void by reason of the prior use claimed.

II.

PLAINTIFF'S STRUCTURE.

This patent must, of course, be construed as meaning and covering a concrete thing, to-wit: A show-case. The whole thing, and nothing more nor less than the complete show-case described. It is true that this show-case is made up of several elements which co-acting together make the show-case called for, and in order to anticipate it, the defendant must show a concrete case possessing the same elements arranged in substantially the same way and accomplishing the same purposes.

When understood, the process of construction of the plaintiff's patented show-case is not difficult, but if its fundamental principles of construction, mode of operation and the results are not fully comprehended and appreciated by the constructors, it cannot be made, at least without a pure accident, so as to operate successfully. The correctness of this statement is made manifest in the testimony of Whitcomb (a witness for the defendant). The completed structure is shown in figure (1) of the patent. The front plate, side plates and top plate resting upon front and side plates, are simple enough. The base of this structure is wood with the top edges rabbeted for the side plates to rest in; the back is also a wooden structure.

When everything is in readiness, a strip of laminated felt has ordinary cement quite thick and

plastic applied to it superficially, forming a skin, as it were, on both sides of the felt, thus retaining its natural state, thereby forming a laminated structure, comprising the two layers of cement with an intervening layer of felt forming the yielding or resilient substance. This laminated structure is then applied to the edges of the side plates and the top plate, the plates brought together in a proper juxtaposition, and at the back of the case where the glass plates fasten to the wooden structure (as shown in figure 1-9) they are bought together in the same manner.

A number of advantages over all other methods of uniting glass plates in show-cases have been realized by this structure. Among them may be mentioned the fact, that when the plates have been united in the manner described they cannot be separated without breaking the glass, except by running a sharp knife through the felt between the two layers of cement. This feature is one of considerable value, inasmuch as it permits of easy removal of a plate when desired, or when making repairs when a plate has been broken. The more important advantage, however, is the yielding nature of the felt cushion, which absorbs the sharpness of shocks on the case and obviates breakage, which so frequently happens with all other forms of fastenings, such as metallic corner fastenings or structures in which a glass plate is grooved to receive the edges of another glass plate, which parts are united by

glue at the groove, or show-cases in which the vertical glass plates are tightly fitted in grooved frames of wood or other material. In such structures a severe shock imparted directly to the front or side plates will fracture them, as a side plate has no inter-resiliency with the front plate or top plate, but this trouble is avoided by the patented device, as there is inter-resiliency between both top and vertical plates which allows each plate to move independently of the other, whether one plate alone is jarred, or whether all plates are jarred simultaneously, so that each plate vibrates in its own plane of vibration. Of course if a liquid material like that unquestionably used by Whitcomb which immediately permeates the felt and then dries and hardens, the joints necessarily became rigid and non-elastic and, therefore, obtained none of the advantages of the plaintiff's invention.

We contend that the testimony in this case (on both sides) shows conclusively that the plaintiff was the first in the art to provide a structure comprising glass plates arranged in three different planes, each plate meeting and joining the other two, with an intervening cushion between the joining faces, to which cushion the glass plates are cemented, in a method to form a structure where each plate is adapted to freely vibrate in its natural plane of vibration, and prevented by the felt, or other elastic material, from imparting its vibration to the adjacent plates.

We think from the foregoing description, to-

gether with the examination of the patent itself, the Court will have no difficulty in comprehending the plaintiff's patented structure.

The anticipatory matter upon which the defendant relies consists of some ten (10) cases, manufactured by Whitcomb in about 1899 or 1900, at Kansas City, and shipped to Joplin, Missouri, to the Cooper Drug Company, who had purchased them of Whitcomb. These cases were set up in the drug store of the said Cooper Drug Company and are there still. Another lot of four (4) or five (5) cases were manufactured by Whitcomb, in Kansas City, and sold to one Federmann at about the same time, which are still in use in that city. All of these cases have been examined and testified to by witnesses for the plaintiff and defendant.

It appears from portions of the record that Whitcomb had been experimenting in various kinds of "all glass show-cases" in an effort to find something that would accomplish the same purposes as those described in the patent in suit, but those experimental cases however made have no bearing upon the case now before the Court. The sole question is, whether the Federmann or Cooper Drug Company cases are really the full anticipation of the plaintiff's invention. It is, therefore, necessary to get a clear understanding of how these two batches of cases were constructed. The difference between them, however, is not very marked and it is not very material, for we concede that if one batch would

anticipate the patent the other would. In describing them, however, we will call the attention of the Court to the only difference that we have observed.

III.

FEDERMANN CASES.

These cases are "all glass show-cases"; felt was used in the vertical and side joints of the top plate, but not on the back rail. They were put together with a liquid substance made by Whitcomb—the component parts of which are unknown, but Whitcomb said that it was not cement, although he called it cement, but that he might just as well have called it anything else; it was a semi-liquid substance that could be poured from one vessel to another; the top plate was held to the back frame by means of bolts which were inserted through holes bored through the glass and running through the glass into the back frame.

On page 32 of the record (near the bottom) it was stipulated that the four (4) or five (5) Federmann cases were made substantially like the Cooper cases, commonly known in the record as the "Joplin cases," and the only difference between the two (disclosed by the testimony) is simply, that in the Joplin cases there was simply a piece of felt laid along the back rail, without any glue or cement, but the top plate was bolted down tight to the back frame in each instance. The evidence is overwhelming that this structure made a tight rigid joint,

which did not, and could not, permit any elasticity or resiliency in the plates, and which did not possess or accomplish any of the results sought to be accomplished by the patentee.

Now the differences between the Whitcomb structure and the plaintiff's structure are these:

- (a) Whiteomb did not use in his structure cement, but he used a semi-liquid compound of his own—the ingredients of which are unknown and which, undoubtedly, dried out in a short time and necessarily left a rigid joint; it permeated the felt so that the felt and this liquid substance when hardened possessed none of the qualities of the felt and cement used by the plaintiff;
- (b) The top plate was bolted or screwed down to the top railing of the wooden frame so that there could not possibly be any elasticity in that joint, and the top plate itself would necessarily be held by these screws in an absolutely rigid position. This rigidity would necessarily transmit its effect throughout the entire body of the case. At any rate (as we will hereafter show from the testimony) these cases did not possess the constructive features of the plaintiff's device, and did not accomplish the purposes desired to be accomplished and which were accomplished by the plaintiff's device.

While it must be conceded that Whitcomb used felt strips, he did not treat these felt strips with cement as the plaintiff did, or at all, and his method of treatment did not involve or obtain the results of an elastic resilient joint, nor provide a structure comprising a plurality of glass plates (the edges of which are spaced from the adjacent plates, a felt cushion filling the space between the adjoining plates, the plates being cemented to the felt and each plate being adapted to freely vibrate in its natural plane of vibration, and prevented by the felt cushion from imparting its vibration to the adjacent plates). On the contrary, the Whitcomb structure was not so arranged that the plates were adapted to freely vibrate, or to vibrate at all, in their natural, or any, plane of vibration, nor were the plates prevented by the felt cushion, or anything else, from imparting vibration to the adjacent plates; the joints being rigid in the Whitcomb cases no such result could be produced.

IV.

ARGUMENT.

As already partially indicated, our contention is: That the evidence shows that these Joplin and Federmann cases were not the equivalent or anticipatory of the patented invention for the following reasons:

- (a) They did not have cement in the joints, but a semi-liquid substance of unknown ingredients which was not cement;
- (b) The ingredient used in these cases permeated the felt and soon dried out, and as soon as the

water, or other liquid substance evaporated the joints became hard and rigid, so that there could not be any elasticity or resiliency. The top plates were bolted down to the wooden frame by boring holes through the glass and inserting the bolt or screw through the glass plate into the wood, so as to make the joint along the back rail absolutely rigid, which necessarily influenced the rigidity of the entire case, so that the case thus made was not the case described in the patent;

(c) The plates were not so "cemented" to the felt so that each plate was adapted to freely vibrate in its natural plane of vibration, and prevented by the felt cushion from imparting its vibration to the adjacent plates.

As these are the crucial points in the case, we desire to refer to the testimony to establish the correctness of our statement of the facts.

We shall contend that, from the evidence and under the law, the case hinges upon the proposition as to whether the Joplin and Federmann structures made an elastic and resilient joint between the plates, so that the said plates might freely vibrate in their own natural plane, and being prevented by the laminated felt cushion from imparting vibration from one plate to the other, for if the Joplin and Federmann structures produced that result it would show substantial similarity in the method of construction. But on the contrary if that result was not produced or obtained by their method of

construction it would demonstrate beyond question the diversity in the means used. In other words, if these structures would not produce these results, it is conclusive evidence (as we will show when we come to discuss the law of the case) that there was a difference in the structure, which we shall claim was a patentable difference.

William G. Whitcomb, of Kansas City, Mo., was the principal witness on the part of the defense to sustain the contention of the defendant, and to establish the similarity and equivalency of the two devices. Commencing at the bottom of page 30 of the transcript he testifies concerning these cases, and on page 31 he says:

"The glass plates in these Joplin and Federmann cases were fastened together with a preparation that I made myself; it was not ordinary cement. I would go into a drug store and get the druggist to give me some drug and fix up some stuff and call it cement; I might have called it something else; I might have called it 'dog,' but didn't. . . . I have not got any of it; it has to be used right away. . . I didn't like to make them; didn't want to make them; talked a fellow out of them. If a fellow came in and wanted one case I would talk him out of it. My custom has been to advise people not to take them. I am willing for both sides to assume that the Federmann and Joplin cases would be a fair representation of my idea of how I manufactured cases along in 1898 and 1905. I do not think that these 'all glass show-cases' are a good practical proposition—those that I have seen; I do not consider any of them a success. The drug company cases at Joplin had felt joints. The other material used by me in making them was 'cement'; I made it myself; it was a special material—something that I worked out myself; naturally didn't publish it; it was a special preparation which I called 'cement'; it was a soft material—something like paint; we could pour it from one vessel to another; I suppose it would have a tendency to harden; naturally most anything would evaporate or harden; it permeated the felt at first, and then I got felt that we had treated water proof; I can't think what we called it."

It will be noted here that these Joplin and Federmann cases were not made with his so-called "water proof felt." He got this idea of water proof felt years later, and probably after the issuance of the patent. The testimony does not clearly show when he did get his "water proof felt," but it is clear that the Joplin and Federmann cases were not made with it; these were the first cases that he made of this class, according to his own story.

Commencing on page 42 of the transcript appears, under the head of "Defendant's proposed amendments to the condensed statement of the testimony taken in the above entitled action," a little more detailed statement by Whitcomb, as to how he made these Federmann and Joplin cases, and some others, which were made the same way, but there is nothing in it to create any substantial conflict with what I have quoted from the plaintiff's statement of the case.

On page 44 (near the middle of the page) he says:

"These Joplin cases were constructed with felt in the joints between the glass, with an adhesive substance on either side of the felt adhering it to the glass; that the cement used in those cases was a preparation he got up himself; that he used felt in the joints of these 'all glass cemented cases' for the vibration of the case (what distinction the witness intended to draw here between the 'vibration of the case' and the 'vibration of the plates' in different planes, we do not know); that he made some with felt simply stuck one plate of glass on the other plate and found it was so solid that any little jar would break it; then he thought of felt to give the elastic movement and make an elastic joint; that the joints in the Federmann cases, and all those are not hard and fixed, they appear to be solid, but there must be some give to them or they will break."

Of course, the witness was here arguing the proposition, and was compelled to admit that they appeared to be solid. But, in his opinion there must have been some give, or they would break. The fact is, that some of the plates had broken in eight out of ten of the Joplin cases for various reasons, and also some of the Federmann plates. But, giving the most liberal construction to this testimony, and even admitting that it is to some extent in conflict with the first portion of his testimony as it appears in the statement, still it is not sufficient to show (especially in view of the other testimony on the subject) that these Joplin and Federmann cases were so constructed with such cement, or other material, as to give that vibration necessary to accomplish the purposes sought and accomplished by the patented invention; it does not establish any resiliency or vibration, or that their method of construction prevented any plate from imparting its vibration to the adjacent plates. It will be observed here that this could not occur to the top plate, which is the most important of all. There could be no vibration along the side joints of the top plate on account of the rigidity caused by the bolts or screws being inserted along the back edge. If the plate was rigid along the back edge, or any other edge, it would destroy any vibration in that plate at least, and this effect would necessarily be imparted to all the plates upon which it rested.

William N. Federmann testified on behalf of the defendant, and on pages 32 and 33 gave the following testimony upon the material points involved in the case:

"It was admitted that the four or five Federmann cases were made substantially like the Cooper drug store cases (commonly known in the record as the 'Joplin cases')"; the witness then proceeds to say:

"I think, so far as my impression and observation goes, the joints were solid tight joints; that the glue or cement, or whatever material was put in between the glass plates, made a solid joint—as I understand it—and that, according to my knowledge, information and observation, during all these years, there was no elasticity in the joints at all; none that I know of. All the cases furnished me by Mr. Whitcomb came with the bolts in the corners as shown by the exhibit of the Joplin Drug Company cases on file in this cause, with the exception that some of them had bolts in the middle of the case along the back rail."

His testimony is direct and positive.

In the defendant's Proposed Amendments to the Plaintiff's Statement, and commencing on page "45" of the transcript, appears a little more of the testimony of Federmann, which was inserted for the purpose of attempting to qualify his positive statements already quoted, but the qualification is of so slight a nature that we do not consider it worth while to dwell upon it. He does not attempt to qualify the statement, that according to his knowledge, information and observation during all these years there was no elasticity in the joints at all, and if this be true it is all that we have to establish.

Gustav A. Holm Jr., on page 33, Tr., testified on behalf of the plaintiff as follows:

"I have repaired a number of the Whitcomb all-glass show-cases; they were put together with some kind of a composition; I couldn't tell you what it is, but it seemed to be a very hard substance after it dried. It made a hard, solid joint. I do not know what kind of a paste or cement, or glue or what it was; couldn't tell anything about it. I saw some rubber in some of the joints and some other substance there that must have been soft when it was put on; some kind of a paste."

This testimony does not indicate a show-case anything like the plaintiff's patented case. It does not refer to the Joplin or Federman cases, and is only purtenant to show that along about that time he was making these rigid jointed cases, and that they were looked upon by the public, and by all those who had anything to do with them, as rigid jointed cases.

H. W. Jackson was then sworn on behalf of the plaintiff, and testified as follows:

"I am a licensee of the plaintiff; I know the Whitcomb Company; I had a conversation with Mr. Whitcomb some four or five months ago about all-glass cemented show-cases; he said they were no good; he denounced the cases as being no good, on account of breakage that might occur in them, and the inaccessibility of the joints to be repaired; it was a hard matter to fix them when they got broken; he had found that his trade preferred to have the cases with clamps or with holes bored through the plates on account of the ease with which this kind of case could be repaired; also, that they could be shipped knocked down, which would be an impossibility in shipping a cement case, on account of its having to be shipped set up".

If these statements are true, they show that Whitcomb, at the time at least that he made these Joplin and Federmann cases, had no comprehension whatever of an all-glass case with elastic resilient joints, and that he never tried to make one; didn't know that it could be made, and did not appreciate the value of them when they were made.

The witness further testified:

"I have been manufacturing the plaintiff's patented show-case quite extensively; they have generally been very satisfactory to customers. All-glass cases can be shipped set up without

any difficulty. I know of some of the all-glass cases made by the Whitcomb Company back in 1902 and 1903, and along there, and know how they are made; there were joints made to look like glue had been used, or some other substance; seemed to be very hard and chipped the under side of the top plate of glass and made them unsightly. We repaired two of them; the joints in the cases repaired by us were solid and rigid".

This testimony is corroborative of the statement of the other witnesses, that Whitcomb was making a case with rigid joints, and his own testimony already quoted from page 31 shows conclusively, that he did not approve of them; that he didn't like to make them; talked a fellow out of them, and would advise people not to take them, and particularly when he made the Joplin cases he made up his mind that he didn't like the cases at all.

Taking this testimony, in connection with other testimony in the case which conclusively shows the utility, superiority and value and popularity of the patented elastic jointed case, we earnestly contend that it conclusively appears that there was a diversity of results, which could not result from similarity of means, because (as we shall show hereafter, and as hereinbefore stated) it is a fundamental principle of patent law, that diversity in results is absolute proof of diversity in means.

Mr. Fred Weber (the patentee) p. 35 Tr. testified on behalf of the plaintiff, but, as he knew nothing about the alleged anticipatory device, his testimony is not important upon this subject, except in so far as it tends to show that he knew the difference between a rigid jointed case and an elastic jointed case, and that the latter was what he was trying to obtain; and on page 36 (at the conclusion of his testimony) he said:

"I had seen show cases where the top plates were bolted onto the woodwork, making a solid joint; that was what I was endeavoring to get away from; I wanted an elastic joint and I got it."

James P. Shaffer was then sworn for the plaintiff, and on page 37, testified (among other things) that he called on Mr. Whitcomb, and put the proposition up to his Company for the purpose of obtaining contracts with the Whitcomb Company to manufacture the patented cases on a royalty basis and, after showing Mr. Whitcomb the model which was only a piece of one corner of the case, Whitcomb said that he didn't think that Mr. Shaffer would find it a good proposition, on account of the elasticity that was in the joints, and that, he had tried cemented show cases but had found them unsatisfactory, and went to his desk and brought forth a metal clamp which is very commonly known in the show-case business.

Mr. William E. Price, p. 37 Tr., the owner of the Cooper Drug Company of Kansas City, which bought these cases, known as the "Joplin cases", of Mr. Whitcomb, said (among other things) that in 1899 or 1900 he got ten (10); they were shipped knocked down. Mr. Whitcomb came down from Kansas City and set them up. I helped him set up eight of the cases; the other two I put up myself after he left; Price then described how they were made in a general sort of a way, but calls the material used "glue," which in fact was the semiliquid material prepared by Mr. Whitcomb in Kansas City, and taken down to Joplin to make up the cases. The glass on the back edge was bolted down to the wood without glue. The Insurance Company refused to insure them while they had bolts along the back rail. He says at page 38, transcript:

"The material used in the bolts (joints) looked to me just like ordinary liquid glue; it was some material that Mr. Whitcomb brought with him."

Mr. A. C. La Rue Shaffer then testified for the plaintiff, which commences on page 38; he says: that the patented cases had given satisfaction to the purchasers who used them; that they had never had any complaint since they commenced business. He says: that he examined the Federmann cases in Kansas City; one of them (I think) was a wood frame and two of them the glass was held together with clamps, and two of them were held together with a substance such as glue or similar substance; that is: the end plates were set and the front plate was held to the end plate with this substance, and the top plate was put on the top of the ends and front plate, and back rail, and the back was held by a bolt running through the top plate into the

back frame. There was no cement or glue or felt on the back rail. The top plate was held to the back frame by means of bolts, by boring a hole into the glass and running the bolt through the glass into the back frame. These cases were not constructed according to the description of the Weber patent.

He says: he knew the Cooper Drug Company in Joplin, and he went to examine their cases. Whitcomb stated, that he had made some cases back there in 1899 or 1900, and that he went down to investigate and see how they were made. Two of the cases, which appeared to be in their original shape, were held together with glue and felt, with bolts through the top plate into the back frame to hold the top plate to the back frame. He says: he thought it vital to use something in the joints that would not permeate the felt. If you permeate the felt it draws up and makes a hard joint, and that is what we avoid in the patent. Our patent covers an elastic joint; that is: when we made a case we made it with an elastic joint. The Federmann cases are what I call solid joints all through, because the material used (I would call it "glue") would permeate the felt and make a hard joint. Whatever material he used permeated the felt and bolts were used as before described. The Joplin cases (he said) are the same composition as the Federmann cases, and his testimony with reference to the Federmann cases applied to the Joplin cases.

A. E. Edwards, a witness for the defendant

(whose testimony commences on page 40 of the transcript) testified: That his Company manufactured the show cases used by the defendant in the suit; that he had had about four years experience in the manufacture of this kind of show-case (this four years immediately preceded the commencement of this suit); he said: that he was familiar with the ingredients that are used in cementing the cases together; it is a combination of drugs, oils, etc., making a cement so that it will work easily, and is used in connection with felt; he said:

"I think when the proper kind of cement and felt are used (under the proper conditions) that it makes an ideal joint."

Outside of some testimony proposed by the defense as additions to our statement (some of which we have referred to), this constitutes the testimony in the case. The testimony brought forth by the proposed amendments of the defendant to the statement does not add to or detract from anything stated in the original condensed statement prepared by the plaintiff under the Rules of the Court.

It may be further remarked, with reference to this testimony, that it very clearly shows, that the plaintiff's patented case had gone quite extensively into public use, and wherever it had become known and understood it has superseded all other cases, and that the business of selling and the use of these cases is constantly increasing. It will be seen from the foregoing, that the case is not a complicated one. The whole contention may be dogmatically stated as follows:

- (a) The plaintiff's patented case is made up by the use of felt and cement in the joints between the respective plates, so united and constructed that each plate is adapted to freely vibrate in its natural plane of vibration, and each plate is prevented from imparting its vibration to the adjacent plates;
- (b) The anticipating devices relied upon are not made up with cement and felt in the joints, so united and constructed that each plate is adapted to vibrate in its natural plane of vibration—each plate being prevented from imparting its vibration to the adjacent plates.

In other words: the said anticipating devices do not have elastic joints, so constructed and united as to prevent the vibration of the plates from imparting such vibration to the adjacent plates. In other words: the joints being rigid any vibration in a given plate must of necessity be imparted to the adjacent plates.

V.

THE LAW OF THE CASE.

It seems to us, that the first question that would necessarily address itself to the mind of the Court is this:

Is a glass case so constructed as to have rigid joints, and where the glass plates do not, nor cannot freely vibrate, or vibrate at all, in its natural plane and must necessarily impart the respective vibrations when they occur in any plate to its adjacent plates an anticipation of a structure which is so constructed that each plate is adapted to vibrate in its natural plane of vibration, and is prevented by a felt cushion from imparting its vibration to the adjacent plates?

This statement also involves a consideration of the effect of having the top plate bolted down with metallic screws or bolts to the back rail, and thus making the joint between the wooden frame and the top plate along the back absolutely rigid. It is not contended that the claims of the patent in terms cover the use of felt and cement along the back rail between the wooden surface and the back edge of the top plate; or, in other words: the joining of glass to wood by the means described. Although the fastening of one glass surface to woodwork forming the parts of the case, is mentioned in the specifications as a part of the subject matter to which the improvement relates. The only effect that we claim flows from the fact of so bolting or screwing down the back edge of the top plate is, that it necessarily makes a rigid joint between the wood and the glass, which to a greater or less extent imparts its rigidity to its adjacent plates, and helps to differentiate the two cases, and tends to show the physical differences between the two cases as a whole, and to explain the reason why the joints between the top and side plates of the plaint-iff's patented device are enabled to impart elasticity and resiliency to the several glass plates, and why this result cannot be accomplished in the other cases.

The defense at the hearing below had a good deal to say, and probably will again, in argument, that the phrase in the first claim of the patent "each plate being adapted to freely vibrate in its natural plane of vibration, and prevented by the felt cushion from imparting its vibration to the adjacent plates" is a mere statement of a result which is not patentable. Of course, results are not patentable; it is the means by which results are accomplished that is patentable. But, the results from certain arrangements are very frequently and properly inserted in the specifications and claims of the patent, for the purpose of limitation and explanation as to what a certain arangement of certain physical things do, or will do, or what results will flow therefrom:

Stewart vs. Mahoney, 5 Fed. page 302;

In this case the patentee is limited to a structural arrangement by which each plate is adapted to freely vibrate in its natural plane of vibration, and prevented from imparting its vibration to the adjacent plates. And it is apparent—even self evident -that this very expression would prevent the plaintiff from claiming as an infringement of its patent any show-case which would not accomplish that result; and it is equally clear and self evident, at least to us, that any device that would not accomplish these results would be a different device and could not anticipate the patented device, for like means produce like results the world over, and if the results are different the means must likewise be different. It is seldom that a case comes before the Courts where this rule becomes so pointed, so apparent and perhaps so important. The patented device accomplishes certain specified meritorious results. The anticipatory devices do not, and cannot produce the same, similar, or analogous results. Are the devices, or means used, the same? How can the results be different, and the means the same, or the means the same and the results different?

It may be that Whitcomb had some dim, indefinite and undeveloped idea of making a glass case with elastic joints, and to construct a case where the several plates might, or would, vibrate in their several planes of vibration without imparting the same to the adjacent plates; and that he was experimenting along this line without knowing what he would in fact produce. But, his own testimony would indicate that he never had conceived the idea of an elastic joint which would permit the

several plates to vibrate independently of the adjacent plates; certainly, he had not at the time of the making of the several anticipating devices now before the Court. The most liberal construction that can be given to his own testimony is: that he knew that the cases then on the market and in public use were not satisfactory, and that he was making blind efforts hoping that he might discover an improvement which would give better satisfaction to the trade.

We hope the Court will keep in mind, that we are now discussing the subject of anticipation and not one of invention; yet (so far) there has been no serious attack on the patent for want of invention, except as flows from the anticipatory matter. It will probably be conceded that the devices patented would involve invention were it not for the anticipatory matter.

In view of the importance of the question here, of identity of the means used by the patentee, and the means shown in the anticipatory device, we desire to return again to the question of identity as being the only real important question involved in the case, and to bring before the Court the authorities supporting our statement, that "like means produce like results, and that unlike results prove different means."

What is to be construed as the essence of the patented invention? The answer seems clear and may be stated, as being the conception of the idea

of an elastic joint, whereby the several glass plates are each permitted to vibrate in its own plane without imparting such vibration to the adjacent plates. Unquestionably at least—so far as the evidence in this case discloses, or tends to disclose—this was a novel idea.

At Section 117 (1st Vol. of Robinson on Patents) the author states a rule that we shall contend for, (and from which we will quote at length as a matter of convenience to the Court) and attempt to support it by adjudicated authority, as follows:

"The intrinsic novelty of an invention is also sometimes indicated by the nature of the end which it accomplishes, when practically employed in the arts. In all departments of physical science, a given end is usually attainable through many different means. Seldom, if ever, in the material world does any effect rest so exclusively upon a single cause that no other operation of natural or artificial forces could produce the same results. Identity of end is, therefore, no proof of identity of means. Though an alleged invention achieves no other ends than have already been obtained by using other arts or instruments, the idea of means which it embodies may still be new, and a true product of creative skill. The converse of this proposition, however, cannot be maintained. Diversity of ends never results from uniformity of means. In every cause perpetually resides every effect which it is able to produce, and as the nature of the effect depends entirely on the nature of the cause, no change can ever take place in the one without a corresponding alteration of the other. Thus, while identity of end is no proof of identity of means, diversity

of end cannot exist witout diversity of means, and every really new result furnishes in itself conclusive evidence that the cause by which it is produced is also new. Any invention, therefore, which accomplishes an end never before attained must be intrinsically new, and unless evidently a mere constructive union of known factors must, likewise, have originated in a new inventive act."

At the conclusion of this paragraph it is said: "The ends which indicate a novelty of means must be themselves actually new; by prior arts or instruments, but new results produced for the first time by that invention concerning whose intrinsic novelty the inquiry is made."

We think the rule, as here stated, and the whole of it is directly applicable to the case at bar.

The ends or results accomplished by the patented device (the essence of which we have just stated) are certainly absolutely new, for there is no evidence other than these anticipating devices themselves now before the Court bearing upon the question and, if we are correct in our conclusion that the evidence sufficiently establishes the fact that the anticipating devices did not have elastic joints which allowed the several plates to vibrate in their respective plane without imparting such vibration to the adjacent plates, then the conclusion of a diversity of means is established beyond peradventure. That this proposition is hoary with age and ripe with accumulated wisdom will be manifested by the cases hereinafter cited.

In the old case of Furbush vs. Cook (reported in 2 Fisher, 668, in the year 1857) Judge Curtis, who

was the author of the text book known as "Curtis on Patents," speaking of this subject says:

"And it is decisive evidence though not the only evidence, that a new mode of operation has been introduced, if the practical effect of the new combination is either a new effect or a materially better effect; or as good an effect more economically attained by means of the change made in the combination of the patentee. A new or improved, or more economical effect, attributable to the change made by the patentee in the mode of operation of existing machinery, proves that the change has introduced a new mode of operation, which is the subject matter of a patent."

That the novelty of the ends proves novelty of means runs through all the cases down to the present date.

In the case of Sewing Machine Company vs. Frame (24 Fed. Rep.) speaking of a similar case, near the bottom of page 597, the Court said:

"The change made in the old device was simple but effective. It produced a new and useful result. That invention was involved in accomplishing it, is manifest. Other intelligent and skillful mechanics, working towards the same end, failed to discover it."

This forcibly applies to the position occupied by Whitcomb.

In the case of *Grier* vs. *Wilt* (120 U. S. 412; 30 Law Ed., 712), at the end of the opinion in this case the Supreme Court, by Mr. Justice Gray said:

"The result being different from that in the plaintiff's device, the mechanism is different and is not an equivalent of that of the plaintiff."

In the case of *Mitchell* vs. **?** ilghman (86 U. S. 287; 22 Law Ed. 125) Mr. Justice Clifford in delivering the opinion said on page 144:

"Two things are not the same, under the patent law, when one is in practice substantially better than the other in a case where the second improvement is not gained by the use of the same means or known mechanical equivalents." (Citing Curtis on Patents, 4th Edition, Sec. 320).

At Section 118 and Section 119 (Robinson on Patents, Vol. I) the author stated as follows:

"Novelty of end is ascertained by an examination of its nature, and by a comparison of its utility with that of other ends. The end to be accomplished is the satisfaction of a public want. The satisfaction of this want consists in a changed condition of affairs, in which the want entirely disappears. This changed condition is the effect produced by the invention, and is the ultimate end to which the means embodied in the invention tends. Novelty of end is thus a new condition of the things or persons upon which the action of, the means embraced in the invention terminates, and when in their condition novelty appears, a novelty of means may safely be presumed. This novelty of end exists whenever the change in the condition of affairs is a substantial, as distinguished from a formal, change; and the change is substantial when it removes a want hitherto wholly unsupplied, or satisfies it by a change essentially distinct from any previously known."

"In cases where a change in the condition of affairs removes a want hitherto unsupplied, the character of the change itself becomes of little moment. No want, however trifling, is for the first time satisfied without the existence of a state of things which never has occurred before; and the production of this state of things requires the operation of a cause which, in itself or in its mode of operation, must be also new. This test of novelty of end is at once the simplest and the most reliable. Given a preexisting want, and its removal, and the condition of affairs, on whose production the want ceases, must be new."

In the case of *Fisher* vs. *Moore*, (1 Fisher, 544) the Court said:

"That the satisfaction of a want hitherto unsatisfied requires a new means" (as Weber said in his testimony: "he wanted an elastic joint and he got it"). "That inventive skill is indicated when the new art or article satisfies a long-felt want and is accepted as such satisfaction by the public:

Eames vs. Andrews, 122 U.S. 40;

Butler vs. Bainbridge, 29 Fed. Rep. 142;

Consolidated Valve Co. vs. Crosby Valve Company, 113 U. S. 157;

United Nickel Co. vs. California Electrical Works, 25 Fed. Rep. 475:

(and other cases cited under Section 119, Robinson on Patents, Vol. 1).

In the case of Electric R. R. Signal Company vs.

Hall Railway Signal Company (reported in the 114 U. S. 87; 29 Law Ed. 96), Mr. Justice Matthews delivering the opinion, it was held:

"To constitute identity of invention, and therefore infringement, (or anticipation) not only must the result obtained be the same, but in case the means used for its attainment is a combination of known elements, the elements combined in both cases must be the same, and combined in the same way, so that each element shall perform the same function; provided, however, that the differences alleged are not merely colorable, according to the rule forbidding the use of known equivalents."

Again, when the difference between the old and the new conditions is not evident upon their face, it may be inferred from their comparative utility. Wherever any want, already partially supplied, after some further change in the conditions of affairs is fully satisfied and ceases to exist, the difference in the usefulness of the two forms of satisfaction is often treated as sufficient evidence of substantial difference in the conditions. On the same principle a form of satisfaction, whose superiority to others is established by the fact that in its practical enjoyment by the public it has superseded every other, is usually regarded as a new condition, unless upon its face the contrary appears. If, on account of cheapness or any other greater ease of access by the public, it shows itself more useful than the old, this also, though of little consequence when other indications of novelty or similarity are present, may be sufficient to denote such a substantial variation as requires an actual difference in means.

(Robinson on Patents, Vol. 1, Sec. 121, page 173).

At Section 122 (Robinson on Patents Vol. 1) it is stated: that the unsuccessful efforts of others to produce the same results also indicates not only novelty of the end, but the necessity of inventive skill in the creation of the means whereby it is attained. The same rule is held in the following cases:

Wilcox vs. Bookwalter, 31 Fed. Rep. 224;

Celluloid Manufacturing Co. vs. American Zylonite Company, 28 Fed. 195;

Dudgeon vs. Watson, 29 Fed. Rep. 248;

Davis vs. Fredericks, 19 Fed. Rep. 99; (and many other cases that might be cited).

It has also been held that:

"Whenever the utility is proved to exist in any great degree, a sufficiency of invention to support the patent must be presumed. These remarks are pertinent to the present case, and they are obviously founded in good sense: (4 Fisher, 532."

And again, it has been held in numerous cases as follows:

"That an increase of utility in the effect pro-

duced by an invention is evidence of novelty in such effect, and so of novelty and inventive skill in the invention itself:

Roberts vs. Schreiber, 2 Fed. Rep. 855; Smith vs. Woodruff, 6 Fisher, 476:

Again, it has often been held that the unsuccessful efforts of others to accomplish the same result indicates that the means by which the present inventor accomplishes it are the fruit of inventive skill:

> Wilcox vs. Bookwalter, 31 Fed. 224; and many other cases cited in note I of Section 122, bottom of page 175 and page 176).

"That prior unsuccessful efforts of others indicate discovery of new factors by the successful inventor, see *Adams*, etc. vs. *Rathbone*, 26 Fed, 262, and many other cases cited in the last mentioned note.

In view of the fact hereinbefore stated, that the alleged anticipating device will not accomplish the results, or perform the functions of the patented device, the case of Farmers Mfg. Company vs. Spruks Mfg. Company (127 Fed. 691) is directly in point. It is there said—amongst other things:

"A patent for a device which fails to accomplish the desired end, is not an anticipation of one for a device which successfully accomplishes it."

This is simply a further exemplification of the

rule: that like produces like and that where the results are different the means must likewise be different.

The opinion of the court in this case presents a strong argument in support of our contentions in the case now before the Court, and a very forcible quotation from the celebrated Barbed Wire Case, in 143 U. S. 275, appears; and for the convenience of the Court we will here insert it:

"It is true that the affixing of barbs to a fence wire does not apparently give a wide scope to the ingenuity of the inventor; but, from the crude device of Hunt to the perfected wire of Glidden, each patent has marked a step in the progress in the art. The difference between the Kelly fence and the Glidden fence is not a radical one; but, slight as it may seem to be, it was apparently this which made the barbed wire fence a practical and commercial success Under such circumstances. Courts have not been reluctant to sustain the patent to the man who has taken the final step which has turned a failure into a success. the law of patents, it is the last step that wins. It may be strange that, considering the important results obtained by Kelly in his patent, it did not occur to him to substitute a coiled wire in place of the wire-shaped prong, but evidently it did not; and to the man to whom it did ought not to be denied the quality of invention. There are many instances in the reported decisions in this Court where the monopoly has been sustained in favor of the last of a series of inventors, all of whom were groping to attain a certain result, which only the last one of the number seemed able to grasp. Conspicuous among these is the case of Loom vs. Higgins,

105 U. S. 580; 591 (26 L. Ed. 1177), where an improvement in looms for weaving pile fabrics, consisting of such a new combination of known devices as to give to a loom the capacity of weaving 50 yards of carpet a day when before it could only weave 40, was held to be patentable. It was said by the Court, in answer to the argument that the combination was a mere aggregation of old and well-known devices, that 'this argument would be sound if the combination claimed by Webster was an obvious one for attaining the advantages proposed—one which would occur to any mechanic skilled in the art. But it is plain from the evidence, and from the very fact that it was not sooner adopted and used, that it did not for years occur in this light to even the most skillful persons. may have been under their very eyes. They may almost be said to have stumbled over it. but they certainly failed to see it, to estimate its value, and to bring it into notice. . Now that it has succeeded, it may seem very plain to anyone that he could have done it as well. This is often the case with inventions of the greatest merit. It may be laid down as a general rule, though, perhaps, not an invariable one, that if a new combination and arrangement of known elements produce a new and beneficial result, never attained before, it is evidence of invention'.

So, in Consolidated Valve Company vs. Crosby Valve Company (113 U. S. 157, 179; 6 Sup. Ct. 513, 525; 28 L. Ed. 939) it was said:

'That Richardson's invention brought to success what prior inventors had essayed and partly accomplished. He used some things which had been used before, but he added just that which was necessary to make the whole a practically valuable and economical apparatus. The fact that the known valves were not used, and the speedy and extensive adoption of Rich-

ardson's valve, are facts in harmony with the evidence that this valve contains just what the prior valves lack, and go to support the conclusion at which we have arrived on the question of novelty.'

In Smith vs. Goodyear Dental Vulcanite Company, (93 U. S. 486-495; 23 L. Ed. 952) it was said by the Court:

'We do not say that the single fact that a device has grown into general use, and has displaced other devices which had previously been employed for analogous uses, establishes in all cases that the later device involves a patentable invention. It may, however, always be considered; and, when the other facts in the case leave the question in doubt, it is sufficient to turn the scale'.'

In Keystone Manufacturing Company vs. Adams, (151 U. S. 144; 14 Sup. Ct. 297; 38 L. Ed. 103) the Court says:

"Where a patentable invention consists of an improvement of a machine previously existing, it is not always easy to point out what it is that distinguishes a new and successful machine from an old and ineffectual one; but when, in a class of machines so widely used as this in question, it is made to appear at least, after repeated and futile attempts, a machine has been contrived which accomplishes the result desired, and when the Patent Office has granted a patent to the successful inventor, the Court should not be ready to adopt a narrow or astute construction fatal to the grant."

In Smith vs. Goodyear Dental Vulcanite Company, (93 U. S. 598; 23 L. Ed. 952) the Court says:

"The patent itself is prima facie evidence

that the patentee was the first inventor. At least, it casts upon him who denies it the burden of sustaining his denial by proof. We do not find such proof in the case."

In Topliff vs. Topliff, et al., (145 U. S. 156; 12 Sup. Ct. 825; 36 L. Ed. 658) the Court says:

"It is not sufficient to constitute an anticipation that the device relied upon might, by modification, be made to accomplish the function performed by the patent in question, if it were not designed by its maker, nor adapted nor actually used, for the performance of such function."

The simplicity and apparently obvious nature of East's device seem to be the chief argument against its patentability, but the books are full of cases where patents have been sustained for changes in methods which seem equally simple. The substitution of the hot blast for the cold in making iron; the use of a flame of gas to finish cloth, rather than the flame of oil; the substitution of pit coal for charcoal, and of anthracite coal for bituminous coal, in certain processes—, are some of them.

It will be noted that in the Barbed Wire Case the Court used the expression that: "In the law of patents it is the last step that wins." This has since been used quite frequently in the discussion of questions of this kind, and it is peculiarly applicable to the case at bar; as it appears, that in the construction of all-glass cases the elastic joint proposition is the last step that so far has been utilized in the art.

In the case of *United Shirt & Collar Company* vs. *Beattie* (149 Fed. 736) the Court said:

"A patent for a successful machine is not void for anticipation, because a prior machine intended for a different purpose may possibly be capable of use as an inefficient substitute for the later machine."

In the case of Wales vs. Waterbury Mfg. Company (59 Fed. 285) the Court said:

"One who takes old devices with material defects and—retaining the desirable features, adapts them by novel modifications to new and varying conditions so as to produce an article superior to all others, is not anticipated by such prior devices."

Also see:

Mfg. Co. vs. Carey, 147 U. S. 626;

Thomson vs. Bank, 53 Fed. 250;

Ansonia Brass & Copper Co. vs. Electrical Supply Co., 144 U. S. 11;

In the case of St. Louis Street Flushing Machine Company vs. American Street Flushing Machine Company (156 Fed. 574) the Court, commenting upon a similar question, used the following language:

"It is not necessary that a result before unknown should be brought about, but it is sufficient if an old result is accomplished in a new and more effective way. If the value and effectiveness of a machine are substantially increased, the new combination of old elements which does it is patentable:"

Citing:

Loom Co. vs. Higgins, 105 U. S. 580, 591; 26 L. Ed. 1177;

Cantrell vs. Wallick, 117 U. S. 689, 694; 6 Sup. Ct. 970; 29 L. Ed. 1017;

Anderson vs. Collins, 122 Fed. 451;

In the case of *Boyer* vs. *Keller Tool Company* (127 Fed. 138) the Court said:

"Where the patentee has supplied features that have brought success, where others who preceded him failed, the Court will not scan narrowly the means by which it has been attained. The mechanical elements may be old, and to a certain extent the result accomplished but where the combination is new, the efficacy attained, being much in advance of what has gone before, suggests—if it does not prove—the existence of inventive skill; (and cited in support thereof a number of cases as follows):

Sessions vs. Romadka, 145 U. S. 29; 12 Sup. Ct. 799; 36 L. Ed. 609;

Hobbs vs. *Beach*, 180 U. S. 383; 21 Sup. Ct. 409; 45 L. Ed. 586;

Taylor vs. Sawyer Spindle Co., 75 Fed. 301; 22 C. C. A. 203;

Stevenson vs. McFassell, 90 Fed. 707; 33 C. C. A. 249;

National Brake Beam Co. vs. Interchangeable Brake Beam Co., 106 Fed. 693; 45 C. C. A. 544; In the case of Starr Brass Works vs. General Electric Company (111 Fed. 398,) the Court said:

"Where the departure from former means is small, yet the change is important, the doubt as to whether the inventive faculty has been exercised has to be weighed in view of the fact that the device in question has displaced others and this may decide the issue in favor of invention, especially where another inventor of conceded ability has been working to attain the same end and had failed. The change 'seems simple enough now but it was the first to combine comprehension of the problem to be solved with a practical arrangement of parts for its solution';

See also:

Buchanan, et al. vs. Perkins Electric Switch Mfg. Co., 135 Fed. 90;

In the case of *Eldred* vs. *Kirkland* (130 Fed. 342) the Court said:

"Where the patentee is the first to produce a self-igniting and self-extinguishing fluid burning cigar lighter and a prior patentee, while seeking the same result failed, such prior patent cannot seriously limit the scope of the later patent, but offers mute but persuasive tribute to the ingenuity of such later patentee."

See also:

Curtis vs. Atlas Co., 136 Fed. 222;"

In the case of *Davis* vs. *Fredericks* (19 Fed. 99) the Court said:

"Plaintiff's patent was for an improvement in scoops. The first scoops were made in pieces and fastened together after being shaped. Plaintiff's scoop was made in one piece. hit upon the necessary pattern for the sheet metal to produce this result must have required calculation and experiment beyond the practice of mere mechanical skill and good workmanship. It seems to be entitled to be classed as inventive. A new thing was produced, better for some purposes than had been produced before, although many skilled workmen had been practicing the making of those known before and making as good as they could without reaching this. He hit upon this while no one else did, although it appears to be easy of accomplishment when seen. This success seems to be within the benefits of the patent law."

A United States patent in due form is presumed to be valid and is *prima facie* evidence of its own validity; also that the invention is a new and useful one, and that the patentee was the first and original inventor of the thing patented, and every reasonable doubt should be resolved against him:

Smith vs. Goodyear, 93 U. S. 486; Lehnbeuter vs. Holthaus, 105 U. S. 94;

One who asserts the invalidity of the patent for any of the statutory reasons at least, has the burden of proof cast upon him, and he must establish his anticipatory matter beyond a reasonable doubt.

In Willians vs. American, 86 Fed. 642, decided by the Court of Appeals of the Seventh Circuit, it is said:

"Anticipation should not be found in prior devices in the art to which the patent belongs unless they are of such a character as to furnish clear, if not unmistakable suggestion, of the improvement in question":

See also:

Hopkins on Patents, Vol. 1, Sec. 205;

What was there in these so-called Whitcomb cases to suggest the improvements patented? There was certainly nothing to suggest any elastic or flexible joint, or the idea of having any sort of a joint which would allow the respective glass plates to vibrate in their respective planes of vibration, and thus prevent breakage. Certainly the bolting down of the top plate to the back frame would not convey any such suggestion.

Again it is a familiar rule, that the accomplishment of the same results is not anticipation, unless it is done by the same means in substantially the same way. This rule is not strictly applicable to this case, because the results are not the same and, of course, as hereinbefore shown, the means must be different.

In Simonds Rolling Machine Co. vs. Hathorn Mfg. Company, et al. (93 Fed. 958) the Court said:

"On a question of anticipation, if the identity of methods and results is doubtful, the doubt must be resolved in favor of the successful patentee, who—in a practical way—has materially advanced the art": See also:

Hopkins on Patents, Vol. 1. Sec. 211.

In Ideal Stopper Co. vs. Crown Cork & Steel Company, (131 Fed. 244) the Court said:

"The line which separates invention from mechanical skill is at best a narrow one, and the difficulty of demarkation in this case is enhanced by the fact that of necessity, we look upon the alleged auticipation with eyes instructed by the patent in suit and other subsequent patents, and must take care that we do not in such light reconstruct the alleged anticipation so as to see in it the possibilities which may seem very obvious now, but which may not have been disclosed by the patent itself."

So looking backward from the patent in suit, it might appear easy to say: well, all you have to do with the patented device is to use ordinary cement instead of Whitcomb's semi-liquid drug composition which he said was not cement, but that he called it cement instead of calling it "dog", which he might have done but didn't, and then you would have the "Weber patented device" with its elastic joints and so constructed that the respective glass plates could vibrate in their own natural plane of vibration, and leaving out the bolts in the top plate and inserting cement and felt in the joint along the wooden frame, you might then have all the benefits of the plaintiff's patent. It may be argued, that this would be very easily done, but the trouble is: that Whitcomb didn't know how to do it, and didn't

do it, and consequently did not accomplish the results of the patented device.

In the case of Coffin vs. Ogden, 85 U. S. 120; 21 L. Ed. 821, the Court said:

"The invention or discovery relied upon as a defense, must have been complete, and capable of producing the result sought to be accomplished; and this must be shown by the defendant. The burden of proof rests upon him, and every reasonable doubt must be resolved against him. If the thing were embryonic or inchoate; if it rested in speculation or experiment; if the process pursued for its development had failed to reach the point of consummation, it cannot avail to defeat a patent founded upon a discovery or invention which was completed. The law requires, not conjectures but certainty. the question relate to a machine, as thus exhibited, the conception must have been clothed in substantial forms which demonstrate at once its practical efficiency and utility."

It seems to us that this case is absolutely conclusive of our contention in the case at bar. Under the authority of this case, it was incumbent upon the defendant to show:

- (a) That the anticipatory devices were complete and capable of producing the results sought to be accomplished by the patent; in other words: it was incumbent upon the defendant to show beyond a reasonable doubt, that the joints in the Whitcomb case were elastic;
 - (b) That the several glass plates could, would

and did permit that vibratory and flexible action in their respective planes of vibration without imparting the same to the adjacent plates; in other words; it was incumbent upon the defendant to show beyond a reasonable doubt, that the anticipatory structures accomplished the same results as the p, tented device.

These things are not to rest in conjecture, but they must be established by the defendant, by competent evidence of sufficient weight to satisfy the mind of the Court beyond a reasonable doubt.

We say: that the defendant absolutely failed to produce any such evidence in the case, and that all the testimony upon the subject goes to show that the Whitcomb cases did not have elastic joints, and that they did have rigid joints; and that, as a necessary consequence thereof, the several glass plates could not vibrate in their respective planes of vibration without transmitting such vibration to the adjacent plates and, therefore, could not produce the results sought by the patentee.

In the case of *Cantrell* vs. *Wallick* (117 U. S. 689; 29 L. Ed. 1017) the Court said:

"Not only is the burden of proof to make good this defense upon the party setting it up, but it has been held that 'every reasonable doubt should be resolved against him'."

See also:

Busch vs. Jones, 184 U. S. 598.

In the case of McNeely vs. Williams (96 Fed. 978) the Court said:

"To sustain the defense of anticipation, it is necessary that the anticipatory matter should clearly show the invention subsequently patented, in such manner as to enable any person skilled in the art or science to which it relates to construct, and practically use, the invention for purposes contemplated by the subsequent patent."

Can anyone successfully maintain that there was enough in these anticipatory devices, with their rigid joints and bolted down top plates, to suggest the elastic cemented felt joints described in the patent?

(See also:

American vs. Fiber, 90 U. S. 566).

In the case of *Edison* vs. *Electric* (66 Fed. 309) the Court said:

"A prior device which in some degree performs the function of the patent in suit, but the purpose and function of which was wholly different, and which in no way pointed out the function of the device in suit cannot be construed as an anticipation."

In the case at bar the anticipatory device in no way pointed out the function of the patented device in suit. Consequently, in view of the law as we have attempted to show, we insist that a rigid joint is not an elastic joint; that glass plates which can-

not freely vibrate in their respective planes of vibration without imparting the same to the adjacent plates, but which are prevented from so doing by the rigid joints, re-enforced (as in this case) by the bolting down of the back edge of the top plate to the wooden frame, cannot possibly be an anticipation of an elastic joint made as described in the patent and producing the results mentioned therein.

VI.

OPINION OF JUDGE RUDKIN IN DISMISSING A BILL.

While it is somewhat unpleasant to criticize the opinion of a very learned Judge of high standing, yet in this case we are compelled to urge that the Judge did not grasp the facts, nor the law of the case, and by some means was lead into error as to the facts which necessarily resulted in erroneous conclusions. The Judge entirely misunderstood the testimony as to how the Whitcomb cases were made.

In his opinion, on page 59, in describing these structures, the Judge said:

"The base and back frame work of the Whitcomb cases were made of wood, while the ends, front and top were of plate glass. The two end plates were imbedded in the wooden base and in the wooden frame work at the rear. The front plate was likewise imbedded in the wooden base and cemented to the end plates with a strip of felt between the plates and the joint."

We do not care to indulge much in mere verbal criticisms, but in this case when the Judge speaks of a strip of felt between the plates and the joint, he was inaccurate, because the felt is not between the plates and the joint, but the felt and cement is what makes the joint by being placed between the edges of the respective plates, constituting the joint in question. But, the more serious and fatal mistake was in saying: that the plates in the Whitcomb cases were in any manner cemented together. The Judge evidently forgot, that Whitcomb testified point blank on page 31 of the Transcript (hereinbefore quoted):

"The glass plates in these Joplin and Federmann cases were fastened together with a preparation that I made myself; it was not ordinary cement. I would go into a drug store and get the druggist to give me some drug and fix up some stuff and call it cement; I might have called it something else, but did not; I might have called it 'dog', but didn't. . . . These glass plates in the Joplin cases were fastened together with a preparation I got up myself, and called it 'cement';"

and on page 32 of the Transcript he says:

"I made it myself; it was a special material—something I worked out myself; naturally didn't publish it; it was a special preparation which I called 'cement'. It was a soft material—something like paint; we could pour it from one vessel to another. I suppose it would have a tendency to harden, naturally most anything would evaporate or harden. It permeated the felt at first, etc."

The Judge was, no doubt, mislead in the use of this word "cement" because, after this explanation of what material he, Whitcomb, did use in constructing these cases, he used the word "cement" (everybody understanding that he meant this semi-liquid material that was like paint, and which could be poured from one vessel to another and not cement in its true sense, or in any sense). Right here is where the trouble arose; the material that he did use permeated the felt and made a rigid joint, but the Judge in his opinion treats it as the same material (cement) used by the patentee, and treats the whole case as if the joints were made in the same way and produced precisely the same results.

Later on (at page 59 of the transcript) the Judge says:

"The Weber patent cases are in all respects similar to the Whitcomb cases with the single exception that cement is substituted for metal screws for the purpose of fastening down the rear of the top plate," etc.

Now this is clearly erroneous. Then on page 60, the Judge says:

"The Weber patent must fail for two reasons:

First: Because the mode of fastening or joining glass to wood is not covered by the claim in the Weber application (meaning the Weber patent)"

Now we never claimed, and do not now claim,

the claims of the patent do in terms cover the fastening or joining of the back edge of the top plate to the wooden frame. We have only referred to that as a feature which marked a distinction between the two cases as a whole, and as one thing which assisted to a greater or less extent in making the joints of the Whitcomb cases rigid instead of elastic and flexible, and as tending to re-enforce our proposition, that the respective glass plates of the Whitcomb cases could not, and were not intended to, vibrate in their several planes of vibration.

On page 60, as another reason for denying plaintiff the relief sought, the Judge refers to the statement in the claims: that in cases where screws were used the plates cannot vibrate in their respective planes of vibration without imparting its vibration to the adjacent plates; and the Court then holds, that this was a mere result which is not patentable. The conclusion is correct that results are not patentable, but (as we have already adverted to at some length) while the result is not patentable it is absolutely determinative of the question of identity, because "like produces like, and where the means are the same the results must be the same, and where the results are different the means cannot be the same. As the question to be determined is the identity of one device with the other, it is evident that the Judge failed to recognize this well established and well known elementary rule in determining this question of identity. Again, when the Court stated: "that the substitution of cement

for screws would occur to the rudest and most unskilled mechanic, and that such a change would not call for the exercise of inventive genius or creative faculty," it stated a broad proposition that is not involved in the case, except so far as the attachment of the back edge of the top plate to the wooden frame is concerned, which (as we say) is not specifically covered by the claims of the patent. whether such a substitution of cemented felt joints making an elastic joint, instead of the use of screws throughout the whole device making rigid joints. would suggest itself to the unskilled mechanic, and therefore would not require the exercise of the inventive faculty, is altogether another question, and is not involved here, because the anticipatory showcases were not made with screws, except along the back plate, and no question of equivalency or of invention is involved so far as the fastening of the back edge of the top plate to the wooden frame is concerned.

We cannot see the application of this reasoning, because there is nothing in the patent to suggest to anyone that the substitution of cement along the back rail for the screws was the new idea, or the thing, or device, or process patented.

The Judge then on page 62 quotes a very familiar rule, and one that is of almost universal application, in determining this question of infringement or anticipation, which is as follows:

[&]quot;That which infringes, if later, anticipates, if earlier."

This rule is stated in several forms; one way of putting it is as follows:

"If one invention infringes another if later, it anticipates it if earlier."

There are many United States Supreme Court cases affirming this rule, and there is no question about its correctness; but let us see how it works in this case.

The patent cases have elastic flexible joints made with felt and ordinary cement in all the joints, the cement not permeating the felt; the result being that the several plates making up the patented glass cases are enabled to freely vibrate in their respective planes of vibration without imparting their vibration to the adjacent plates. There is no contention but that these are the results of the patented structure, as described in the patent itself. There is no dispute, but that all of the objects or purposes of the patented device, as stated in the specification, are accomplished by this method of constructing an all-glass show-case. Now let us turn to the Whitcomb cases; they are glass showcases; the joints uniting the glass plates are made with felt and a semi-liquid paint like material, which can be poured from one vessel to another, and which when applied permeated the felt and made a rigid joint, and to increase, or insure, the rigidity of the joint the back edge of the top plate was bolted down tight to the wooden frame, which would tend to prevent any vibration in the top plates, but should there be any vibration in the plate caused by jars or knocks it would be instantly transmitted to the adjacent plates.

Now to carry out our argument, we will suppose that the Whitcomb cases were subsequent to the patent and that Weber had sued Whitcomb for infringing his patent. Weber would introduce his patent, and the patent itself would be prima facie evidence that his structure was one, the objects of which were to produce an elastic or flexible joint, whereby the respective plates were permitted to vibrate without imparting their vibratory action to the adjacent plates; at this point he rests. Whitcomb then opens his defense of non-infringement, by showing that he did not use cement in his joints, but a semi-liquid drug compound made up by himself, which permeated the felt and which could be poured from one vessel to another like paint; the result of which was a rigid joint, and that the several glass plates could not vibrate in their respective planes of vibration without imparting the same to their adjacent plates; in other words: that any vibration that might take place by reason of any strain or jar would necessarily be imparted to the adjacent plates. He then adds to his proof the fact, that in order to make it sure that these several joints were rigid and that the plates could not vibrate, as above described, he bolted down the back edge of the back plate to the wooden frame in a tight solid manner, so that any vibration which might take place, would necessarily be imparted to

the adjacent plates and throughout the whole device.

Could it be reasonably said, that a case of infringement had been made out. The defendant would appeal to the law, as we have stated it in this brief, and show that as the results were absolutely different, and being so, the means were necessarily different, and that, therefore, there could be no infringement. The defendant would establish beyond a doubt that he did not obtain the results sought by the patentee; that he had none of its advantages or benefits, and could not invade any of his patented rights whatever. Consequently, we say: that the rule suggested by the Court—while correct in itself—was not properly applied, because it could not be held that the Whitcomb cases (if subsequent to the plaintiff's patent) could have been any infringement of the patent.

It is too well known to need any citation of authorities other than what we have already made, that one device which does not accomplish the same results as another device is not the same thing in the eyes of the patent law, and would not, and could not, infringe it.

In conclusion permit us to say: that, while this invention seems to be small and narrow, it is of great importance (much greater than it would seem to be at first blush). Under the protection, presumed to have been given by the patent, plaintiff has invested large sums of money and built up

quite an extensive and profitable business, relying upon the protection given by the patent. It has gone into extensive use, and wherever brought in competition with the prior structures has, to a large extent superseded them. As Mr. Edwards (who was a witness for the defendant) said on page 41 of the Transcript:

"I think when the proper kind of cement and felt are used under the proper conditions, that it makes an ideal joint."

Mr. Edwards had been making these cases for four (4) or five (5) years, and thoroughly understood the business and the difference between the patented joint so to speak, and other methods of uniting the plates together of a show-case.

The importance of this case to the plaintiff must be our excuse for so lengthy a discussion of points which seem to be so plain to us, but which we failed to make plain to the Court below.

For the reasons herein given, we earnestly insist that the judgment be reversed.

All of which is respectfully submitted:

Scrivner & Montgomery, Attorneys for Appellant.



United States

Circuit Court of Appeals

For the Ninth Circuit MAY TERM, 1914.

DIAMOND PATENT COMPANY, a Corporation,

Plaintiff and Appellant,

vs.

S. E. CARR COMPANY, a Corporation,

Defendant and Appellee.

APPELLEE'S ANSWER BRIEF.

In this action the plaintiff alleges that the defendant has infringed its Patent No. 801,944, for an improvement in showcases, applied for October 3, 1904, and issued October 17, 1905, to Fred Weber and thereafter assigned to the plaintiff. It was stipulated that showcases in use by defendant were substantially like the patented cases and no controversy arises unil he defenses are reached.

The defendant contends that the patentee was not the original or first inventor of the thing patented and that the thing patented had been in public use and on sale in this country for more than two years prior to the application for the patent sued upon. These defenses are statutory and are commonly known as prior invention and prior use and are to be found in subdivisions 4 and 5 of U. S. R. S. 4920, as follows:

- 4. "That he was not the original and first inventor or discoverer of any material and substantial part of the thing patented; or,
- 5. "That it had been in public use or on sale in this country for more than two years before his application for a patent, or had been abandoned to the public."

Then, in addition, the question whether the improvement patented involved invention is raised.

The plaintiff's rebuttal is all directed to an attempt to distinguish between the improvement patented and the antcipating showcases, it being in effect conceded that the anticipating cases were made in the manner and at the times shown by the testimony.

Based upon the facts, the deefndant contends that it has proven beyond any doubt whatever that the patentee was not the original or first inventor of the thing patented and that show-cases made identically in accordance with the claims of the patent were sold and used in this country considerably more than two years prior to the patentee's application for patent. As a matter of law the defendant contends that the so-called reasonable doubt rule has no application

to this case; that a portion of each of the claims of the patent cover a function and that a function is not patentable; that the claims of a patent are strictly consrued and limit and restrict the rights of the patentee and the claims cannot be enlarged or construed to include anything not clearly within the language thereof; that the claims of the patent in suit include simply the joints of a showcase where glass is joined to glass and nothing else and do not cover any portion of the showcase where glass is joined to wood; that the proof of the use by a single individual of a single showcase made substantially in accordance with the claims of the patent and more than two years prior to the application therefor is under the law sufficient to invalidate the patent both on the ground of prior use and prior invention. With this statement of the case and our contentions we will proceed to a consideration of the case on its merits.

THE FACTS OF THE CASE

In the first place we are unable to find anything in the transcript warranting plaintiff's assertions in its brief as to the state of the art at the time of the application for the patent. No references are made to the record in support of its statements. This is characteristic of its brief. Without reference to the record, facts are stated and assumed that do not appear in the

record. Very many of the contentions of plaintiff are based on an assumption of facts which do not in fact exist. Under such circumstances it was wise for it not to attempt to support its statement of the facts by reference to the record. As the status of the art is of little if any consequence, so far as the defenses of prior use and prior invention are concerned, we will not give it further attention. It is sufficient to call attention to the fact that the record does not disclose the prior art. Whitcomb stated that he had made certain kinds of cases, but that is far short of proving the prior art.

It may be well to determine at once just what the patent covers. For this we can only look to its claims, which are as follows:

- 1. "A structure comprising a plurality of glass plates, the edges of which are spaced from the adjacent plates, a felt cushion filling the space between the adjoining plates, the plates being cemented to the felt, each plate being adapted to freely vibrate in its natural plane of vibration, and prevented by the felt cushion from imparting its vibration to the adjacent plates.
- 2. A structure comprising a plurality of glass plates, an unconfined edge of one plate nearly but not quite meeting another plate also with unconfined adjacent edge, an elastic material filling the space thus existing between the nearest adjacent surfaces of the plates, said plates being attached to the elastic material, whereby the plates by reason of their

unconfined edges and the intervening elastic material can each vibrate or move in any direction independently."

Later on it will be contended with authority in point that all of the first claim following the comma after the word felt and all of the second claim following the comma after the word material is invalid as being functional and not patentable. From this it appears that the patent merely covers a structure consisting of glass plates cemented together with felt or elastic material in the joints between the glass. It does not cover the combination of glass with wood or other material and is confined strictly to the joining of glass to glass. With this in mind in connection wth a showcase it is clear just what is covered by the patent. The front and end plates of glass of a showcase are joined to the wood frame at the base and the end and top plates are fastened to the wood at the rear as all the cases have wood back and base frame.

Having gotten the patented thing in mind, we can now look to the anticipating cases. At this point we want to call attention to the findings of he lower court incorporated in its opinion as set up on pages 58 to 63 of the record. Judge Rudkin found that the anticipating cases were made as follows:

"The base and back framework of the Whitcomb cases were made of wood, while

the ends, front and top were of plate glass. The two end plates were imbedded in the wooden base and in the wooden frame work at the rear. The front plate was likewise imbedded in the wooden base and cemented to the end plates with a strip of felt between the plates at the joint. The top plate was cemented to the front and end plates in the same manner and fastened to the wooden frame work at the rear by means of metal screws inserted through holes drilled in the glass at each rear corner of the eight foot cases with an additional screw in the center of the ten foot cases. A strip of felt was placed between the plate glass and the wood at the rear of the case.

The cases manufactured under the Weber patent are in all respects similar to the Whitcomb cases with the single exception that cement is substituted for metal screws for the purpose of fastening down the rear of the top plate. In other words, in the Weber case the top plate was cemented to the wooden frame work at the rear just as glass is cemented to glass in other parts of the case, while metal screws are used to hold the rear of the top plate of the Whitcomb case in place."

While that finding is not conclusive in this court it is entitled to much weight. The court in making that finding had before it a volume of evidence quite ten times what is before this court including many details which of necessity cannot be brought to the attention of this court. The court finds that in the anticipating showcases the front plate of glass was cemented to the end plates with a strip of felt in the joint between

the plates and that the top plate was cement to the end and front plates in the same manner the top plate being fastened to the wood frame at the rear by means of screws through holes in the glass, a strip of felt being inserted between the glass and wood at the rear. That that is the identical construction set forth in the claims of the patent cannot be successfully controverted. That the finding of the court on the question involved is the only reasonable deduction from the evidence will presently appear.

No question has been raised that these anticipating showcases referred to in the record as the Cooper or Joplin cases and the Federman cases were not made and put into use more than two years prior to the application for the patent, and further space will not be taken as to the time of making and putting into use of these anticipating cases save to say that the ten cases for the Cooper Drug Company at Joplin, Missouri, were installed during November, 1899 (pgs. 30, 31, 44 and 51), and the Federman cases were installed during April, 1900 (pgs. 32 and 43).

The first witness giving testimony concerning the construction of these anticipating cases was W. G. Whitcomb, of Kansas City, Missouri. He testified that he had practical experience as a mechanic in making showcases for thirty years; that he had been operating as the Whitcomb Cabinet Company for more than ten years (p. 30) (page references, unless otherwise noted, will refer to the Transcript of Record), as a manufacturer of showcases; that among others he made showcases "with felt joints cemented" (30); that he put in ten of these cases for the Copper Drug Co., at Joplin, Missouri, and made some for Federman about the same time; that these cases are all in existence now (31); that the Joplin cases had "felt joints" used with cement (32); that these felt and cement cases were "constructed by putting the cement along the edge of the glass and then lay the felt on and then put cement on top of the felt and put the glass on" (page 42); that he made one of these cases for H. J. Ernest in 1899, which was made "with felt stuck to the edge of the end glass and then put cement on the felt, and simply put up the front glass and the same thing with the top"; that "the front, top and end joints were put together with felt and cement clear along the edges" (page 43); "that he made five of these cases for Mr. Federman, constructed with felt and cement the same as the Ernest case, these cases were delivered to Mr. Federman in April, 1900, and he has them yet" (page 43); "that in some of these elastic cases made with the cement and felt construction he bored holes through the top glass at the back top corners and put a screw through the holes and into the back wood frame, some of them were made without these screws, the two end joints and

front joints and the front corners where the glass is put together did not have any holes and were held together by the cement; that he began experimenting with these felt joint cases in 1896 or 1897; that he made several of these cases before selling any, and first tried using glue for the adhesive to adhere the felt to the glass and found out glue would not do as it broke and chipped the glass, then he tried shellac and found that would not work and finally he used a substance made up of ingredients that he would get at a drug store (pg. 43); * * * * that the Federman cases were made by sticking the felt to the glass and then put cement on the other side of the felt and lay the glass on; * * * * that these Joplin cases were constructed with felt in the joints between the glass with an adhesive substance on either side of the felt adhering it to the glass; that the cement used in these cases was a preparation he got up himself (pg. 44); * that he remembers the construction of the ten cases delivered to the Cooper Drug Company, at Joplin, Missouri, very well, as he went down and set them up and worked on them at night; that the joints were made with felt and cement, cement on the edge of the glass and then felt and then cement and the glass laid on" (pg. 45).

Even with the testimony of this single witness there is no room for doubt as to the construction of the anticipating cases made and put into use in 1899 and 1900 and still in use, but that is only a portion of the record.

Wliliam M. Federman, another absolutely disinterested witness, who got the so-called Federman cases from Mr. Whitcomb in April, 1900, gave instructive testimony on the question of the construction of his cases. On pages 45 and 46 he testified as follows:

"That in April, 1900, Whitcomb installed five showcases in his store at 904 Main St., Kansas City, Missouri, said cases having been used by him ever since in the same location; that said cases were made with felt between the glass and fastened together with some adhesive substance; * * * that the strips of green felt are still there on the edges of the glass and can be seen readily; * * * that said cases have been in continuous use since installed in 1900; * * * that whatever elasticity followed from the use of felt in the joints between the glass existed in his cases; that his cases were made by putting a strip of felt having an adhesive substance on either side of it in the joints between the glass and the different plates of glass thus held together and that any elasticity resulting from that method of construction existed in his cases."

Henry W. Jackson, the licensee of plaintiff in Kansas City, Missouri, and thereby interested in the result of this case, testified on pages 47 and 48, in corroboration of Whitcomb by saying "that he knew without being told that Mr. Whitcomb

had been making these all glass showcases, as he had seen such cases made by Whitcomb running back a dozen or thirteen years ago, and knew two or three places where Whitcomb had put in the cement felt, all-glass showcases."

William E. Price of Joplin, Missouri, who was one of two partners in the Cooper Drug Company at the time said company purchased the ten anticipating cases from Whitcomb in 1899 and continued such partner and to use said cases until just prior to giving his testimony in January, 1913, testified on behalf of the plaintiff on pages 51 and 52, as follows:

"That said cases were shipped to Joplin, knocked down and were set up in the store by Mr. Whitcomb himself; the back frame was separate from the base; that they screwed the back frame onto the base and then set the end plates of glass in grooves in the base and back frame, then put glue on the edge of these end plates of glass and then put on a strip of felt over the glue and then put glue on the felt and then put on the front plate of glass and then did the same with the top plate of glass; that all these cases are still in use in the store where they were installed and have been in continuous use ever since installation; that this glue, felt and glue construction in these cases ran along the top end joints, down the front end joints and the top front joint."

William C. H. Wilson, a witness in rebuttal on behalf of the plaintiff, testified that he examined these Federman cases in June, 1909, and that they were constructed with "some adhesive substance on either side of the felt" (page 53).

A. C. Larue Shaffer, who is substantially interested in the plaintiff company and in the result of this action, testified on behalf of plaintiff concerning these Cooper and Federman cases, saying "that he was present and heard Mr. Whitcomb testify in this case that he examined the Federman cases" and "whether felt was used in all the joints he does not know; that after Mr. Whitcomb's testimony he examined the Cooper Drug Company cases at Joplin, Missouri; that he found the Cooper cases were made at the joints with glue and felt; that in some of the Federman cases they had inserted a sort of bolt with a rubber washer on it down into the back frame; that the balance of the cases from the bottom to the front of the top corners and across the front on top and across the top of the ends, he thinks, was constructed with felt and glue that the cement which they use in constructing the patented showcases and which the licensees are required to purchase from plaintiff is simply a composition of ingredients that they know about and which they have made up for them; that he does not claim any patent on the cement; that the patent covers uniting two plates of glass, with some adhesive substance and a cushion between" (pages 54 and 55).

Here we have the testimony as to the construction of these anticipating cases of Mr. Whitcomb, who made the cases and who went into detail as to his experimentation leading up to their construction, and testified minutely and repeatedly as to the construction and how it can be sincerely contended even from his testimony that these anticipating cases were not made in identical accordance with the claims of the patent is difficult to understand. But in addition Mr. Federman gives clear testimony as to the construction of the cases which Whitcomb made for him in April, 1900, and which he has used all these years. Then comes the plaintiff with five witnesses in rebuttal in a desperate attempt to distinguish between the patent and the anticipating cases and in its efforts to distinguish it signally fails and makes assurance doubly sure that the cases are identical so far as the patent covers a showcase.

If the plaintiff had omitted its so-called rebuttal testimony there might have been some slight excuse for its contending that the anticipating cases vary from the patent, but with this array of rebuttal testimony all possible excuse for its position completely vanishes. So far as that portion of the case where glass is joined with glass is concerned, and that is all the patent covers, the construction of the anticipating cases is exactly what the patent embraces. In brief, the joints were formed by inserting a strip of felt, the sides

of which were cemented to the glass. That applies with equal force to either the patent or the anticipating cases. The conviction is overwhelming and there can be no escape. The fact stands out as positive as a searchlight in the darkness. To deny it is a futile waste of energy.

The first claim of the patent so far as it covers actual physical means, and that is all a patent can cover, reads:

"A structure comprising a plurality of glass plates, the edges of which are spaced from the adjacent plates, a felt cushion filling the space between the adjoining plates, the plates being cemented to the felt."

It appears that there are four elements in this construction, first, a plurality of glass plates; second, the edges of the plates are spaced from the adjacent plates; third, a felt cushion is inserted in the space between the adjoining plates and, fourth, the plates are cemented to the felt. We respectfully inquire wherein, in the slightest particular, the anticipating construction varies from this claim in any of its elements. That the anticipating cases embrace every detail of this claim cannot be gainsaid. If the witnesses had described the construction of the anticipating cases in the exact language of the claims it could not be clearer. As to the second claim we encounter exactly the same situation. When you analyze it you have the identical thing you find in the first claim. The only difference is in phraseology. Where the first claim employs "felt" the second claim employs "elastic material," but as felt is an elastic material it follows necessarily and unavoidably that an anticipation of the first claim is equally an anticipation of the second claim. In the first claim we are told that the plates are "cemented" to the felt while in the second they are "attached." As cementing is attaching it again follows that an anticipation of the first claim must be an anticipation of the second. At this point we have only considered that portion of the claims which cover the actual physical means, omitting the resulting function that is appended to each claim. We will take up the functional portions of the claims later and show how they are invalid.

The plaintiff goes on at great length at various points in its brief telling the court what the patented structure consists of and how it is constructed. To determine what the patent covers resort, can be had to only one thing, and that is the claims of the patent. That is one point of law that is so absolutely fixed that there can be no question about it. The law gave the patentee an opportunity to put into words just what he claimed and imposed upon him the duty of doing so. He cannot now be heard to say that his claims mean anything different or in addition to their clear import. If it were otherwise the scope of

a patent would rise and fall with the needs of its holder. It would fluctuate in accord with the holders' interests, and be one thing today and something much different tomorrow. When he wanted to avoid anticipation his patent would be very narrow and when he wanted to enjoin infringement the patent would become very comprehensive. We desire to emphasize that what the plaintiff says its structure as patented is is wholly irrelevant. What it now says cannot be permitted to, in the least, change the situation. It must content itself with a reference to the claims of the patent. Anything else is a waste of printers' ink.

After telling the court what it now claims its patent is, it proceeds to take up the anticipating cases and at once lapses into inaccuracies.

In the third line of the division styled "Federman Cases," on page 12 of its brief, it says there was no felt on the back rail of the Federman cases. The testimony shows positively that there was and plaintiff's own witnesses so testify. For instance, on pages 53 and 54, plaintiff's witness, A. C. Shaffer, who has a substantial interest in plaintiff company, and is one of its officers, stated that he had examined the Federman cases and that "there was felt on the back rail of these Federman cases." Following this, plaintiff says the component parts of the adhesive substance are

unknown. That is equally true of the patented showcases. Plaintiff's witnesses state that their socalled cement is a formula that they have which is made up for them as they require it. However, that is wholly immaterial, as the patent does not cover cement by any stretch of imagination. it did the formula would have to be disclosed, otherwise there never could be an infringement of the patent. Further than that, the patent does not require the use of cement or any particular adhesive substance. Then under the well-established rule that "that which infringes if later, anticipates if earlier," it follows that cementing the plates to the felt with any form of adhesive anticipates the claim. The plaintiff's contentions proceed on the theory that cement must be used and further than that, their particular brand of cement, in order to anticipate. This is clearly erroneous, as the claim does not use a noun or name the material with which the cementing must be done. The same observations are true as to the second claim. It requires that the plates be "attached to the elastic material" without in anywise specifying the means or material by which they shall be attached. Again he wanted to catch every possible infringer and by attempting to catch too much ahead he has actually caught too much behind. It seems to us that this should for all time dispose of plaintiff's attempted distinction between the patent and the anticipation arising out of the form of adhesive substance used. In one claim the plates must be "cemented" and in the other "attached" to the felt, but by no manner of reasoning can it be successfully contended that the cementing or the attaching must be done with any particular material. The contention cannot endure even a careful reading of the claims.

Then on the same page plaintiff says Whitcomb testified the substance he used was "not cement." Unless the writer has overlooked something the plaintiff is again consistent by being wrong. What Whitcomb did sav is that he did not use "ordinary cement." There is a great variety of cements and at best the term is a relative one. From plaintiff's viewpoint there is only one cement and they have it and won't tell anyone what it is. It, in some mysterious manner, has acquired a monopoly of the term cement, and what it pleases them to call cement is by reason of their pleasure actually cement while the calling of some material cement by some other party makes that material not cement. Whitcomb started in calling his adhesive cement some five years before the patentee employed that name for his adhesive, but, of couse, when the patentee adopted the term cement he got the right-of-way and Whitcomb's rights immediately ceased. No doubt the cessation should be retroactive.

Again, on page 12 of its brief, plaintiff says the difference between the Federman cases and the

Joplin cases is that the latter cases had a strip of felt along the back rail. If this is the only difference then there is no difference, as in this respect, the cases are alike, as counsel will ascertain if they will only read the testimony. Then they say that the evidence is overwhelming that this construction made a tight right joint. Counsel for plaintiff must be very easily overwhelmed. We know they were in the trial below. Now, the evidence is not overwhelming that the anticipating cases had rigid joints. It does not even preponderate in plaintiff's favor. It should be kept in mind that of plaintiff's seven witnesses six of them are in somewise connected with the patent. Of these seven witnesses plaintiff succeeded in getting some of them to make indefinite expressions of opinion that the anticipating cases had solid joints, including the patentee, who never saw the Whitcomb cases. The patentee said "He had seen showcases where the top plates were bolted onto the woodwork, making a solid joint." This statement has no reference to the anticipating cases but to some cases he had seen. He never saw the anticipating cases. At best the solid joint, part of it, is a mere conclusion. Then the witness Price said the back part of the case "had bolts or screws fastened down tight." That is much short of solid and rigid. Plaintiff would have the court believe that there is absolutely no elasticity in the joints of the Cooper and Federman cases and that the four plates of glass in each case became as one piece, the joints being just as solid and rigid as the glass itself, so that the vibration of a blow on one plate would have ts entire force and energy communicated to the other plates; that in effect there is only one piece of glass in the Cooper and Federman cases. Let us see about this: Their Witness Holm said he repaired some of Whitcomb cases, not either the Cooper or Federman cases, but some others, and that they had a hard solid joint. Then he immediately (page 47) proceeds to give himself the lie by saving that in repairing these cases he did not need to disturb the end plates of glass. In other words, he took the glass plates apart at the joints which positively refutes the idea that the joints were absolutely rigid and solid, as plaintiff contends. This is some of the evidence that overwhelmed plaintiff. Such a witness would overwhelm most anyone. Mr. should know something about this Whitcomb matter, and we will see what he says. On page 44 he states:

"He used felt in the joints of these all-glass cemented cases, for the vibration of the cases, that he made some without the felt, simply stuck one plate of glass on the other plate and found it was so solid any little jar would break it, then he thought of the felt to give the elastic movement and make an elastic joint; that the joints in the Federman cases and all those are not hard and fixed, they appear to be solid, but there must be some give to them or they would break; that his trouble with the first ones he made was that the joints were

solid and he could not handle them, they would break without anyone touching them, but later I got so I shipped them all set up, that the Fort Scott cases were set up in his factory and shipped down there all complete; that his idea was to get an elastic joint, something that would give a little, and he succeeded."

Further, on page 45, he said:

"That one of the objects in using felt in the joints between the glass was to give flexibility and elasticity to the joints and obtain sort of a rubber or cushion effect between the plates of glass."

This testimony from an absolutely disinterested witness is not only plausible but convincing. Plaintiff would have us believe that Mr. Whitcomb is a knave and a fool and does not know what he is talking about. We submit that he knows altogether too well what he is talking about for the welfare of this action. Right here let us note that a change in degree only does not permit a patent to stand. Even conceding, which we do not do, that the patent employs more elasticity than Whitcomb, the patent would then be invalid as patentees invention would only be a change in degree and only expanding an idea that was old. Facts always have more evidentiary force than opinions, so let us look to the facts as to these Federman and Cooper cases.

Mr. Federman is a druggist in Kansas City, Missouri, and on page 46 he testifies concerning his cases, giving facts that point out clearly the truth of this rigid joint question. He says:

"That the strips of green felt are still there on the edges of the glass and can be seen readily; that the top plate has been broken on a couple of the cases and the fragments removed and new tops put on. * * * That whatever elasticity followed from the use of felt in the joints between the glass existed in his cases; that said cases were made by putting a strip of felt having an adhesive substance on either side of it in the joints between the glass and the different plates of glass, thus held together, and that any elasticity resulting from that method of construction existed in said cases."

Counsel for plaintiff procured this witness to say that the joints were tight and solid, but when the matter was further called to his attention he gave the above testimony and said further:

"That in saying that the joints were solid he meant that they were not loose and open, but were firm with the felt intervening, with no opening to allow dust to enter, or anything of that kind."

Mr. Federman is in no wise connected with this patent or controversy, and is absolutely without interest and his testimony should receive weight, especially as opposed to plaintiff's witnesses on the point, all of whom are interested in the outcome of this litigation. Some of plaintiff's witnesses are very materially interested.

Now, William E. Price, one of the plaintiff's witnesses, used the Joplin cases from their installation in 1899 until late in 1912, and he should be able to throw some light on the point. He says on page 52, in speaking of the ten Joplin cases:

"That the top plates of glass have been broken on eight of these cases and new tops put on; that two of the cases are still just as they were first set up and have not been changed or repaired, * * * that he has broken the top plates of these cases a good many times without breaking the other plates of glass, just the top plates would break and the other plates not break at all * * * that when the top plates of glass would get broken he would take a thin knife blade right under the glass * * run the blade right along there through the felt and pull it off, it is not a very difficult process and some plates would skin right off."

How can the plaintiff escape these demonstrating facts from its own witness, and its only witness that is not in some manner interested? He says that he broke the top plates a "good many times" without breaking the other plates. If these joints were rigid and would not "permit any elasticity or resilency," as plaintiff contends, how, we inquire, could he have a good many times broken the top plates without at all breaking the other plates of the case, which were adhered to the top plates so that they in effect became one piece? There is only one answer, the felt in the joint absorbed the shock which broke the top plate

and the shock was not communicated to the other plates. Then, in addition, the witness says he would, upon the top plates being broken, take a thin knife blade and run it right along through the felt in the joint and remove the plate, and that it was not a difficult process. Again, we inquire, could he have run his knife blade through the felt if the cement had permeated the felt and the joint had been solid and rigid, as plaintiff contends? With this uncontradicted evidence put in by plaintiff's witness, the fallacy and fultility of plaintiff's contention becomes at once apparent. There is only one conclusion open, that is, that the joints in these Cooper cases were yielding and elastic as Whitcomb who made them said they were. Otherwise the plates could not have broken individually and the broken plates removed in the manner stated by plaintiff's witness. The idea of running a knife blade through a joint solid and non-elastic, such as plaintiff would like to have the court believe these joints were, is foolish. This is an instance where "Actions speak louder than words."

This should be abundant to entirely dispose of plaintiff's contention that the joints in the Federman and Cooper cases are rigid and without flexibility or elasticity. The facts are so clearly against the centention that plaintiff would not be urging the point if it had something better to offer.

Following its contention that the joints of the

anticpating cases are rigid and non-elastic the plaintiff on page 13 of its brief attempts to point out differences between the patent and the anticipating cases. It says Whitcomb did not use cement, but did use a semi-liquid compound, the ingredients of which are unknown; that it dried out in a short time and necessarily left a rigid joint. The all-sufficient answer to most of this is that there is no evidence to support it. It is not necessary that cement be used, as the claims of the patent do not call for it and whether the adhesive used is semi-liquid, or otherwise, is wholly immaterial. That the composition of the adhesive must, under the patent, be known, is idle. If the patentee had desired to use any particular cement or adhesive he should have so stated in his claim, and given the public the information so that it could know what belonged to it and what belonged to the patentee. Not having done so, he has only himself to blame. He simply said that the glass plates should be "cemented" or "attached" to the felt so that any material we choose may be used to do this cementing with. It may be too bad that the patentee did not make his claims otherwise, but it is too late now that controversy has arisen to permit him to adjust his claims to meet the varying needs and changing conditions as they arise. No doubt he would like to make his claims very broad when he is endeavoring to include infringers and very narrow when he encounters anticipation, but the law in its wisdom required him to make his claim once and for all time when he applied for his patent and to stand or fall by what he then voluntarily claimed. However, all this quibbling about the term cement is all beside the issue. Whitcomb had just as good right to call his mixture cement as the patent holder has to call its mixture cement. There is no particular virtue or magic about the word cement. Call either mixture any other name and it would still be the same thing and fulfill the same functions. For aught that appears in this record the two mixtures may be identical. There is nothing in the record that gives us any information concerning either mixture and probably for the reason that no one deemed it at all material. It is absolutely certain that it would not have to be proven that a claimed infringer used identically the same mixture as these patent owners use in order to make out a case of infringement. doubt the showcases which defendant stipulated are an infringement of the patent, if it is valid, are made with a cement that is different from the plaintiff's cement. We could have raised that question and quibbled about it as plaintiff is doing, but fortunately we had somehing worth relying upon. However, the patentee is not confined to any particular cement and can change as many times as he chooses. It should be kept in mind that if the Cooper and Federman cases were made today and would constitute an infringement of the patent, then their having been made and used more than two years prior to the application for the patent constitutes a clear case of anticipation.

Then plaintiff is endeavoring to impose another claimed difference on the court consisting of the fact, as it claims, that in the anticipating cases the top plate was bolted or screwed down to the top railing of the wooden frame, so that there could not possibly be any elasticity in that joint and the top plate so held by the screws is in an "absolutely rigid position." While the Cooper and Federman cases had screws through the glass at the top rear corners, down into the wooden frame the conclusion as to rigidity added by plaintiff does not follow. The glass was not screwed down to the wood, but rather lav upon felt and plaintiff's substantially interested witness on page 54 said that this screw had "a rubber washer on it." The witness Price, on page 51, said these screws were put in with a screwdriver "and they had big washers around the head; that he was not sure about the underside of the washers being lined with felt." So it appears that the construction at the back top joint was not absolutely rigid, as plaintiff would have us There was felt on one side and either felt or rubber on the other side of the glass. The glass was in position between two cushions and, argue as they may, plaintiff's counsel cannot

change the facts and make it rigid. It would best suit the plaintiff to have these anticipating cases nailed up like a boxcar, but unfortunately for it, the facts are not as it would like. However, the back top joints where the top plate of glass is fastened on to the wood back frame is not within the claims of the patent, as the patent only covers the joining of glass to glass and is entirely silent as to joining glass with any other material. The plaintiff does not seem to urge this back top joint as a distinguishing feature very strongly in this court, while in the court below that was its main contention. The law, when we get to it, to the effect that the patent is confined strictly to the claims of he patent and that the patent holder canno depart one iota therefrom will effectively dispose of this back top joint contention so far as it is urged in this court. The law is emphatic to the point that even the specifications and illustrations of the patent cannot be referred to for the purpose of expanding or adding to the claims of the patent.

Then plaintiff says the anticipating cases were so made that the plates could not vibrate at all and in the same sentence says the plates were not prevented from imparting their vibrations to the adjacent plates. These conclusions are not by any manner of means supported by the evidence, and the subject has been covered by what we have already said. We want to make the further obser-

vation that we cannot understand how a plate of glass so situated that it "cannot vibrate at all" can have any vibration to "impart" to its adjacent plates. The bulk of the plaintiff's presumed statements of fact is merely the conclusions of its counsel, and most of them are wholly unwarranted. The apparently big point that it is so industriously endeavoring to maintain is that the joints in the anticipating cases are right. That this is not the fact is so clear from the evidence that we do not feel that it requires more extended discussion.

On page 15 of its brief, plaintiff says its contention is that the anticipating structures had rigid joints between the plates, the plates not being prevented from imparting their vibrations to the other plates, and says that if the Joplin and Federman cases were made with elastic joints so the plates could vibrate and not impart the vibrations to the other plates, they would be substantially similar to the patent. We say the Joplin and Federman cases did have elastic joints and that they could vibrate, and without imparting their vibration to the other plates, and we feel absolutely sure that the evidence fully sustains us beyond the question of a doubt. There is attempt in the record to avoid the positive proof, but it did not and could not get beyond a mere attempt. The plaintiff not being satisfied with the defense made out, put on five witnesses in rebuttal, and they clinched the matter for good and

all. They added fact upon fact and corroboration upon corroboration until the anticipation became so conclusive that try as it may there is no possible escape for plaintiff. We had no disposition to brng about the untimely demise of plaintiff's patent, but they forced the issue upon us and said we had no right and were invading their right. The futile contentions of plaintiff and the straws it is grasping for show the inherent weakness of its case. If we were endeavoring to anticipate by something long out of existence and had only memories to rely upon it would be a different situation. Here the cases are in existence and actually have been seen by practically all the witnesses. There is no disputing the existence of the cases and that they were made and put into use more than two years before the application for the patent. Likewise it cannot be seriously or successfully disputed that these anticipating cases are made in accordance with the claims of the patent. That the invention of the patent, if it has any, was practiced and used years before the patent is a fact that cannot be contradicted. Plaintiff's witness Price makes out a clear and positive case of prior use. His credibility is vouched for by plaintiff and what he says must be accepted. In the face of the volume of testimony as to prior use and prior invention that this record discloses it matters little what the applicable rule of evidence may be. The patent

involves a very simple structure. We are not dealing with some intricate complex mechanism that only the skilled and scientific can comprehend. One of the witnesses actually construced the cases, two of the witnesses have actually used the cases continuously for some twelve years, and other witnesses testifying on behalf of the plaintiff have actually seen the cases and examined the manner of their construction. The sum total of the evidence is so clear and positive that it is irresistible. That the cases are made in substantial accord with the claims of the patent is shown by the fact that plaintiff's witnesses, eager as they were, wholly failed to point out a distinction worthy of the name. When it was put right up to the witnesses to specify the differences the most they could do was to claim that a different form of adhesive was used; that they claimed the adhesive used by Whitcomb in the Cooper and Federman cases permeated the felt and that there was screws through the top plate of glass down into the back wood frame. This back top joint where the top plate of glass joins the back wood frame is clearly without the patent, so that any attempted distinction based upon this joint must fail. The adhesive used in the Cooper and Federman cases did not permeate the felt, as is demonstrated by the evidence. Whether the same adhesive was used is not known for the good and simple reason that no one knows what the plaintiff claims should be used. They are keeping the

thing secret, but have the audacity to claim that we have not shown anticipation because we did not use their secret formula. If such a procedure could obtain, there never could be an anticipation, as the patentee could keep a portion of his patent secret and thereby avoid the proof of anticipation. The fact is there is no patent on the adhesive substance and so far as the patent is concerned the world is open to use any adhesive it chooses.

In its so-called argument the plaintiff quotes from some of the witnesses in an unsuccessful attempt to show that the joints in the Cooper and Federman cases are rigid. We have already considered the testimony of these witnesses on the point, except H. W. Jackson, and he can be disposed of by saying that the cases he refers to are not the Cooper and Federman cases, and that the cases he talks about having repaired are the same cases the witness Holm said he took apart at the joints and repaired, showing conclusively that the joints were not rigid and solid and the plates adherred together as one piece even in these cases. Holm is an employe of Jackson's company, and was the party who actually repaired the cases referred to by Jackson.

Then it is said Whitcomb had no comprehension of an all glass case with elastic joints, and that he never tried to make one, did not know that it could be made, and did not appreciate the value of them when they were made. The utter fallacy of this claim by plaintiff is shown by Whitcomb's testimony, on pages 44 and 45, where he tells of his experimenting and finding that constructing cases by adherng one glass to the other resulted in their breaking from even a slight jar, and that "they would break without anyone touching them." Further on he says "that his idea was to get an elastic joint, something that would give a little, and he succeeded." Counsel attempts to ridicule the witnesses in that he used the felt "for the vibration of the case," apparently contending that vibration of the plates is the desired thing. On page 45 the witness says:

"The objects of using felt in the joints between the glass was to give flexibility and elasticity to the *joints* and obtain sort of a rubber or cushion effect between the plates of glass."

That should be definite enough, even to satisfy plaintiff.

The witness James P. Shaffer said, on page 50, that he tried to sell Whitcomb a license to make the patented cases and that Whitcomb objected to their construction, as it had "too much elasticity in the joints" and that Whitcomb seemed to "concede that you wanted some elasticity, but that we had too much, he thought we were overdoing the elasticity feature." From this evidence it is idle to contend that Whitcomb did not fully

comprehend and appreciate the elastic joint proposition. We do not claim he was as fanatical about it as the plaintiff.

Plaintiff says the testimony clearly shows that the plantiff's case has gone quite extensively into public use and wherever it had become known and understood it has superseded all other cases and that the business is constantly increasing. We say the testimony shows nothing of the kind. The plaintiff's secretary said that the licensees are putting out about 500 lineal feet a month (page 38). That would be fifty ten-foot cases per month, or six hundred cases per year. If that is the popularity they refer to, all well and good, but we object to the extravagant language that is wholly unsupported. In closing its argument plaintiff says the plaintiff's case is made by the use of felt and cement in the joints. We deny that they are necessarily made with cement or with any particular form of adhesive mixture and further deny that plaintiff has any superior rights in the term cement. If only that is cement which it pleases plaintiff to call cement, then we will awake some morning to find that there is no such thing as cement, as plaintiff's pleasure is to that effect. Who ordained plaintiff to sit in judgment as to what is or is not cement? If it is going to be the judge we petition for the recall.

We believe we have shown beyond all possibility

of a doubt that showcases made in substantial, if not in identical, accordance with the claims of the patent, were made and used in this country more than two years prior to the application of the patent sued upon, and have disposed of plaintiff's contention to the contrary. If so, it follows as a matter of plain statute, that the patent is invalid, just as the lower court decreed.

PRIOR INVENTION.

We also contend that the patent is invalid by reason of prior invention. The testimony as to pror use covers this point except to show when the patentee first practiced the invention. own statement is that he began experimenting on an all glass cemented showcase somewhere about 1904, and that he did not go into the showcase business until 1901 or 1902 (page 35). Again, on page 49, he says he went into the showcase business in March, 1902, and "began experimenting with the patented showcase along in 1904," From this it appears that for him to be "the original and first inventor or discoverer" (U. S. R. S. 4920) of the thing patented it must not have been made by anyone else prior to 1904. That Whitcomb made the invention and practiced it as early as 1899 cannot be successfully disputed. we have a clear defense of prior invention. the time the patentee made the discovery the idea of his patent and the right to vend and use the

same was public property which he had no right to monopolize. Some five years previously Whitcomb had invented the same thing, and as he did not procure a patent securing to himself any right of invention, it became the right of all. For any particular person to now claim the exclusive right to the invention is an attempt to appropriate public property to their own use. A patent is granted as a reward for inventing something new and novel, and useful. Weber did not invent anything new or novel and is not therefore entitled to the reward of a monopoly. In Corrington vs. Westinghouse Air Brake Company, 178 Fed., 711 (1910), in discussing the prior use testimony, the court said:

"Undoubtedly such use would defeat the patent, but so would proof that the patented combination was made by someone other than the patentee, two days or two hours before it was made by him, * * * such person must have invented the machine * * * which he seeks to have patented, and if it was shown that the machine was known and used by others in this country before his discovery, it is manifest that he is not the inventor within the meaning of the patent law."

Again we want to call attention that the claims of the patent are confined to the joints where glass is joined to glass and do not cover the joints where the top plate of glass is joined to the back wood frame of the case. We respectfully submit that

the record shows a clear case of prior use as well as a clear case of prior invention.

THE LAW OF THE CASE.

Plaintiff takes up the law of the case by an abstract statement of what it would like the evidence to be. It starts out upon the theory that these anticipating cases have rigid joints, when as a matter of fact, as has been shown, they have elastic joints. We take no issue with much of the law plaintiff has so industriously presented, save to say that it has no application to the facts of this case. They insist that these plates of the Federman and Cooper cases cannot "vibrate at all," but that they "necessarily impart the respective vibrations" to the adjacent plates. This shows the inconsistency of plaintiff. The urgencies of their case are leading them round in a circle.

They persist in their reference to the screws in the top rear corners as making a rigid case. We reiterate that that portion of the case is entrely without the claims of the patent and further, that the screws do not and did not make a rigid joint. In fact, it would seem that more elasticity would be secured by letting the glass lie on felt than by adhering it to felt, as in the latter method some of the felt must be engaged by the adhesive, and to that extent the elasticity is reduced. It follows as a matter of common sense that you could not make a rigid joint with screws as was done in the

Federman and Cooper cases. The elasticity is in the felt and it matters not how you hold the glass in place against the felt. So long as the felt remains the elasticity follows necessarily. Whether the glass is adherred to the felt or held in place by pressure from the opposite side can make no possible difference. All we have to the effect that these screws make a rigid joint is the opinion of some of plaintiff's witnesses, and of course their opinions were in harmony with their interests in the case. Glass is a very fragile and brittle substance and will break from a light blow, even though suspended in space in contact with nothing. Elasticity seems to be the big thing plaintiff is contending about, and it is present in the Federman and Cooper cases.

To show the inconsistency of plaintiff, it may be observed that the patentee testifies that they construct the patent cases with the rear and bottom edge of the end plates and the bottom edge of the front plate set in putty in the frame of the case, which makes a far more rigid proposition than plaintiff is complaining about in the anticipating cases. The patentee surprisingly went so far as to admit that they get a pretty firm rigid joint on two edges of the end plates and on one edge of the front plate by the use of putty. Then he continues on page 49 by saying "that the elastic joint feature applies simply to the all-glass construction." He seems

to know what his patent actually covers betterthan plaintiff's counsel.

If this evidence by the patentee is correct, why do we hear so much about the rear top joint where wood and glass is joined.

Plaintiff makes much of the so-called rule that like means produce like results. It seems to feel that at last it has found the rule that has no exception. Be that as it may, we have no fault to find with the rule, as we contend that the anticipating cases have the idential results of the patent. The results are identical and the means are, to speak mildly, substantially the same. All the law developed by plaintiff along this line has no application to the case. As a matter of fact, the real question in the case is one of fact. If the court finds, as did the District Court, that the Federman and Cooper cases were made in substantial accordance with the claims of the patent, then the case falls by the very clear wording of the statute. We will not take the time to discuss the cases cited by plaintiff to the effect that novel ends and so on proves novel means. We contend that patent employs no novel means and accomplishes no novel results, as the idea was old and in use several years before the patent. If we are right plaintiff's citations do not hit the case. It is aiming at a theory not based on the facts of the case.

Then plaintiff to some extent elaborates on the

point that inventive skill in indicated when the new article satisfies a long felt want, and so forth. That the immediate adoption and universal use of a patent device is some evidence that inventive skill is involved is conceded, but it is not by any means conclusve. As was said in *Butler vs. Bain-bridge*, 29 Fed. 142, cited by plaintiff:

"Each case must depend upon its own facts and circumstances. The perplexities which surround such controversies cannot always be solved by an examination of adjudged cases. They serve to illustrate the paths to be traversed, but he who desires to select the right one must depend largely upon his own judgment."

As the court well says, we get right back to the facts of each case.

Then in Ansonia Brass & Copper Co. vs. Electric Supply Co., 144 U. S. 11; 36 L. Ed. 327, cited by plaintiff, the court holds: That a more thorough doing of that which had already been done by another involved no novelty; that the application of an old process to a new and analogous purpose does not involve invention, even if the new result had not before been contemplated; that a mere carrying forward or more extended application of the original thought, a change only in form, proportons, or degree, the substitution of equivalents, doing substantially the

same thing in the same way by substantially the same means with better results, is not such invention as will sustain a patent.

In Lovell Mfg. Co. vs. Cary, 147 U. S. 623, cited by plaintiff, the court says:

"That the extent to which a patented device has gone into use is an unsafe criterion, even of its actual utlity; and while in a doubtful case, the fact that a patented article has gone into general use is evidence of its utility, it is not conclusive of that, much less of its patentable novelty. In this connection see McClain vs.Ortmayer, 141 U. S. 419 to the effect that advertising and large commissions often market a thing without merit."

Then counsel cited Cantrel vs. Wallick, 117 U. S. 689 (29 L. Ed. 1017) to the effect that a patent is valid though not new in all its elements. In this case the court in quoting from Machine Co. vs. Murphy, 97 U. S. 120 (24 L. Ed. 925), said:

"In determining the question of infrongemen, the court or jury are not to judge about similarities or differences by the names of things; but are to look at the machines or these several devices or elements in the light of what they do or what office or function they perform; and to find that one thing is substantially the same as another if it performs substantially the same function in substantially the same way to obtain the same result, always bearing in mind that devices in a patented machine are different in the sense of the patent law when they perform different func-

tions or in a different way, or produce substantially a different result."

Then, Anderson vs. Collins, cited by plaintiff, holds that the use of a different, but mechanically equivalent, method or material to construct some of the elements of a patented combination will not avoid infringement where the principle or mode of operation is adopted, and the elements, when completed, perform the functions by the same means as those described in the patent.

In Stevenson vs. McFassell, 90 Fed. 707, cited by plaintiff,, the court said on the question of patentablity:

"In a doubtful case, the fact that the patent device has gone into general use, and superseded other devices, may be sufficient to turn the scale."

In Buchanan vs. Perkins, Elec. Switch Mfg. Co., 135 Fed. 90, the court said:

"Whether in a given case, there has been an exercise of the inventive faculty within the meaning of the patent laws, is always a delicate and sometimes difficult question addressed to the sound judgment of the court having to pass thereon. It is difficult, perhaps impossible, to prescribe general rules for the exercise of this judicial function. It demands careful consideration of the prior art and the essential and distinguishing feature of the device or combination, as to which invention is alleged, and appreciation of the practical

working of the mental faculties. But it must often happen and is unavoidable, that what is evdence of inventive genius to one mind, may only suggest the exercise of mechanical skill to another equally sincere and intelligent."

This case strongly supports our contention that whether a patent involves invention is essentially a question of fact and each case must stand upon its circumstances. Some of the quotations by plaintiff in its brief show clearly that we are right. General usage; that others had striven for the same end and all those analogous elements are some evidence, in doubtful cases, that inventive faculty has been exercised, but after all is said and done each case must "paddle its own canoe."

Then the question that stands out prominently in the case is not lack of invention, but the question of prior invention and anticipation. It seems to us that the view the court must take as to prior invention and anticipation will make it unnecessary to go into the matter of patentability. Plaintiff's labored effort on the question of patentability may be to divert attenton from matters which it regards as more serious.

As illustrating the inapplicability of some of the cases cited by plaintiff, reference may be made to the case of Topliff vs. Topliff, quoted on page 43 of its brief, as follows:

"It is not sufficient to constitute an anticipation that the device relied upon might, by

modification, be made to accomplish the function performed by the patent in question, if it were not designed by its maker, nor adopted nor actually used, for the performance of such function."

Such law in nowise affects this case. The anticipating thing here involved was designed by its maker and was adopted and actually used for the identical purpose claimed for the patent and no change or modification was necessary to make it accomplish that purpose. In other words, we contend that the anticipating cases were designed by Whitcomb and adopted for use and actually used identically as the patented structure and that plaintiff's efforts to show the contrary only served to make the identity of the anticipating nad patented structures more certain and positive. Our position first last and all the time is that such cases as the Topliff case and others of its nature cited by plaintiff are not in point on the facts in this case.

We do not regard it as material what evidence rule applies to this case, as we have proven the anticipation beyond any doubt whatever, reasonable or otherwise. Plaintiff seems to emphasize its contention that we must show anticipation beyond a reasonable doubt, and even goes as far as to say that it must be shown to a moral certainty. That clear proof of anticipation is required is conceded, but that proof of the same degree as is required in criminal cases is denied. Requiring proof beyond a reasonable doubt in a civil case runs counter to all the rules of evidence governing the adjudication of property rights. That a patent is a mere property right cannot be questioned. Yet, counsel would have us believe that the moment a patent is questioned it immediately becomes sacred, and is surrounded with all the safeguards and presumptions of life and liberty. We take the liberty, and even the life, of our citizens on evidence that is only beyond a reasonable doubt, and plaintiff would place chattels when they consist of a patent on the same basis. That such is not the law is obvious. The courts require clear and definite proof of anticipation and the expression of reasonable doubt appears in a few cases, but in each instance the showing was such as to call for condemnation. When it is claimed that a complex machine was anticipated many years ago and the thing is not in exstence and only vague memories interested in the result are produced, then strong evidence is required. No such situation obtains here. The cases are actually in existence beyond a question, and plaintiff has only attempted to show that they differ, substantially, from the patent, and in this attempt it has lamentably failed. Then the thing here is not complex or even difficult, but is simple and can be understood by even a layman while anticipation is sufficient when it is such as to disclose the idea to one skilled in the art.

The language of Judge Sanborn in *Mast*, *Foos* & Co. vs. Dempster Mfg. Co., 82 Fed. 327, illustrates the class of cases that give use to strong language as to evidence requirements. In this case he states:

"The evidence of prior use is the testimony of a *single witness* who was once in the employ of another infringer of the device of appellant, but has since been employed by the appellee. He produces no part of the old windmill which he testifies was set up and put into operation before Martin filed his application, and his evidence is without the support of any other witness."

Of course, such testimony cannot prove prior use. It would not prove anything. Any law predicated on such an absence of proof as that, can have no bearing on this case.

Then the Barbed Wire Patent Case, 143 U. S. 275, was another instance where an attempt was made to dig something from memories and much conflict and confusion was developed. We simply have no such situation at bar and those cases do not control.

That prior use can be established by oral evdence alone and that the prior use of only one of the devices is sufficient to anticipate will appear from cases we will cite. In American Roll Paper Co. vs. Weston, 59 Fed. 147, it appeared that five or six witnesses gave more or less definite testimony as to the prior use of a single roll and paper cutting machine used in a store years before. The thing was no longer in existence, and the only testimony as to its use and construction was recollections, and the court held it sufficient proof of prior use. The proof there was far weaker than in the case at bar. There only one of the anticipating devices had ever been in existence and it had been lost a long time before the trial.

Then the law does not require the use to be other than what the thing is designed for. The use of some watch mechanism in one watch as it was designed to be used is as much a public use within the law as if it were something used on a busy street corner. A good case on this point is *Egbert vs. Lippman*, 104 U. S. 333; 26 L. Ed. 755, in which prior use of corset stays was involved.

Now we propose to show the court that facts are proven in a patent case, including the defense of prior use, as they are in other cases. When the matter attempted to be proven is very doubtful and improbable more proof is required than when the claimed fact is probable. You have to have clear evidence of an improbability in any case. More proof is required to show that a man procured goods by fraud than that he purchased them in the

ordinary way as the probabilities are materially different. If it is claimed that one previously used a complicated piece of electrical mechanism more proof is required than when he claims to have previously used a simple thing like a bookcase or showcase. The reason is obvious. Then whether the witnesses have knowledge of the business about which they testify is a factor in determing the value of their testimony. Again, the probability enters. Whether the thing testified about is actually in existence or merely exists in the memory of a few individuals is a very material factor in weghing evidence. It requires more proof to show where a cornerstake was years ago than where one is today. The everyday probabilities enter into a patent case the same as any other case, and the mind of the court must be satisfied in a patent case the same as in any other case. If a patent is claimed to be invalid because of the prior issuance of a patent covering the same thing it can be seen how the claim might excite suspicion as the patent office, to a certain extent, determines those matters and it is not supposed to issue duplicate patents to different persons. But when a patent is claimed to be invalid by reason of facts entirely extraneous to any determination by the patent office, and which that office could not have been conversant with, we see no reason for great alarm or suspicion. If the claimed facts are true, the patent office's grant was invalid. The right

was beyond its authority to dispose of. True, even then the patent is prima facie valid, but nothing more. The same is true of any official grant that is due and regular on its face, but if it is issued without authority it is invalid and can be so determined by the courts, and upon evidence that is clear and satisfying and no "beyond a reasonable doubt" evidence is imperative. Why there should be any greater temptaton to attack a patent on facts not appearing on its face, but which operate to defeat it than there is to attack any other document in the same manner, is not easy to appreciate. Of couse, the instances of such attacks are more numerous because patents are more frequently before the courts. A patent is either valid or invalid and when a defendant, clearly within his legal rights contends it is invalid by reason of facts existing at and before its issue, we see no reason why his defense should be covered with suspicion. He has been brought into court by the patent holder and when he is doing only what the law expressly accords him the right to do, he should not be characterized as one resorting to suspicious methods.

Now, let us see what the courts have said. In Coffin vs. Ogden, 18 Wall. 120, 21 L. Ed. 821, the Court, in discussing the prior knowledge and use testimony, said:

The law requires not conjecture, but cer-

tainty. * * * The prior knowledge and use by one person is sufficient."

In that case Erbe testified to having made the anticipating lock before the patentee. One Brossi testified to having seen the lock at Erbe's house, where Erbe explained it to him and that he saw it in use on a door at the shop where Erbe worked. Masta testified that Erbe showed him the lock and that he examined it and he testified as to its construction. One Patterson said Erbe showed him the lock and he described it and said it was the same as the patent product. He was supposed to have used one of the anticipating locks but was not sure. Erbe thought one of the locks was used at the shop. Only one witness gave positive testimony as to the use of the anticipating lock. After reviewing this evidence, the court said:

"Here it is abundantly proved that the lock originally made by Erbe was complete and capable of working. The priority of Erbe's invention is clearly shown. It was known at the time to at least five persons, including Jones and probably to many others in the shop where Erbe worked; and the lock was put in use, being applied to a door as proved by Brossi. It was thus tested and shown to be successful. These facts bring the case made by appellees within the severest tests which can be applied to them. The defense relied upon is fully made out."

In that case, only one lock was previously used and the fact of its use depended upon the evidence of one witness and the anticipating thing was much more difficult and complex than the matter at issue here, and here the evidence is much more abundant than in that case.

In Lee v. Upson & Hart Co., 43 Fed. 670, the plaintiff was contending for a rehearing on the ground of the insufficiency of the prior use testimony. The court said:

"If the improvement had been a complex mechanism, if the essence of the invention had been the nice adjustment of parts to produce a result, or if the thing to be done required genius of a superior order, the testimony would have been insufficient; but it requires much less testimony to satisfy a court that the Messrs. Hart, who had brazed and welded, and butt-welded for years, conceived and carried out the idea of butt-welding instead of brazing the inclined end lips of a blank, than it would to satisfy a court that they had made a new, complicated machine. In such a case as this, the sever scrutiny which is given to the alleged anticipation of the Morse telegraph, the Bell Telephone, or the Howe Sewing Machine, is not called for, because reasonable doubts do not exist. The argument of the plaintiff forgets that it requires less testimony to establish a fact which was very likely to have occurred than to establish an improbable theory. The application is denied."

Another case to the same effect is Clark v. Palmer Bldg. Block Co., 149 Fed. 1001. As to the prior use testimony the court said:

"Bearing in mind the familiar rule, we find no basis for the slightest doubt of the testimony concerning prior use. The witnesses said that the structures were in existence as erected, at the time they were testifying. Owners, architects, workmen, averred that the structures were put up many years prior to the application for the patent. Appellee offered no evidence in contradiction and was and is content to invoke the rule of reasonable doubt. These structures speak for themselves as to the question of design. Their nature and location were such that no pretense can be made that they were erected for the purpose of this case. The Barbed Wire Patent, 143 U. S. 275; Bettendorf Patents Co. v. Little Metal Wheel Co., 123 Fed. 433, and other cases in which the thing can only be known as it is reconstructed, years afterwards, from the memory of witnesses, have no pertinency."

In Corrington vs. Westinghouse Co., 178 Fed. 711, the court in discussing the reasonable doubt rule, said:

"But testimony must be weighed in a patent cause as in other causes and the court is not permitted to reject arbitrarily the testimony of respectable witnesses because of mistakes and differences in non-essentials."

In Riley v. Daniels, 20 Fed. Cases No. 11837, the court held that the testimony of one witness, that in January, 1862, he formed a lamp wick the same as the one patented was sufficient to overcome the prima facie evidence furnished by the patent. The court said:

"The important question upon this state of facts is whether inasmuch as the defendant takes the burden of proof and must overcome by preponderating testimony the prima facie evidence which is furnished by the letters patent, the testimony of a single witness is sufficient to create such a preponderance. In cases in which the priority of the invention of a machine was the subject of controversy, I should not be willing to rely upon the testimony of a single witness that he had made such a structure, and had antedated the patent, unsupported by the presence of the machine itself. The bare recollections of one witness in regard to the peculiar construction of a piece of machinery, especially if the structure is one of a complex character, is not ordinarily sufficient evidence of a patent. But in this case, the invention of the patentee was of the simplest character. Much less testimony should be demanded to satisfy a court that a very simple invention had been anticipated than would be necessary to prove the fact that previously to the alleged date of an invention, originally requiring much labor, skill and ingenuity, another person had made and completed the same machine or article. The evidence should be of such a character as to satisfy the court that the prior invention of the particular article in controversy took place."

In National Casket Co. v. Stolts, 157 Fed. 392, the court held that the prior use was established by one witness and without the production of the prior used device. The court said:

"We are now dealing with a witness concededly familiar with the art, who narrates

acts of his own, so simple in character that he can hardly be mistaken regarding them. A carpenter's description of a compound wound dynamo seen by him ten years before might well be received with grains of allowance, but if the question were whether a bookcase built by him at that time was provided with glass door or curtains, this statement would probably be received without cavil. So it would seem that an undertaker who swears that he tacked silk illusion in a casket as a face plate, cannot be laboring under misapprehension. Either the face plate was attached as he testified, or he is guilty of a deliberate falsehood. As before stated, we regard the latter supposition as an impossible alternative."

In Moyer v. Metal Co., 169 Fed. 825, the court held the prior use established and said:

"But in the present case the witnesses were acquainted with devices of the description in suit."

Then ins Rochester Coach Lace Co. v. Shaefer, 46 Fed. 190, the court said:

"But, irrespective of these views, unless the court is to reject arbitrarily the evidence of several uncontradicted witnesses, the method described in the first claim was employed in at least two instances prior to the patent and in one instance as early as 1859. No reason is perceived why the court should not credit these witnesses. If we were dealing with a complicated machine or an abtruse and difficult process there would be reason to say that persons unskilled in the art might easily be mistaken in describing minute details. But

here, we have to do with the simplest possible contrivance * * * A person of average intelligence who had actually made balls of yarn by this method could hardly be mistaken about the use of the spool. No motive for perjury is suggested and no discrepancies which discredit the testimony upon the principal points are pointed out."

In *Phoenix Knitting Works v. Rich*, 194 Fed. 721, we find the court stating as follows:

"Applying to the proper consideration of the testimony of the four witnesses on this point whom Judge Witmer considered, that of Miller and his wife not in the Philadelphia record, we are compelled to find that, in the early part of 1906, Miller made and sold to Myers a quantity of mufflers which are plainly within claim one of the Mead patent and clear anticipations thereof. * * unless we arbitrarily reject them as credible witnesses which we cannot do. Undoubtedly the court must scrutinize the testimony offered to establish a prior use, and the rule should be observed that in such testimony the evidence must appear superior to a mere preponderance and must prove the priority strictly; but there is no hard and fast rule which would exclude such testimony as that touching the Myers muffler."

In the case the court quoted from $Sipp\ v.\ Atwood$, 142 Fed. 149, where it was said the subject matter is: "so simple in character that it is impossible to believe that an ordinary intelligent man could be mistaken" as to its exact form and function. It also quote from $Lee\ v.\ Hart,\ 43$

Fed. 670, to the effect that if it had been a complex machine the testimony would have been insufficient.

Brush v. Condit, 132 U. S. 39, 33 L. Ed. 251, is a good case on this point. There the court said:

"The plaintiffs vigorously insist that the Hayes clamp was not a completed and successful invention, but that its use was 'merely tentative and experimental, and was permanently abandoned because the device did not promise to be successful' and 'the plaintiff press the question * * *.' Why, then, was the future use of the Hayes clamp and lamp discontinued?"

In deciding the case the court said:

"Although only one clamp and one lamp were ever made, which were used together two and a half months only, and the invention was then taken from the lamp and was not afterwards used with carbon pencils, it was anticipation of the patented device, under the established rules upon the subject. With a strong disinclination to permit the remains of old experiments to destroy the pecuniary value of a patent for a useful and successful invention, and remembering that the defendants must assume a weighty burden of proof, I am of the opinion that the patentee's invention has been clearly proved to have been anticipated by that of Hayes."

Egbert v. Lippmann, 104 U. S. 333, 26 L. Ed. 755, is another good case on this point, in which the court said:

"The evidence on which defendants rely to establish a prior public use of the invention, consists mainly of the testimony of the complainant herself, who is the executrix of the original patentee."

The testimony consisted of Egbert, who said that Barnes gave her a pair of the corset steels in 1855; that in 1858 he presented her with another pair; that Barnes made both pairs; that she wore the steels in several pairs of corsets. One Sturgis says that in 1863, Barnes took him to his home to see the steels and Egbert (then Mrs. Barnes) produced the corsets and took out the steels and Barnes explained how they were made. The court said:

"This is the evidence presented by the record, on which defendants rely to establish the public use of the invention. * * * * We observe in the first place that to constitute the public use of a patent it is not necessary that more than one of the patented articles should be publicly used. The use of a great number may tend to strengthen the proof of public use, but one well defined case of public use is just as effectual to annul the patent as many. We remark, secondly, that whether the use of an invention is public or private, does not necessarily depend upon the number of persons to whom its use is known."

The court held that the prior use was established.

In Morgan v. Daniels, 153 U.S. 120-123, 38 L.

Ed. 657, the court said in discussing the evidence rule in prior use testimony:

"The plaintiff in this case, like the defendant in those cases is challenging the priority awarded by the patent office, and should, we think, be held to strict proof. In the opinion of the court below the rule is stated in these words: 'the complainant on the issue here tendered, assumes the burden of proof, and must, I think, as the evidence stands, maintain a clear and undoubted preponderance of proof that he is the sole author of that drawing."

In National Cash Register Co. v. American Cash Register Co., 178 Fed. 79, the Circuit Court of Appeals, in referring to the prior use testimony, said:

"The fact that there was only a single sale of a single machine does not save the patent. One sale before the two years' period will invalidate a patent as well as many, citing Smith and Griggs Mfg. Co. v. Sprague, 123 U. S. 249, 257, 31 L. Ed. 141."

In Delameter v. Heath, 58 Fed. 414, the court said:

"The opinions of the Supreme Court in * * * abundantly sustain the proposition that proof of a single unrestricted sale is sufficient to establish the defense of prior public use."

In the case of Doubleday v. Beatty, 11 Fed. 729,

it was held that oral evidence alone may be sufficient to prove prior use.

In Daniel v. Restein Co., 131 Fed. 469, the court said:

"How any two devices could be closer, it is difficult to see, and that the one fulfills the terms of the patent equally with the other, there can be no doubt. It is contended, however, that the two packings are distinguished * * * the difference so by the results, established is one of degree, and not of mechanical structure, which alone is patentable. But it is said that the earlier packing was not successful commercially it never advanced beyond the experimental stage. Prior knowledge and use by a single person has been held to be sufficient to negative novelty * * * and there is far more than that here. It was not necessary that it should go into general use or become a commercial factor, as suggested, and that it did not may well be ascribed * * * to the fact that it was not a cheap packing, and was not 'pushed'."

The last case is right in point in view of plaintiff's contention in regard to the results of the anticipating cases. If there is any difference in the amount of the elasticity it is only a question of degree. As a matter of fact, there is nothing to show how much elasticity follows from the patented construction. By using very thick felt they may get a great deal of elasticity while if they use real thin felt the elasticity might be reduced to a

minimum. Then the grade and texture of the felt might be a factor in determining the amount of elasticity obtained.

In Bradley v. Eccles, 138 Fed. 911, the court said:

"It is, of course, well settled that, under Sec. 4886, R. S. U. S., when a device has been in public use and on sale in the United States for more than two years prior to the filing of the application on which a patent has been granted, the patent will be void." Citing several cases, the court also said:

"One well defined case of prior public use in the United States is all sufficient." Citing

several cases.

In Parker v. Stebler, 177 Fed. 210, the Circuit Court of Appeals held that where oral testimony only is relied upon to to establish prior use it must be clear and satisfactory so as to convince the court beyond a reasonable doubt.

In the case of Swain v. Holyoke, 102 Fed. 910, it was shown that there was one instance of prior use about a week in excess of the two-year period and it was contended with some basis in the testimony that the prior use was experimental and the court went so far as to say that the purpose of the use was a "desire to introduce his invention and make it known to the public" and to know "how his invention would work, with a view to

improving the same." In deciding the case the court said:

"U. S. R. S. 4886 authorizes the patenting of a machine not in public use, or on sale for more than two years prior to his (patentees')

application.' A certain kind of experimental use is held to be without the language just quoted, but it seems to me that the sale of Chaffee and the use at Moodus were within the statutory exception." (Citing several cases.)

This case was decided by the Circuit Court of Appeals and is reported in 109 Fed. 154, where that court held that a single sale for actual use more than two years prior to the application for a patent constitutes prior use within U. S. R. S. 4886 which will invalidate the patent, unless it is clearly shown that the principal purpose of the sale was experimental, with a view of testing and perfecting the invention. That court said the fundamental inquiry is:

"Under what circumstances and for what purpose did the public use or sale take place? And, where it appears that there has been a public use or sale more than two years before the application, the burden is thrown upon the patentee to establish, by full, clear and convincing proofs, that such use or sale was principally and primarily for experimental purposes, and that such purposes were not merely incidental or subsidiary."

This case is not only in point to show that a

single sale or use is sufficient to invalidate the patent, but also to the effect that to defeat such prior use or sale the patentee has the burden of proof and must show the defeating facts by evidence that is "full, clear and convincing." In view of such law as this, it is easy to see how little basis there is in the case at bar for the plaintiff to contend that the sale by Whitcomb and the use by the other parties was experimental.

Lettelier v. Mann, 91 Fed. 917, is another case holding that the facts defeating prior use must be shown by the plaintiff. There the court said:

"The character and degree of evidence necessary to prevent a prior use from invalidating a patent have been stated by the Supreme Court of the United States, as follows," quoting from Smith & Griggs Mfg. Co. vs. Sprague, that such testimony should be "full, unequivocal and convincing."

In *Eames v. Andrews*, 122 U. S. 40, 30 L. Ed. 1064, the court held that the prior knowledge and use must be sufficient only to enable one skilled in the art to practice the invention.

Other cases holding that a sale more than two years prior to the application for the patent operates to defeat the patent, are:

Fruit Jar Co. v. Wright, 94 U. S. 92; 24 L. Ed. 68.

Hall v. McNeale, 107 U. S. 20; 27 L. Ed. 367.

Manning v. Glue Co., 108 U. S. 462; 27 L. Ed. 793.

The plaintiff is contending that Whitcomb has forgotten and abandoned the invention made by him in 1899. There is absolutely no basis for this in the facts, but in any event the burden of making any such showing is on the plaintiff.

Dalby v. Lynes, 64 Fed. 376.

Then the contention is advanced that Whitcomb did not appreciate the value of his invention. This again has no foundation in fact. In the case of *Merimac Mattress Co. v. Feldman*, 133 Fed. 64, the court said:

"Anticipation is not avoided by the fact that the inventor of the anticipatory device did not realize its value, which he reduced to practice."

That is the important point, was it reduced to practice, so that one skilled in the art could practice the invention? There can be only one answer in the case at bar.

Another contention is that Whitcomb's invention was an accident. This, too, finds no supporting evidence but as a matter of law it makes no difference whether it was accidental or otherwise.

In National Harrow Co. v. Quick 74 Fed. 236, the court said:

"To constitute anticipation of a later patent it is enough that such a construction had been in well established use, whether it originated in design or by accident."

Again we get back to the question—was the thing in actual use in the manner it was designed to be used and so those skilled in the art had an opportunity of learning the invention? If so, the matter of accident, abandonment, experiment and appreciation or lack of it are all foreign to the inquiry.

A good case on the question of experiment is Mfg. Co. v. Sprague, 123 U. S. 249, 31 L. Ed. 141, where the court holds that where the substantial use is not for experiment, but is mainly for the purpose of trade and profit and the experiment is incidental and such use is public and for more than two years prior to the application, it will defeat the right to a patent. This case also holds that where the defense of prior use is met by the claim that the use was for an experiment "the proof on the part of the patetnee * * * should be full, unequivocal and convincing."

Now, it seems perfectly clear from the foregoing authorities that there is no hard and fast rule of evidence as to prior use testimony in patent cases. A patent case is not unlike any other case. The court must be satisfied that the prior use actually took place. Some of the courts have used the reasonable doubt expression, but in cases where the showing was very flimsy. For the most part, such expressions have been references to other cases and almost wholly in cases where the prior used thing was not in existence and oral testimony alone was relied upon to show its construction. It has been held so clearly and positively that one instance of prior use is sufficient to defeat a patent that it almost seems idle to discuss the question. Then, there is a very clear distinction running through the cases to the effect that much more proof of the prior use of a complex machine is required than is required to establish prior use of a comparatively simple device. This case clearly comes within this exception to the rule if it can be said there is such a rule. There is another exception to the rule that much less proof is required when the prior used thing is shown to actually exist than when the court must rely upon memories alone. This exception innures to the benefit of the defendant in the case at bar. Another exception also applicable to this case is that less testimony is required from those familiar with the art than from strangers thereto. When the whole situation is analyzed we find aside from what the rule contended for by plaintiff really is, that in any event it has no application to the instant case. On the other hand, we find that plaintiff is required to make very full and convincing proof of any facts claimed to defeat the prior use testimony. In Sipp Co. vs. Atwood-Morrison Co., 142 Fed. 149, the court said:

"We see no reason to doubt the testimony as to these alleged prior uses. The witnesses are shown to be men of experience and intelligence and there is no impeachment of their character. Their familiarity with the art and industry to which the patent in suit relates, is abundantly established. No bias or pecuniary interest is shown to qualify the force of their testimony. The time that has elapsed since the date of the facts testified to was not great,—ten or twelve years. The witnesses were in the prime of life, and their testimony direct, positive and distinct as to the facts testified to."

In any event, this reasonable doubt rule, so far as it applies at all, only applies to the defense of prior use leaving the defense of prior invention free from any such burden though, of course, the burden of proving prior invention is on the defendant, but only in the ordinary degree of weight.

As throwing light on the question of prior use in this case it might be well to consider briefly the rule that "that which infringes, if later, anticipates if earlier." This rule is laid down in Miller vs. Eagle Mfg. Co., 151 U. S. 186, 39 L. Ed. 121, where the court said:

"It admits of little or no question that if this Brown patent was one of later date than the Wright patent of 1881, it would be held to be an infringement thereof, as under the authorities, 'that which infringes, if later, anticipates, if earlier.' Peters v. Acme Mfg. ticipates, if easlier. Peters v. Acme Mfg. Co., 129 U. S. 530, 32 L. Ed. 738; Thatcher Heating Co. v. Brutis, 121 U. S. 286, 295, 30 L. Ed. 942, and 946; Grant v. Walter, 148 U. S. 547, 37 L. Ed. 552; Gordon v. Wardner, 150 U. S. 47, 37 L. Ed. 992; Knapp v. Morris, 150 U. S. 221, 37 L. Ed. 1059.

This rule is so well established that it cannot be evaded. Suppose some one was now making cases identically like the Cooper and Federman cases with all the all-glass joints made precisely in accordance with the patent the back top joint, we will assume, being held down to the felt with screws instead of cement. Can it be doubted for a moment that such construction would be an infringement of the patent? Then counsel would be contending that screwing glass down to felt made an elastic joint and that in any event infringement could not be avoided by only using ninety per cent of the idea of the patent. They would say, and rightly so, that to use part of the principle was as bad as using the whole; that to employ the principle of the patent only half so far as the patent must be an infringement as otherwise infringement could be avoided by stopping the felt cement construction only a few inches short of the sum total of the patent. It is the principle and idea in concrete form that is patented and not the extent of its application. Yet,

the law says with clearness and positiveness that "whatever infringes, if later, anticipates if earlier.' If the Cooper cases, for instance, would infringe if made now, they are bound to anticipate as having been made in 1899. The use in any degree of the idea of a patent covering an art or process such as the patent sued upon, would, it would seem, constitute an infringement. If ten per cent can be used without infringing, then ninety-nine per cent can also be used without infringing. It follows that any substantial use of the idea of a patent covering a process of construction must be an infringement thereof it in turn follows under the law that any substantial prior use of the idea constitutes anticipation. In using the term idea it must be understood as having been carried into concrete form. A mere naked idea is not patentable.

CONSTRUCTION OF THE PATENT.

Section 4888 of the U. S. R. S. requires among other things that an inventor applying for a patent "Shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery."

Now, as to the construction of the patent in suit, the defendant contends that plaintiff is confined strictly to what is stated in the claims; that a portion of the claims attempt to cover a function or result; that a function is not patentable and that

so far as the claims are functional they must be restricted and held invalid; that a patent can only cover the concrete, physical means employed to accomplish the result or function; that the claims of a patent being self-imposed are binding on the patentee and all that he does not claim is abandoned to the public; that the claims of a patent cannot be enlarged or extended in any particular even by reference to the specifications, descriptions or illustrations of the patent; that a patentee is confined to his claims even though his invention is clearly broader and more inclusive; that the patent in this case covers only the all-glass joints of the showcase and in no way includes the back top joint of the showcase, or the character of adhesive substance to be used.

Now claim one of the patent reads:

"A structure comprising a plurality of glass plates, the edges of which are spaced from the adjacent plates, a felt cushion filling the space between the adjoining plates, the plates being cemented to the felt (each plate being adapted to freely vibrate in its natural plane of vibration, and prevented by the felt cushion from imparting its vibration to the adjacent plate)."

The brackets are used to indicate that portion of the claim that we shall later contend is functional and invalid for that reason. The second and only other claim of the patent is just like the first with a little change in phraseology and that "an elastic material" is substituted for "felt cushion" in claim one.

Now, if patent claims are strictly construed and are limiting and confining in their character and cannot be in any wise extended or enlarged by construction or even by reference to the specifications or drawings it is easy to see how these claims only cover the construction where there is a "plurality of glass plates" and that they do not in any possible sense embrace the back top joint where plaintiff is attempting to distinguish the patent from the anticipating cases. Of course, a distinction cannot be based on a feature not within the patent. If the feature is not there neither is the distinction.

Now, what is the law on this subject?

In Keystone Bridge Co. v. Phoenix Iron Co., 95 U. S. 274, 24 L. Ed. 344, in construing the claims of a patent said:

"When the terms of a claim in a patent are clear and distinct, as they always should be, the patentee in a suit brought upon the patent, is bound by it. He can claim nothing beyond it. But the defendant may at all times, under proper pleadings, resort to prior use and the general history of the art to assail the validity of a patent or to restrain its construction. The door is then opened to the plaintiff to resort to the same kind of evidence in rebuttal; but he can never go beyond

his claims. As patents are procured ex parte, the public is not bound by them, but the patentees are and the latter cannot show that their invention is broader than the terms of their claims; or, if broader they must be held to have surrendered the surplus to the public."

Lehigh R. R. Co. v. Mellon, 104 U. S. 112, 26 L. Ed. 639, where the court was construing the claims of a patent said:

"In view, therefore, of the statute, the practice of the patent office and the decisions of this court, we think that the scope of letters patent should be limited to the invention covered by the claim and that though the claim may be illustrated, it cannot be enlarged by the language used in other parts of the specifications.

* * * In this case the description of the appellee's invention is much broader than his claim.

* * * He can not go beyond what he has claimed and insist that his patent covers something not claimed, merely because it is to be found in the descriptive part of the specifications."

Then in Yale Lock Co. v. Greenleaf, 117 U. S. 554, 29 L. Ed. 952, the court said:

"We think this difference between the two locks does not give validity to the Rosner patent, for two reasons: First, because of the shape and size of the key hole is not mentioned in the claim of the Rosner patent as one of the elements of the combination. The scope of letters patent must be limited to the invention covered by the claim, and while the claim may be illustrated it cannot be enlarged by language used in other parts of the speci-

fication. Keystone Bridge Co. v. Phoenix Iron Co., 95 U. S. 247; Railroad Company vs. Mellon, 104 U. S. 112."

Again in White v. Dunbar, 119 U. S. 47, 30 L. Ed. 303, the court, in construing a patent, said:

"Some persons seem to suppose that a claim in a patent is like a nose of wax, which may be turned and twisted in any direction, by merely referring to the specification, so as to make it include something more than, or something different from, what its words express. The context may undoubtedly be resorted to, and often it is resorted to, for the purpose of better understanding the meaning of the claim; but not for the purpose of changing it and making it different from what it is. The claim is a statutory requirement, prescribed for the very purpose of making the patentee define precisely what his invention is; and it is unjust to the public, as well as an evasion of the law, to construe it in a manner different from the clear import of its terms. This has been so often expressed in the opinions of this court that it is unnecessary to pursue the subject further."

In Howe Machine Co. vs. National Needle Co., 134 U. S. 388, 33 L. Ed. 963, the court said:

"The specification and drawings are usually looked at only for the purpose of better understanding the meaning of the claim, and certainly not for the purpose of changing it and making it different from what it is. As remarked by Mr. Justice Bradley, in White v. Dunbar, 119 U. S. 47, 'the claim is a statutory requirement, prescribed for the very pur-

pose of making the patentee define precisely what his invention is; and it is unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms."

In McCclain v. Ortmayer, 141 U. S. 419, 35 L. Ed. 800, we find the court stating as follows:

"While the patentee may have been unfortunate in the language he has chosen to express his actual invention, and may have been entitled to a broader claim, we are not at liberty, without running counter to the entire current of authority in this court to construe such claims to nclude more than their language fairly imports. Nothing is better settled in the law of patents than that the patentee may claim the whole or only a part of his invention and that if he only described and claims a part he is presumed to have abandoned the residue to the public. object of the patent law in requiring the patentee to 'particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery' is not only to secure to him all to which he is entitled but to apprise the public of what is still open to them. The claim is the measure of his right to relief, and while the specification may be referred to to limit the claim. it can never be made available to expand it."

The, in *Deering v. Harvester Works*, 155 U. S. 296, 39 L. Ed. 157, the court said:

"It is possible that Olin was entitled to a broader claim than that to which he limited himself, but if he described and claimed only a part of his invention, he is presumed to have abandoned the residue to the public."

In Western Electric Mfg. Co. v. Ansonia Brass Co., 114 U. S. 453, 29 L. Ed. 210, the court, in determining the scope of a patent, said:

"That part of the alleged invention is not even referred to in the most distant manner in the claim. It has been held by the court that the scope of letters patent should be limited to the invention covered by the claim; and, though the claim may be illustrated, it cannot be enlarged by the language and other parts of the specification. Railroad Co. v. Mellon, 104 U. S. 112. The element of the process under consideration cannot, therefore, be held to be covered by the patent. The contention that the patentee intended to include it in his process is evidently an afterthought."

In Coupe v. Royer, 155 U. S. 565, 39 L. Ed. 263, the court used this language:

"The principle of construction which we think applicable to the plaintiff's patent is that such construction must be in conformity with the self-imposed limitations which are contained in the claim. Such claims are the measure of their right to relief."

In *U. S. Co. v. Asphalt Co.*, 193 U. S. 591, 40 L. Ed. 342, the court said:

"It is not within the rightful power of the courts to enlarge or restrict the scope of patents which by mistake were issued in terms too narrow, or too broad to cover the inven-

tion, however manifest, the fact and extent of the mistake may be shown to have been."

In Unhairing Co. v. American Co., 198 U. S. 399, 49 L. Ed. 1100, the court said:

"In making his claim the inventor is at liberty to choose his own form of expression, and while the courts may construe the same in view of the specifications and the state of art, they may not add to or detract from the claim."

In *Universal Brush Co. v. Sown*, 154 Fed. 655, the court held that a patent cannot be given a construction broader than its terms in order to cover something which might have been claimed, but was not.

In Peifer v. Brown, 106 Fed. 938, the court said:

"If it be true, as suggested by the plaintiff's expert witness, Mr. Clark, that the patent granted to Mr. Peifer, and accepted by him did not adequately cover his real invention, it is a misfortune which the court is powerless to redress."

In Schreiber & Coucher Mfg. Co. v. Adams Co., 117 Fed. 830, the court held that the language of the claim of a patent cannot be enlarged by the courts although it may not be broad enough to cover the actual invention of the patentee.

In Seabury vs. Johnson, 76 Fed. 456, the court in construing the claims of a patent said:

"The inventor, for reasons doubtless satisfactory to himself, deliberately limited his his claim to a 'metallic band,' although it is quite clear from the words of the specification that he was perfectly well aware that bands of other material might suffice. Believing that metal bands were preferable he deliberately chose them for his monopoly, and chose them only. His act in so doing was nothing more or less than a declaration that he abandoned to the public the right to use bands which were non-metallic. The law of patents requires that the patentee shall particularly specify and point out the part, the improvement, or the combination which he claims as his invention or discovery. Courts are bound by the language chosen by the inventor; and they have neither the right nor the power to enlarge a patent beyond the scope of its claim as allowed by the Commissioner of Patents. When the terms of a claim in a patent are clear and distinct, the patentee in a suit for infringement is bound by it. He is absolutely barred from attempting to show that his invention or discovery is larger and broader than the terms of the claim."

In Harder v. U. S. Piling Co., 160 Fed. 463, the Circuit Court of Appeals, in construing the claims of a patent, said:

"Now a patent is to be sustained, not for what an inventor may have done in fact, but only for what he 'particularly points out and distinctly claims" in his open letter."

Hardison v. Brinkman, 156 Fed. 692, and Day Time Register Co. vs. Syracuse Time Recorder Co., 161 Fed. 111, are cases which hold that a patentee is bound by the language in the claims of his patent, even though he may have been entitled to make broader claims and that the courts cannot alter or enlarge the claims of a patent.

There are scores of other cases on this question of construction of the claim of a patent, but it seems that those which we have herein cited and quoted from are abundantly sufficient to satisfy the court beyond any possible question, as to what the law governing such construction is. To pursue the subject further, would, it seems to us, be mere surplusage.

Under the law which we have pointed out to the court, there can be no escape from the conclusion that the plaintiff in this case is absolutely confined and limited to the language of the claims of the patent and is estopped, from contending for anything in excess of the plain and clear import of his claims. In other words, in his patent he must once and for all time exercise his right to claim what he has invented. When he has exercised that right his rights as well as those of others become defined and vested and he is forever debarred from making any claim other than what is clearly within the enclosure which he has voluntarily con-He deliberately draws the line which structed. separates that which is his, from that which is others and no sense of justice should permit him

after controversy has arisen, to alter, extend or change that line in the slightest particular. If he erred in his choice he can blame no one but himself. Claims of a patent effect and define substantial rights and it must follow as a matter of necessity that they be strictly construed and construed against the party who had the right to claim little or all as he thought wise. To permit him to adjust or expand his claim as his needs arise is to say that the public has something today and nothing tomorrow. The theory and justice underlying this principle of construction is so patent that it seems unnecessary to labor the point further.

In this patent he has confined himself to the glass construction. He says he claims a "structure" of a "plurality of glass plates" spaced from each other, a "felt cushion" filling the space, the "plates being cemented to the felt." Nowhere in either claim is there the slightest intimation or even the vaguest kind of a suggestion that he claims the construction of the joints where wood and glass come together or that his invention embraces the construction of the wood and glass joints in any form or that he claims any particular adhesive must be used. He employs the "felt" and "elastic material" between all the glass plates where they would otherwise come in contact but by no stretch of imagination does he claim to employ the felt or elastic material in any other joints.

It is submitted in all candor that there is not a word in either claim that justly can be contended to intimate in any sense that the patentee claimed the back top joint where the top plate of glass is joined to the back wood frame or the adhesive substance that is to be used. The expressions he employed, and that is what governs, do not embrace anything but the all-glass joints. If he did not say all he might have said or perhaps all that he may have intended to say, he should be the loser and not those who have in no manner been delinquent. With the patent confined to the all-glass joints it requires no argument to show that the distinction plaintiff is endeavoring to make between Whitcomb's cases and the patent consisting of the screws in the back top joints of some of Whitcomb's cases is no distinction at all. are clear without the scope of the patent and, of course, any tenable distinction must concern something within the claims of the patent.

The attempted distinction based upon the claimed difference in the adhesive used is equally untenable. The claims of the patent do not cover cement and do not even require that cement be used. That is simply another matter that the patent does not cover. A simple reading of the claims will be sufficient to exclude any distinction based on the different adhesive mixtures used even if it were shown that the mixtures were not the same. The first claim requires that the glass

plates be "cemented" together but is entirely silent as to what they shall be cemented with. You may use anything that will adhere the glass and felt together. The term "cemented" as used in the claim is obviously intended to direct that the glass and felt be adhered together with material having adhesive qualities. The second claim directs that the plates be "attached" to the "elastic material" without in any manner indicating how or with what material the attachment shall be made. In one case when you have "cemented" the plates and felt together and in the other when you have "attached" the plates to the elastic material you have done all the claims call for and have infringed the patent. Then going back to the familiar rule that "that which infringes, if later, anticipates if earlier," a clear case of anticipation is shown if in the Federman and Cooper cases the felt and glass were cemented and attached together with some material that made an adhesive connection. That, that very thing was performed and practiced by Whitcomb as early as 1899 cannot well be disputed.

Now, there is another point of law equally as well established that is fatal to a portion of each of the claims of the patent. It is clearly the law that the function, result, accomplishment, operation or adaptation of a machine or thing is not patentable. The patent can only cover the actual physical concrete thing itself. The means and

not the end is patentable. If the result, and so forth, flow from the use of the means all well and good. The patentee is entitled to obtain results and functions that come from the use of his means but he cannot cut off the rights of others to accomplish the same result and function by substantially different means. If some other person can secure an elastic joint in a showcase by substantially different means than that employed by Weber he has a clear right to do so, and even to procure a patent. The elastic result is not patented, but simply the method of construction. contend that the claims of the patent in suit covers more than the actual physical means and lap over and attempt to claim the result and function presumed to flow from the means. Just so far as the patent covers a function it is void.

We contend that the latter portion of claim one, is invalid because it is functional; that the functional part of said claim is stated as follows:

"Each plate being adapted to freely vibrate in its natural plane of vibration and prevented by the felt cushion from imparting its vibration to the adjacent plates."

The portion of the second claim that we contend is functional and invalid is:

"Whereby the plates by reason of their unconfined edges and the intervening elastic material can each vibrate or move in any direction independently."

Now the gist of the objectional-part of claim one is that each plate is adapted to vibrate without imparting its vibration to the other plates. It would seem that a mere reading of it shows that it does not claim anything physical and concrete but rather the result that is claimed to follow the physical means that is set up immediately preceding. He is clearly claiming the alleged beneficial result that follows his method of construction and that is precisely what the law does not permit. The result is open to the public at all times. The only thing that can be monopolized is the means of attaining that result in a certain way. Any one that can attain the result in a substantially different way has a perfect right to do so. The adaption to vibrate and the preventing the imparting of vibration is the result of the use of the felt cushion. He can claim the felt cushion. It is the physical and tangible means. He cannot claim the vibration and so forth. That is a result of the use of the felt cushion. The same thing can be said of the objectionable portion of claim two. There again he is claiming the vibration that results from the use of the elastic material. In each instance up to the quoted portion of the claims he has claimed the physical construction—the means, and that is as far as the law permits him to go. The moment he exceeds that he is attempting to appropriate that which he can, in no event, be entitled to. Let us look at some of the cases on this point.

The case of National B. B. Co. v. Interchangeable B. B. Co., 106 Fed. 693, which plaintiff cited to no purpose, covers this point very clearly where the court says:

"Now, the function or result of the operation of a machine or combination is not patentable under our laws and therefore the camber in the beam could not be monopolized by means of a patent. The means, the mechanical device, by which that camber was produced and that alone was capable of protection by such a franchise." (Eight cases from the Supreme Court are cited in support of that statement.)

In Columbus Watch Co. v. Robbins, 64 Fed. 384, Judge Taft, speaking on behalf of the Circuit Court of Appeals, said:

"But it is said the claims * * * are void because they seek to appropriate results or functions, rather than means or devices for accomplishing results. Unless the claims are to be restricted by construction, this criticism is a just one. The inventor, in his first claim, seeks to monopolize a train 'adapted' to be placed in engagement with the winding or setting wheels. * * * In the light of the Corn Planter Decision, it is evident that they must be limited to the particular mechanism * * * securing the adaption referred to in the claim."

In National Cash Register Co. v. Boston Cash

Recording Co., 156 U. S. 502, 39 L. Ed. 511, the court said:

"There is no conflict here with the principle laid down by this court in Knapp v. Morse, 150 U. S. 221, and Wollensak v. Sargent, 151 U. S. 227, that the end or purpose sought to be accomplished by a device is not the subject of a patent but only the new and useful means for obtaining that end."

Other cases holding that the result, function and so forth are not patentable and that only the physical means employed to secure the results are patentable are as follows:

Fuller v. Yentzer, 94 U. S. 288; 24 L. Ed. 103.

Disdon v. Medart, 158 U. S. 68; 39 L. Ed. 899.

Knapp v. Morse, 150 U. S. 221; 37 L. Ed. 1059.

Westinghouse v. Boyder, 170 U. S. 537; 42 L. Ed. 1136.

Corning v. Burden, 15 How. 252; 14 L. Ed. 683.

Plaintiff closes its brief with a subdivison entitled "Opinion of Judge Rudkin in Dismissing the Bill," and takes issue with the District Judge in decding the case in the court below. Much of the controversy with this decision gets back to the question concerning the cement or adhesive sub-

stance used by Whitcomb. It seems to us that this question does not require further discussion from us as we have already clearly shown that the patent does not require the use of any particular cement and if that is true no particular cement is required in order to constitute an anticipation. The Judge is criticzed because in the record he is made to state that a strip of felt was placed between the plates "and" the joint. If counsel will refer to his copy of the Judge's opinion he will find that the word "and" used in the record is a substitution for the word "at" used by the Judge.

Then counsel assert that the patent cases have elastic joints made with felt and ordinary cement. the cement not permeating the felt. We again deny that the construction under the patent necessarily requires ordinary cement or any cement at all and this record does not disclose what, if any, cement the patent holder uses. Whether the cement or adhesive substance used by the patent holder actually permeates the felt or not is a question that is not in any way touched by the testimony in the case. Then counsel proceed with their oft repeated and baseless assertion that the cement used by Whitcomb permeated the felt and made a rigid joint. We have denied this so frequently that we may be imposing upon the court to reiterate the denial. However, our contention to the contrary is so clearly supported by the testimony that we do not feel like letting a single assertion of this character, made by the plaintiff, go unchallenged.

Then plaintiff just before closing assumes a hypothetical case which is based upon the unwarranted assumption as to the facts in the case and is already disposed of by our contentions heretofore made. We earnestly contend that the same results accomplished by the patent were and are accomplished in the Cooper and Federman cases.

In closing we submit that it has been proven beyond any doubt whatever that show cases made in at least substantial accordance with the claims of the patent were in public use in this country more than two years prior to the application for the patent sued upon and that it is clearly shown that the patentee Weber was not the first or original inventor of any substantial part of the device patented as is required by Section 4920 of the U. S. R. S. That the defenses set up in subdivisions four and five of U.S.R.S. 4920 have been abundantly sustained in accordance with all the applicable rules of evidence, would seem to be beyond any real controversy. It seems equally clear that plaintiff's contention as to accident, experiment and so forth are wholly without support in the evidence.

We also submt that the distinctions attempted to be drawn by the plaintiff between the anticipating cases and the patent are not within the claims of the patent; that the patent cannot be construed to include the top back joint of the showcase where the glass joins with the back wood frame; that the patent does not require the use of any particular adhesive substance, and any adhesive substance which will adhere glass to felt comes within the claims of the patent and is sufficient to constitute an anticipation; that portions of each claim of the patent are functional and therefore void.

The patent in suit should be held to be invalid and the decree of the lower court affirmed.

Respectfully submitted,

S. H. CUTTING.

Ruse & Morril

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